SUPREME COURT OF THE UNITED STATES.

No. 166.

THE PROVIDENCE RUBBER CO. ET AL., APPELLANTS,

vs.

CHARLES GOODYEAR'S EXC'R, AND THE UNION INDIA RUBBER CO. AND AL.

APPEAL FROM THE CIRCUIT COURT OF THE UNITED STATES FOR THE DISTRICT OF RHODE ISLAND.

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1 At a Circuit Court of the United States, begun and holden at Newport, within and for the District of Rhode Island, on the fifteenth day of June, A. D. 1867, before Hon. Nathan Clifford, Associate Justice Supreme Court United States, Hon. J. R. Bullock, District Judge U. S. for said Rhode Island District, the following cause was disposed of:

Be it remembered, that on the 27th day of November, A. D. 1866, the following motion was made to said court at its November term, 1866:

THE PROVIDENCE RUBBER CO. *et al.*
vs.
CHARLES GOODYEAR, *Ex.*, *et al.*

The Providence Rubber Co., Wm. Brown and Edwin M. Chaffee, move the court for leave to file the cross-bill herewith presented.
By their Solicitor, A. PAYNE.

And upon a hearing of said motion, leave was granted accordingly; whereupon, on the same day, the following bill in equity was entered:

Bill in Equity.

2 In the United States Circuit Court for the District of Rhode Island.

In Equity.

THE PROVIDENCE RUBBER COMPANY, William W. Brown, Edwin M. Chaffee, and Augustus O. Bourn,
vs.
CHARLES GOODYEAR, Executor of the last will and testament of Charles Goodyear, deceased. The Union Rubber Company and the Phenix Rubber Company.

To the judges of the Circuit Court of the United States for the district of Rhode Island:

The Providence Rubber Company, a corporation duly organized under the laws of the State of Rhode Island, and having its chief place of business in the city of Providence, in said State, and a citizen of said State, William W. Brown, Edwin M. Chaffee, and Augustus O. Brown, respectively, stockholders in and agents and officers of said corporation, and citizens of said State of Rhode Island, bring this their bill of complaint against Charles Goodyear, claiming to be the executor of the last will and testament of Charles Goodyear, deceased; The Union India Rubber Company, claiming to be a corporation duly organized under the laws of the State of New York, and having its chief place of business in the city of New York;

and the Phenix Rubber Company claiming to be a corporation duly organized under the laws of the State of Connecticut, and having its chief place of business in the city of New York.

And thereupon your orators complain and say, that on the 30th day of October, A. D. 1862, the said respondents exhibited in this honorable court their bill of complaint, still pending here, against your orators, wherein and whereby the said respondents, among other things, complain and say that your orators, The Providence Rubber Company and Augustus O. Bourne, William W. Brown, and Edwin M. Chaffee, as principal stockholders and officers and agents of said corporation, either alone or confederating, or engaged with others, so as to elude, if possible, discovery, had been and were, without the license and consent of the complainants in said bill and the respondents herein, or any one having power to give such license or consent, engaged in manufacturing and selling, and procuring to be sold, large quantities of army and navy equipments, made of vulcanized India rubber, and more particularly vulcanized India rubber blankets, coats, cloaks, clothing, ponchos for army and navy and other purposes, and also vulcanized India rubber bulbs, to be used in the manufacture of syringes; which goods, as the complainants therein and the respondents hereto averred the said Union Rubber Company and the said Phenix Rubber Company had the exclusive right to manufacture, and wherein and whereby they pray that your
4 orators may be decreed to account with the complainants in said bill and the respondents hereto, for the quantity of said goods which they had made and sold in violation of the rights of the said complainants in said bill and the respondents hereto, and to pay to said complainants in said bill and the respondents hereto such sums as they might have made by the manufacture and sale of the same quantity of goods themselves, and that your orators might be perpetually enjoined from any further violation of the rights of the complainants in said bill and of the respondents hereto; and for a more full account and description of said bill of complaint your orators pray leave to refer to the record thereof, here remaining in this court, and which, with a copy thereof hereto annexed, marked A, your orators pray may be taken as a part of this their bill of complaint; and your orators aver, that on the 31st day of December, A. D. 1862, they made their answer to the same bill of complaint, wherein and whereby they denied that your orator, The Providence Rubber Company, a corporation, and your orators, the said Bourn, Brown, and Chaffee, as stockholders therein, or as officers or agents thereof, either alone or confederating with others, had been or were then engaged, without the license or consent of the complainants therein and the respondents herein, in manufacturing and selling and procuring to be sold, army and navy equipments, blankets, coats, cloaks, cloth, clothing, ponchos, for army and navy or other purposes,
5 and India rubber bulbs, to be used in the manufacture of syringes, which the complainants therein and the respondents herein alleged in their said bill that they had the exclusive right to make, and they therefore wholly denied all the allegations in that

behalf in the said bill contained, in manner and form as is therein set forth; and they refer to said answer here remaining in the records of this court, and they hereto annex a copy of the same, marked B, and they pray that the same may be made part of this their bill of complaint.

And replication was made by the respondents to said answer of your orators, and proofs were taken in the cause; and thereafterwards an interlocutory decree was entered in said cause, wherein and whereby your orators, The Providence Rubber Company, were adjudged to have infringed the exclusive rights of the complainants under the patent issued to Charles Goodyear, June 15th, 1864; re-issued December 25, 1849; extended June 14th, 1858; and again re-issued to Charles Goodyear, executor, November 20th, 1860, being re-issued No. 1,084, for the new manufacture called vulcanized India rubber; and it was also therein engaged that an absolute injunction issue against the respondents, The Providence Rubber Company, enjoining them, their workmen, officers and agents, and all persons under their control, and each of them, from any further manufacture,
6 use, or sale, of cloth, clothing, coats, cloaks, blankets, ponchos, syringe bulbs, and army and navy equipments made of vulcanized India rubber, or a compound of India rubber in which sulphur is present in any form or degree, such compound, or the fabric made therefrom, having been at any time subjected to the action of artificial heat, that are not made by The Union India Rubber Company, until the further order of the court.

And it was also adjudged that The Providence Rubber Company were liable to account to the complainants therein and the respondents herein, The Union India Rubber Company, The Phenix Rubber Company, for all profits made in violation of their right of the patent aforesaid by the respondents therein and the complainants herein in the manufacture, use, or sale of any or all the articles named in the said bill.

And it was also ordered and adjudged that the cause be referred to Charles Hart, esq., master in chancery, to take an account of the quantity of the articles manufactured, used, or sold by the respondents therein and complainants herein, and all profits made by such manufacture, use or sale, and report the same to the court; and that the respondents therein and complainants herein should produce such books and papers relating thereto as the master should direct; and that the parties have leave to produce and examine witnesses as to the matter of said accounting. And your orators refer to said
7 decree here remaining on the records of this court, and they also annex hereto a copy of the same, marked C, which they pray may be made part hereof.

And upon the coming in of the master's report exceptions were taken thereto, and the cause was recommited to the master with instructions, the court directing that the fourth article of the decree as originally settled be amended by stricking out certain words and inserting in place thereof the words and figures following:

"Whereas the court, in adopting the fourth article of the decree

in this case, did not intend to prescribe any other or different rule of damages than that more clearly and correctly expressed in the third article of the said decree," "Therefore ordered, that the fourth article of the decree be, and the same is hereby, amended by striking out all after the words "respondents" and inserting in place thereof the words following, to wit: "And of all the profits made by the said respondents, in violation of the rights of the complainants, under the patents aforesaid, in such manufacture, use or sale, and report the same to this court with all convenient speed."

"Ordered further that the report of the master in this case be, and the same is hereby, recommitted to him under the original decree as amended, with instructions to report accordingly, as therein directed."

And the said master was also instructed concerning the allowance to be made for the value of raw material and other matters.

8 And your orators refer to the said amended decree and instructions here remaining in the records of this court; and they also annex hereto a copy of the same, marked D, which they pray may be made part of this their bill. And upon the coming in of the second report of the master, exceptions were taken thereto, and have been duly argued by counsel.

And your orators aver, that after the hearing before this honorable court of the exceptions to the said first report of the master they had reason to believe, and did believe, that the complainants in said bill and the respondents herein were united in the allegations therein contained. And had reason to believe, and did believe, that the said Charles Goodyear, claiming to be executor as aforesaid, conceded and admitted that the damages, if any, which should be finally adjudged and decreed against the said Providence Rubber Company would be justly due and payable to the said Union India Rubber Company and the said Phœnix Rubber Co., as is claimed in and by the allegations in said bill of complaint, and such being the case, your orators, the said Providence Rubber Company, were not called upon or interested to raise any question in the premises.

But now, so it is, may it please your honors, that since the said hearing upon the exceptions to the said first report of the master in the said cause they have been informed by the said Charles

9 Goodyear, claiming to be executor, as aforesaid, that he, the said Goodyear, claims that he is the party entitled to secure and be paid the chief portion, if not the whole, of the sums decreed to be paid or accounted for by the defendants in the suit aforesaid, complainant herein; that the allegations in said bill to the effect that the said Union India Rubber Company and the said Phœnix Rubber Company are exclusively entitled to the same, were made without his knowledge or assent, and that said intertlocutory decree was made without his knowledge or assent.

And that on the 28th day of August, A. D. 1866, the said Goodyear made a motion in this cause that the said decree might be amended in accordance with the pleadings and proceedings in said suit and the decision of the court on which the interlocutory decree

was based. The said motion was called up, after notice given by the said Goodyear, on the 19th day of November, 1866; and to said motion here remaining on the records of this court, the defendants refer, and they annex thereto a copy, marked E, which they pray may be made part of this their bill.

And on the said 19th of November, 1866, the said Goodyear made a further motion in said cause that the bill in this case might be amended in several particulars set forth in said motion, and also that he, the said Goodyear, might have leave to appear in the suit by his own solicitor, and also to file a supplemental bill, and for such further relief as to the court might seem proper; and to said last-named motion here remaining on the records of this court, your ora-
10 tors refer, and they annex hereto a copy thereof, marked F, which they pray may be taken as part hereof.

And your orators aver, that they believed that upon said motion last aforesaid such proceedings would be had that the questions raised thereby would be adjudicated upon the pleadings in the said cause, as the same now are, or as they might be amended by the order of this honorable court. But on the 19th day of November, 1866, this honorable court refused to allow the amendments prayed for in the motion last aforesaid, and dismissed the same, and allowed the amendments to the decree prayed for in the said motion first filed as aforesaid; but they refused to allow the said Charles Goodyear to appear by his own solicitor in said cause, or to amend the bill therein, or to file a supplemental bill; and to the orders of the court, here remaining on record, your orators refer, and they hereto annex copies of said orders, marked G, respectively, and which they pray may be taken as part of this their bill.

And your orators are advised and aver, that upon the present state of the pleadings and proofs in said cause, they may be adjudged and decreed to pay full damages to the said Union India Rubber Company and Phœnix Rubber Company, for all the wrongs and
11 injuries complained of in said bill, and remain liable to pay the same damages in some part thereof to the said complainant, Charles Goodyear, claiming to be executor, as aforesaid, which would be to the manifest wrong and injury to your orators.

And your orators are advised and aver, that the appropriate remedy for your orators in the premises is in equity and by this bill of complaint.

And your orators pray that they may refer to and make part of this their bill the whole record of the pleadings, proofs, motions, orders and decrees here remaining on the record of this honorable court in the suit aforesaid.

And your orators aver, that to such portion, if any, of the damages, if any, which the said Providence Rubber Company may finally be adjudged and decreed to pay in said cause, as may be due and payable to the said Charles Goodyear, claiming to be executor as aforesaid, they have in equity and good conscience an offset, to wit, a judgment against the estate of the said Charles Goodyear, deceased, obtained in the Supreme Court of the State of Rhode-Island, at its

March term, A. D. 1858, in favor of E. M. Chaffee & Company, which they now own and hold for the sum of $48,215 20 dollars, which, with interest thereon now due, amounts to the sum of $72,563 87 dollars or thereabouts; and they hereto annex and make part of this their bill, a copy of said judgment and of the evidence of their ownership thereof, marked H, which they pray may taken and made part of this their bill of complaint, and they claim the benefit thereof.

12 To the end, therefore, that the said respondent may severally and under oath answer the premises, and especially that the said Charles Goodyear, claiming to be executor as aforesaid, may, in his said answer set forth whether he claims any portion, and if any, what portion of the damages which the said Providence Rubber Company may finally be adjudged and decreed to pay in said cause, and the facts, if any, upon which said claim is founded.

And that the said Union India Rubber Company and the Phœnix Rubber Company may severally, under the oath of the proper officer of each of said corporations, answer whether they claim the whole damages which the Providence Rubber Company may be finally adjudged and decreed to pay in said cause, and the facts upon which said claim is founded.

And that the said Charles Goodyear, claiming to be executor as aforesaid, may answer and set forth whether the Providence Rubber Company have a judgment against the said Charles Goodyear, deceased, or his estate, as hereinbefore set forth; and that your honors may adjudge and decree what portion, if any, of the damages which the said Providence Rubber Company may finally be adjudged and decreed to pay in said cause, is due and payable to each of the said respondents; and that each and all of the respondents may be enjoined from making any other or further claim upon your orators on account of any of the wrongs and injuries complained of in said bill; and that your orators may have the benefit of the offset

13 of said judgment against such portion of the damages, if any, which the said Providence Rubber Company may be adjudged and decreed to pay, as may [may] be ascertained to be due and payable to said Charles Goodyear, claiming to be executor as aforesaid; and that your orators may have such other and further relief in the premises, as to your honors may seem meet and proper.

May it please your honors to grant unto your orators a writ of subpoena, issuing out of and under the seal of this honorable court, directed to the said defendant, the said Charles Goodyear, claiming to be executor of the last will and testament of Charles Goodyear, deceased, The Union Rubber Company, and the Phoenix Rubber Company, commanding them, and each of them, to be and appear at a certain day before this honorable court to answer the premises, and to stand to and perform and abide such order, direction, and decree as to your honors shall seem meet.

And may it also please your honors to order and direct that service of said subpœna may be made on the said Union India Rubber Company, and the Phoenix Rubber Company, by serving the same upon the solicitor of record in this court, and that service of the same

may be made upon Charles Goodyear, executor, &c., by having the same served on him by some disinterested person in the State of New York, where said Charles Goodyear, executor, &c., resides, and of which he is a citizen,

And your orators will ever pray—

PROVIDENCE RUBBER CO,
14 By AUGUSTUS O. BOURN, *Treasurer.*
AUGUSTIS O. BOURN.
WM. W. BROWN.
EDWIN M. CHAFFEE.

C. CUSHING,
A. PAYNE,
JAMES H. PARSONS, *of Counsel.*
A. PAYNE, *Solicitor.*

[50 ct. stamp.]

On this 27th day of November, A. D. 1866, before me, personally appeared, Augustus O. Bourn, William W. Brown, Edwin M. Chaffee, and the Providence Rubber Company, by its treasurer, Augustus O. Bourn, who, being duly sworn, depose and say that the foregoing bill of complaint by them signed is true, to the best of their knowledge and belief, except as to matters therein stated upon information and belief; and as to those matters, they believe it to be true.

STEPHEN A. COOK, JR., *Public Notary.*

We certify that, in our opinion, this bill is well founded in point of law, and was prepared under instructions from our associate, Mr. Cushing.

A. PAYNE.
JAMES H. PARSONS.

15 We, Augustus O. Bourn, treasurer of the Providence Rubber Company, and we, William W. Brown, Edwin M. Chaffee, and Augustus O. Bourn, on oath, declare and say that we are advised that this bill is well founded in point of law, and that it is not interposed for delay.

AUGUSTUS O. BOURN, *Treasurer, &c.*

AUGUSTUS O. BOURN.
EDWIN M. CHAFFEE.
WM. W. BROWN.

Subscribed and sworn to before me this 27 day of November, A. D. 1866.

STEPHEN A. COOK, JR., *Notary Public.*

16 In the Circuit Court of the United States for the district of Rhode Island.

Exhibit A.—Bill in Equity.—Filed Oct'r 30th, 1862.

CHARLES GOODYEAR, EXECUTOR OF THE LAST will and testament of Charles Goodyear, deceased, The Union India Rubber Company, and The Phoenix Rubber Company,
against
THE PROVIDENCE RUBBER COMPANY, AUGUSTUS O. Bourn, William W. Brown, and Edwin M. Chaffee.

To the judges of the Circuit Court of the United States for the district of Rhode Island:

Charles Goodyear, of the city, county, and State of New York, executor of the last will and testament of Charles Goodyear, deceased, the Union India Rubber Company, a corporation duly organized under the laws of the State of New York, located in the city of New York, and the Phoenix Rubber Company, a corporation duly organized under the laws of the State of Connecticut, bring this their bill of complaint against the Providence Rubber Company, a corporation duly organized under the laws of the State of Rhode Island, Augustus O. Bourn, William W. Brown, and Edwin
17 M. Chaffee, respectively, stockholders in, and agents and officers of, The Providence Rubber Company, at Providence, Rhode Island, citizens of said State; and thereupon your orators complain and say, that, before the 15th day of June, 1844, the said Charles Goodyear, deceased, a citizen of the United States, became and was the first and original inventor of a certain new and useful improvement in India rubber fabrics, which your orators verily believe had not been known or used before his invention thereof, and which was not, at the time of his application for a patent therefor, in public use, or on sale with his consent or allowance, and being such first and original inventor, and being desirous of obtaining an exclusive property in his invention, by him made, the said Goodyear made application in writing therefor to the Commissioner of Patents expressing such desire, and delivered a written description of his invention or discovery, and a specification of improvement by him claimed, whereupon such proceedings were had, that on the 15th day of June 1844, letters patent of the United States, entitled for a new and useful improvement in India rubber fabrics, signed by John C. Calhoun, Secretary of State, and countersigned and sealed with the seal of the Patent Office, by Henry L. Ellsworth, Commissioner of Patents, were issued to the said Charles Goodyear, deceased, in due form of law, granting to him, his heirs, administrators, or assigns, for the term of fourteen years, from the day of the date thereof, the full and exclusive right and liberty of making, constructing, using, and vending to others to be used, the said improve-

ment, a description whereof was annexed to and made a part of the said letters patent.

That afterwards the said Charles Goodyear surrendered the said last-mentioned letters patent to the Commissioner of Patents in due form of law, and in pursuance of the statute in such case made and provided, and such proceedings were had that the said commissioner did, on the 25th day of December, 1849, re-issue to the said Charles Goodyear, deceased, letters patent of the United States, entitled, for "a new and useful improvement in processes for the
18 manufacture of India rubber," signed by Thomas Ewing, Secretary of the State, and countersigned and sealed with the seal of the Patent Office, by Thomas Ewbank, Commissioner of Patents, whereupon there was granted to the said Charles Goodyear, deceased, his heirs, administrators, and assigns, for the term of fourteen years from the 15th day of June, 1844, (that being the date of the said surrendered letters patent,) the full and exclusive right and liberty of making, constructing, using, and vending to others to be used, the said improvement, a description whereof was annexed to and made a part of said re-issued letters patent, as by reference to the same, or to a true copy thereof hereunto annexed, marked "**A,**" **and** making a part of this your orators bill of complaint will more fully and at large appear.

That soon after the granting of the said original letters patent, one Horace H. Day commenced infringing the same, and various suits were brought against him by the said Charles Goodyear, deceased, at law and in equity. A suit was also commenced by the said Charles Goodyear against Ebenezer Seaver and John B. Knowlton, the agents of said Day, for infringing said patent, in the Circuit Court of the United States for the district of Massachusetts, in the year 1845, and said Day and his agents, Seaver and Knowlton, by their pleas, notices and answers, denied that the said Charles Goodyear was the first and original inventor of the improvement described in the said patent of June 15, 1844, and also denied that the said patent was of any validity, for the reasons in said pleas, notices and answers set forth, upon which allegations the parties were at issue; that said suits were pending in said court till the fall of 1846, and for the trial of which preparation had been made on both sides; that said suits were settled on the the application of the said Day, and a written agreement was executed between the said Day and the said Charles Goodyear, whereby said Day agreed, among other things, to pay five thousand dollars for said settlement, and for a license to manufacture certain articles under said patent and other patents of the said
19 Charles Goodyear, and to pay a tariff therefor, and covenanted not to infringe said patent; and said Day then and there acquiesced in the said Charles Goodyear's rights, and acknowledged the validity of said patents, and said sum of five thousand dollars was paid by said Day, and said suits were discontinued, except the said suits against Seaver and Knowlton, agents of said Day, in which a verdict was taken and judgment entered up against them in favor of the said Charles Goodyear, and satisfied, as agreed between the said

Charles Goodyear and the said Day, as by the record thereof ready to be produced will fully appear.

And your orators further show, that soon after said settlement and the discontinuance of said suit, said Day recommenced his infringment of said patent, whereupon the said Charles Goodyear, about the first day of November, 1850, filed his bill against the said Day in the Circuit Court of the United States for the district of New Jersey, setting out the said letters patent and the infringement thereof, praying an injunction and account against the said Day, to which bill of complaint the said Day filed his answer, denying the validity of the said letters patent, and setting up that some other persons than the said Charles Goodyear were the inventors of the thing patented by him, and that the said re-issue to the said Charles Goodyear was fraudulent and void, and that the said Charles Goodyear had no title by reason thereof in his said invention; and issue being joined thereon, the parties proceeded to proofs, which were taken at great length and for a long time.

And your orators further show unto your honors, that the proofs in the said cause being taken, the cause was brought to a final hearing on its merits, at the March term of the Circuit Court of the United States, for the district of New Jersey, in the year 1852, before Justices Grier and Dickerson, and by them held under advisement until the September term next following, when the judgment of the court was pronounced, and opinions delivered, copies whereof are hereunto annexed, marked "B." And the said court then decided that both the said letters patent were valid in law, and that the said Charles Goodyear was the inventor of the improvement patented as aforesaid by him, and referred to in said bill of complaint, and the said re-issued letters patent were lawfully re-issued, and by a decree pronounced in said cause perpetually enjoined the said Day from making, constructing, using, or vending to others to be used, the said improvements, and ordered an account to be taken of the damages due to the said Charles Goodyear, by reason of the infringements of said Day already committed, as by reference to a true copy of the judgement of the court, or to the record of proceedings therein ready to be produced, will more fully and at large appear.

And your orators further show unto your honors, that from the granting of the said letters patent until the hearing of the said cause against Day, the said Charles Goodyear had and enjoyed an exclusive possession and use of the said improvements by himself and his licenses, except so far as the same were disturbed by the said Day and those combined and confederated with him, and by a few other persons who, from time to time, began to violate his rights, but who uniformily acquiesced in them, and submitted to pay tariffs for their enjoyment, when they became acquainted with the said Charles Goodyear's rights, secured by his patent, so far as your orators have been informed and believe.

And your orators further show that the Central Railroad of New Jersey infringed the rights of the said Charles Goodyear, deceased,

by using car springs, made according to the said Goodyears's process and patent, and in violation of said letters patent, and of the exclusive right to use the same in the manufacture of car springs, which had been conveyed to the New England Car Spring Company; and thereupon the said Charles Goodyear and the said Company filed a bill in equity in the Circuit Court for the district of New Jersey, against said Central Railroad, to restrain them from such infringement, and the said Central Railroad appeared and answered to said bill, and denied the said Goodyear's right, and the case came on and was heard before said court, and the said court pronounced a decree in favor of said complainants, and your orators annex a copy of the opinion delivered in said cause, marked "Exhibit C."

21 And your orators further show, that said Goodyear and the New England Car Spring Company filed their bill in equity in the Circuit Court of the United States for the southern district of New York, in or about the month of March, 1852, against Anson G. Phelps and others, to restrain them from the infringement of the said patent by the manufacture and sale of vulcanized rubber car springs, and said Phelps and others put in their appearance to said bill and answered and denied the validity of said patent, and a motion was made for an injunction against the said defendants to restrain them from said infringement; and the same was argued before his honor, Judge Nelson, on the 30th day of May, 1853; and afterwards, on the 25th day of November, 1853, a decision was rendered in favor of the said Charles Goodyear and said complainants, establishing the validity of said patent, and an injunction was granted against said defendants; and your orators annex hereto a copy of said decision, marked "Exhibit D."

Ahd your orators further show unto your honors, that on the 15th day of June, 1858, the Honorable Joseph Holt, Commissioner of Patents of the United States, did, as such commissioner, duly grant to said Goodyear, an extension of said letters patent of June 15, 1844 and re-issued December 25, 1849, for the further term of seven years from the 15th day of June, 1858, and that the certificate and award of such extension were, by the said commissioner, duly endorsed on the letters patent of which such extension was so granted, a copy of which extension is hereto annexed, marked "Exhibit E."

And your orators further show to your honors, that before the said extension, the said Union India Rubber Company, your orators herein held, under certain agreements, rights from the said Charles Goodyear, deceased, authorizing them to make various articles of India rubber according to his process, so as aforesaid patented, and giving them the exclusive right to make army and navy equipments, clothing, cloth and syringes, and other things, according to that process; copies of which agreements are hereunto annexed, marked "Exhibits F, G, H, I, J, K," all of which are still in force and effect.

22 That on the 23d day of April, 1858, and afterwards, on the third day of July and the 28th day of September, 1858, said Charles Goodyear, deceased, for a valuable consideration, executed and delivered to the said Union India Rubber Company certain

agreements continuing such rights, copies of which are hereunto annexed, marked "Exhibits L, M, N." The agreement of April 23, 1858, was recorded in the Patent Office, September, 18, 1858, in Liber X, 4, of Transfers of Patents, page 273, and the agreement of September 28, 1858, was recorded in the Patent Office, December 27, 1858, in Liber B, 5, of Transfers of Patents, page 180.

That all the agreements aforesaid are in full force.

And your orators further aver Charles Goodyear, executor as aforesaid, of his own knowledge, and the said other above-named complainants upon information and belief, that subsequently, to wit, on the first day of July, 1860, said Charles Goodyear, senior, deceased, leaving a last will and testament, which was thereafter duly admitted to probate in the office of the surrogate of the city and county of New York, and your orator, Charles Goodyear, was duly confirmed and appointed as executor of said will, the other named executors therein having declined to serve, and letters testamentary were duly issued to him by said surrogate; copies of said will and probate, and letters testamentary are hereto annexed, marked "Exhibit O."

And your orators further aver, that subsequently and prior to the 20th of November, 1860, your orator, Charles Goodyear, as executor as aforesaid, did, on account of a defective specification, duly and in accordance with the statute in such case made and provided, surrender the said patent for improvement in processes for the manufacture of India rubber for the purpose of having the said defective specification corrected, and the inventions or discoveries therein described separated, and separate patents issued therefor; and that the said Goodyear also paid on such surrender, the further duty of fifteen dollars as by law required, for the re-issue entitled "improvement in the manufacture of caoutchouc," and thirty dol-
23 lars for the re-issue, entitled "improvement in the art of preparing caoutchouc;" and thereupon, on the 20th day of November, 1860, two new patents bearing date the day and year last aforesaid, were duly issued to the said Goodyear, as executor as aforesaid, or his assigns, in two corrected specifications by the said Goodyear duly made and filed, one for an improvement in the manufacture of caoutchouc, and one for an improvement in the art of preparing caoutchouc, each of which last-named letters patent, was issued for the then unexpired term of said extended patent; that is, for the term of twenty-one years from the aforesaid 15th day of June, 1844.

And your orators further aver, that a copy of each of said letters patent, so as aforesaid re-issued to said Goodyear, as executor as aforesaid, one for the improvement in the manufacture of caoutchouc, and another for an improvement in the art of preparing caoutchouc; and of the schedules thereto annexed, is hereto annexed, marked "Exhibits P and Q."

And your orators pray that the same may be taken as as a part of this bill.

And your orators further aver, that the last aforesaid patents so

re-issued, together with the said corrected specification, have the same effect and operation in law as though the same had been originally filed in such corrected form before the issuing of the said original patent, and that each of said patents so re-issued as aforesaid, has the same effect in law as though it had been originally issued for the term of twenty-one years from the said 15th day of June, 1844.

And your orators further show unto your honors, that amongst all persons engaged in the manufacture of India rubber within the United States, the term or phrase vulcanized rubber goods is used and understood to mean the fabric or product made according to said Goodyear's process, patented as aforesaid, and is so used and understood as the designation of all goods made of a compound of India rubber in the original composition whereof sulphur was present in any form or degree, such compound being in that state subjected to
the action of artificial heat, so as to produce the chemical or
24 other changes or effects described in said Goodyear's original and re-issued letters patent, and the specification thereto annexed, and the patents re-issued to Charles Goodyear, executor of Charles Goodyear, deceased, and that the defendants in this bill also do so understand it, and your orators employ such phrase in this bill of complaint in the sense so explained.

And your orators further show, that on the first day of May, 1862, the said Union India Rubber Company, your orators herein, granted unto Warren Ackerman and Nathaniel N. Halstead, composing the firm of Warren Ackerman & Company, their successors and assigns, a full and absolute license to make, use, and vend all articles of Inda rubber which the Union India Rubber Company could make, use, and vend, by virtue of patents, rights, and licenses from Charles Goodyear and others, on record at the Patent Office, and expressed in said grant and license: that it was the intention thereof that the said Warren Ackerman & Company, and their assigns, should possess and enjoy all the rights, privileges, and immunities of the Union India Rubber Company, under and by virtue of all rights and licenses held by it in any and all patents for inventions, processes, and improvements in the manufacture of India rubber fabrics and articles, on certain conditions.

That afterwards, and on the 21st day of July, 1862, the said Warren Ackerman & Company, and the Union India Rubber Company, by an instrument in writing, duly executed, assigned, transferred, and set over to your orators herein, The Phenix Rubber Company, the aforesaid license, with all the rights, privileges, and immunities therein contained, and thereby your orators, the Phenix Rubber Company, became and now are, possessed with the Union Rubber Company of the exclusive right to manufacture certain articles of vulcanized India rubber goods, including the articles above mentioned.

And your orators further show unto yours honors, that the said Union India Company, before said extenion, were, and ever since have been, and now are, engaged under the aforesaid agreement, in
the business of making and selling vulcanized India rubber
25 goods of various kinds, including clothing, coats, cloaks,

blankets, ponchos, syringe bulbs, and army and navy equipments, according to said process of Goodyear, patented as aforesaid, and the extension, renewals, and re-issue thereof, and the Phenix Rubber Company have, since the execution of their license, been, and now are, selling, and are actively engaged in making preparations to manufacture and sell said goods under their license, and according to said process of Goodyear, patented as aforesaid, and the extension, renewals and re-issues thereof.

And your orators further show that injunctions were granted in the Circuit Court of the United States for the southern district of New York, in the years 1860 and 1861, at the several suits of Charles Goodyear, executor as aforesaid, and others, restraining Fertier and Asterbury, Demarest and Middleton, and others of the city of New York, merchants, from selling vulcanized rubber goods, manufactured in violation of the patent of said Charles Goodyear, and of the renewal, re-issue and extension thereof, as aforesaid, and such injuctions remains in full force and effect.

And your orators further show, that in the year 1856, at the November term of the Circuit Court of the United States for the Rhode Island district, a motion was made for an injunction on a bill filed by the said Charles Goodyear, deceased, and others, against George O. Bourn, William W. Brown, and Edwin M. Chaffee, of Providence, Rhode Island, of whom the said William W. Brown and Edwin M. Chaffee are defendants in this bill of complaint, charging said Bourn, Brown, and Chaffee with a violation of the patent granted to Charles Goodyear, on the 15th of June, 1844, for a new and useful improvement in India rubber fabrics, and afterwards re-issued by the Commissioner of Patents on the 25th of December, 1849, upon a surrender of the first patent, and the said defendants resisted said motion on various grounds, affecting the validity of the original and reissued patent.

That his honor, Judge Pitman, before whom said motion was heard, delivered an opinion on the decision of said motion, in which he sustained the validity of said patents, and granted an
26 absolute injunction against said defendants, and your orators refer to the records thereof now on file in this honorable court.

And your orators further show, that the said George O. Bourn, William W. Brown and Edwin M. Chaffe, comprising the firm of Edwin M. Chaffee & Co., obtained since the date of the extension of the patents granted Charles Goodyear, as aforesaid, a license to manufacture vulcanized India rubber boots and shoes, under the patents granted to the said Charles Goodyear, and the renewal, reissues, and extensions thereof, have manufactured and sold vulcanized India and rubber boots and shoes under said license; that said license extends only to the manufacture and sale of India rubber boots and shoes, and not to any of the articles of which your orators have the exclusive right to make, use and vend. And your orators further show, on information and belief, that since the granting of the said license to the said George O. Bourn, William W. Brown, and Edwin

M. Chaffee, the said George O. Bourn has deceased, and that his son, Augustus O. Bourn, is now associated with the aforesaid William W. Brown and Edwin M. Chaffee, and has been ever since the death of the said George O. Bourn, and that the said Augustus O. Bourn, William W. Brown, and Edwin M. Chafice, have been, since the death of the said George O. Bourn, engaged in manufacturing and vending vulcanized India rubber boots and shoes under the aforesaid license, and now claim the right so to do under said license. And your orators further show, that for a long time past the said defendants, The Providence Rubber Company, a corporation, and the defendants, Augustus O. Bourn, William W. Brown, and Edwin M. Chaffee, as principal stockholders, and as officers and agents of such corporation, either alone or confederating, or engaged with others, so as to allude, if possible, discovery, have been, and now are, engaged without the license or consent of your orators, or any one having power or authority to grant a license or give consent in manufacturing and selling, and procuring to be sold, large quantities, but to what amount it is impossible for your orators to say, of army
27 and navy equipments made of vulcanized India rubber, and more particularly vulcanized India rubber blankets, coats, cloaks, cloth. clothing, ponchos for army, navy, and other purposes; and also vulcanized India rubber bulbs to be used in the manufacture of syringes, which goods your orators, The Union India Rubber Company and the Phenix Rubber Company have the exclusive right to manufacture and vend, and [and] have had since the execution of their respective licenses.

That such goods have been made and sold for the profit and advantage of the said defendants and their confederates, and to the manifest injury of your orators.

That all of such goods have been made and sold in violation of your orator's rights, and all of such goods so made by the defendants or the manufacture and sale thereof by them, or their agents, are respectively infringements of the patents of said Charles Goodyear, deceased, and of the renewals, extension and re-issues thereof.

And your orators further show unto unto your honors, that the said defendants, in the making of such goods, used a compound of India rubber, in which sulphur was present when the compound was subjected to the action of artificial heat, so as to produce the aforesaid changes or effects.

And your orators further show, that the said Providence Rubber Company is unlawfully engaged in manufacturing and selling the various goods above described, which your orators, the Union India Rubber Company and the Phenix Rubber Company have the exclusive right to manufacture and vend as aforesaid. That the abovenamed defendant, Augustus O. Bourn, is the treasurer thereof, that the said Bourn, Brown and Chaffee have the management and superintendence of the business of the said Providence Rubber Company, were concerned in organizing the same and procuring and accepting its charter or act of incorporation, and in putting the same into operation, are the principal directors and stockholders therein, are the

agents concerned in conducting its business, and under their directions for the profit and advantage of the said corporation, and of the officers and stockholders thereof, the above-described goods
28 are manufactured and sold. And your orators aver on information and belief, and so charge the fact to be that the said Providence Rubber Company was incorporated and its charter obtained by the said defendants, Bourn, Brown and Chaffee, to enable them to infringe on your orator's rights, and avoid, if possible, being individually responsible for such infringements; and the said Bourn, Brown and Chaffee being such officers, agents, and managers, possess full knowledge of the transactions of said defendant corporation, and are the persons through whom the discovery, under oath, sought in the bill, must be obtained, and upon whom, as such officers of said corporation, the restraining process of this court is specially prayed for by your orators

And your orators further show, that as they are informed and believe, the said defendants threaten to continue making and selling, or making or selling, or causing or procuring to be made and sold, or made or sold, such goods as are above described in this bill of complaint, in violation of your orator's rights; and your orators say that they have been damaged and injured by such acts of the defendants, and apprehend being further injured in future by the repetition or continuance of such acts.

And your orators pray that the several papers heretofore referred to in this bill of complaint, and of which copies are annexed as aforesaid, may be taken as part of such bill, your orators being ready to produce all such documents and papers or certified copies thereof, all which acts or contrary to equity and good conscience, and tend to the manifest injury of your orators in the premises.

In consideration whereof, and forasmuch as your orators can only have adequate relief in this court where matters of this kind are properly cognizable, wherefore your orators pray that the said defendants, The Providence Rubber Company, a corporation, under its comcom seal, and by the oath of its officers, Angustus O. Bourn, William W. Brown, Edwin M. Chaffee, may, upon their corporal oaths, and to the best and utmost of their knowledge, information and
29 belief, full, true, and perfect answers make to all and singular the matters aforesaid, and that as fully as if the same were now repeated, and they severally interrogated thereto, and especially that they may set forth and answer particularly—

First. Whether the said defendants admit or deny the validity of the grant of said letters patent to said Goodyear as re-issued to him as aforesaid, the renewals and extensions thereof on the novelty and utility of the invention so secured by said grant.

Second. Whether the said defendants admit or deny the validity of the re-issue or re-issues to Charles Goodyear, as executor of Charles Goodyear, deceased?

Third. Whether the several suits and complaints were made at the time and manner and against the parties as stated, and whether they resulted as herein set forth.

Fourth. Whether the defendants admit or deny the right and title

of said invention as applied to the manufacture of army and navy equipments, cloths, blankets, coats, cloaks, ponchos, or syringe bulbs, as being in your orators, as set forth in the grants and assignments thereof as herein alleged.

Fifth. Whether the defendants have not made or procured to be made, sold or procured to be sold, and whether they are not now making, or causing to be made, selling or causing to be sold large quantities of India rubber blankets, coats, cloaks, clothing, ponchos, or cloth, or syringe bulbs.

Sixth. What quantity in numbers, dozens or yards of cloth, blankets, cloaks, coats, clothing, ponchos or syringe bulbs, said defendants have made or sold, or procured to be made or sold, and what quantity they have now on hand.

Seventh. Whether such goods, blankets, coats, cloaks, ponchos, cloth, or syringe bulbs, were or are not cured or vulcanized by the application of a high degree of heat in combination with sulphur in some form, or in the presence of sulphur, and a carbonate or other salt or oxide of lead, or in combination with chemical equivalents of some carbonate or other oxide of lead or ingredients in combination producing equivalent products.

Eighth. How, and with what name, have the blankets, cloaks, coats, clothing, ponchos, syringe bulbs, or cloth been stamped or marked, or the cases, boxes, packages, or other things in which they have been inclosed when received and when sent away, been stamped or marked?

Ninth. How said blankets, coats, cloaks, ponchos, clothing, syringe bulbs, or cloth have been stamped as manufactured, and if under any patent or with the name of any maker, under what patent and by what name of maker?

Tenth. How long the said defendants have been engaged in the manufacture of vulcanized India rubber blankets, coats, cloaks, clothing, ponchos, syringe bulbs, or cloth?

Eleventh. Whether said George O. Bourn, William W. Brown, and Edwin M. Chaffee, did not obtain a license under Goodyear's patents to manufacture and vend vulcanized India rubber boots and shoes?

Twelfth. Have not the above-named defendants been and are they not now manufacturing and vending, or manufacturing or vending vulcanized India rubber boots and shoes under said license?

Thirteenth. When was the Providence Rubber Company incorporated and its charter obtained, and from what State or authority, who by name procured and accepted it, who are the corporators named in its charter, who is the president thereof, and who are the stockholders, directors, and managers thereof?

Fourteenth. Whether Augustus O. Bourn is not the treasurer of the Providence Rubber Company, and William W. Brown and Edwin M. Chaffee, the principal directors, stockholders, and managers thereof?

Fifteenth. Whether said defendants have not combined, or confederated, or engaged with others to manufacture or prepare for manu-

facture the above-described goods, and what are the names of the persons or corporations with whom said defendants have so combined, confederated, or engaged?

And that the defendants may answer the premises, and that
31 they may be ordered and decreed to account with your orators for the quantity of said goods which they, or either of them, may have made or sold in violation of the said letters patent, and of the rights of your orators, and to pay your orators such sums as they might have made by the manufacture and sale of the same quantity of goods themselves, and that the said defendants, their agents, or workmen, be perpetually enjoined from any further violation of your orator's rights, and that your orators may have such other or further relief in the premises as may be consistent with equity and good conscience.

May it please your honor to grant unto your orators the writ of injunction, issuing out of, and under the seal of, this court, directed to the said Augustus O. Bourn, William W. Brown, and Edwin M. Chaffee, as officers and agents of the Providence Rubber Company, and the Providence Rubber Company, commanding and strictly enjoining them, and each of them, their workmen, and all persons under the control of said company, its officers and agents, not to manufacture, use, or vend any of the articles above mentioned, made of vulcanized India rubber, that are not made by the Union India Rubber Company, or the Phœnix Rubber Company, or any of such articles made of a compound of India rubber, in which sulphur is present in any form or degree, such compound or the fabric made therefrom, having been at any time subjected to the action of artificial heat, so as to be changed or affected in the manner described in the aforesaid letters patent or specifications, or renewals or re-issues thereof, or so as to have become insensible to heat or cold, or not liable to decompose from the action of essential oils, or animal perspiration; and from making or selling any of the aforesaid articles made from a compound which has been at any time, so vulcanized, or affected, or changed.

Also, the writ of subpœna, issuing out of, and under the seal of,
32 this honorable court, directed to the said defendants, The Providence Rubber Company, Augustus O. Bourn, William W. Brown, Edwin M. Chaffee, commanding them, and each of them, to be and appear at a certain day, before this honorable court, to answer the premises and to stand to, perform, and abide such order, direction, and decree, as to your honor shall seem meet.

May it also please your honor to grant to your orators a provisional or preliminary injunction, issuing out of, and under the seal of, this honorable court, enjoining and restraining the defendants, The Providence Rubber Company, Augustus O. Bourn, William W. Brown, Edwin M. Chaffee, officers and agents of said company, and all other workmen, agents, and other persons connected with said company, to the same purport, tenor, and effect as herein before prayed for, in regard to the aforesaid perpetual injunction.

And your orators will ever pray, &c.

C. S. BRADLEY, *Sol. and Surety for cost.*
WM. CURTIS NOYES, *Of Counsel.*

UNITED STATES OF AMERICA, *State of New York:*

On this 27th day of October, one thousand eight hundred and sixty-two, before me came Henry G. Hadden, who, being by me duly sworn, did depose and say that he was the president of the Union India Rubber Company mentioned in the preceding bill of complaint; that he has heard said bill read, and knows the contents thereof, and that the same is true of his own knowledge, except as to the fact of invention, as stated in said bill, and as to such matters as are therein stated to be on information and belief; and as to such matters, he believes it to be true.

HENRY G. HADDEN.

Sworn to before me this 27th day of October, 1862.

JAMES H. ACKERMAN,
Notary Public, New York City and County.

33 UNITED STATES OF AMERICA, *State of New York:*

On this twenty-seventh day of October, eighteen hundred and sixty-two, before me came Warren Ackerman, who, being by me duly sworn, did depose and say that he was the president of the Phœnix Rubber Company mentioned in the preceding bill of complaint; that he has heard read said bill, and knows the contents thereof, and that the same is true of his own knowledge, except as to the fact of invention as stated in said bill, and as to such matters as are therein stated to be of information and belief; and as to such matters, he believes it to be true.

WARREN ACKERMAN.

Sworn to before me this 27th day of October, 1862.

CHARLES E. JENKINS,
Notary Public, New York City and County.

34 *Exhibit A.*

THE UNITED STATES OF AMERICA:

To all to whom these letters patent shall come:

Whereas Charles Goodyear, of New Haven, Conn., has alleged that he has invented a new and useful improvement in processes for the manufacture of India rubber, (for which letters patent were issued to him, dated June 15, 1844,) and said letters having been surrendered by him on account of a defective specification, and that separate letters patent may be granted to him for the aforesaid improvement, the same have been cancelled and separate letters patent ordered to issue to him on two amended specifications—one for the aforesaid improvement, and another, of even date herewith, for an "Improvement in Felting India Rubber with Cotton Fibre," which, he states, has not been known or used before his application; has made oath that he is a citizen of the United States; that he does verily believe that he is the original and first inventor or discoverer

of the said improvement, and that the same hath not, to the best of his knowledge and belief, been previously known or used; has paid into the Treasury of the United States the sum of fifteen dollars, and presented a petition to the Commissioner of Patents signifying a desire of obtaining an exclusive property in the said improvement, and praying that a patent may be granted for that purpose:

These are, therefore, to grant, according to law, to the said Charles Goodyear, his heirs, administrators, or assigns, for the term of fourteen years from the fifteenth day of June, one thousand eight
35 hundred and forty-four, the full and exclusive right and liberty of making, constructing, using, and vending to others to be used, the said improvement, a description whereof is given in the words of the said Goodyear, in the schedule hereunto annexed, and is made part of these presents.

In testimony whereof, I have caused these letters to be made patent, and the seal of the Patent Office has been hereunto affixed.

Given under my hand, at the city of Washington, this twenty-fifth day of December, in the year of our Lord one thousand eight hundred and forty-nine, and of the independence of the United States of America the seventy-fourth.

[L. S.]

T. EWING,
Secretary of the Interior.

COUNTERSIGNED AND SEALED WITH THE SEAL OF THE PATENT OFFICE.

THOS. EWBANK,
Commissioner of Patents.

The schednle referred to in these letters patent, and making part of the same.

To all to whom these presents shall come:

Be it known that I, Charles Goodyear, now of the city and county of New Haven, and State of Connecticut, have invented certain new and useful improvements in the manner of preparing fabrics of caoutchouc or India rubber, and that the following is a full, clear, and exact description of the principle or character which dis-
36 tinguishes them from all other things before known, and of the manner of making, compounding, and using the same:

Caoutchouc or India rubber, which possesses so many valuable properties in the arts, is, in its native state, useless for many of the most important purposes for which it might be used, for the reason that it will become soft and sticky, and finally dissolve under the action of a moderate decree of heat and its other solvents; and as this substance also hardens and softens within the range of different temperatures of the atmosphere, it is ill adapted to most of the manufacturing purposes. But as it is elastic and water-proof, as well as durable in a high degree, its introduction into a more common use for manufacturing purposes was deemed of great importance.

This led the subscriber to apply all the time and means he could

command, and to persevere in his exertions to discover some method of preparing India rubber by which its melting or softening property should be removed, neutralized, or destroyed, and its good qualities be retained. Seeing the great importance of this object, I early and earnestly directed my attention to it.

By the use of acid solutions, a process for which I obtained letters patent, bearing date the 17th day of June, 1837, I obtained a partial result bearing on my grand object, but not sufficient to render it of general practical utility.

Subsequently it was discovered that the presence of sulphur in the preparation and treatment of India rubber had some effect to improve its qualities for certain purposes; and for this I, as assignee of Nathaniel Hayward, obtained letters patent, bearing date the 24th day of February, 1839.

The leading object of my exertions was to render India rubber capable of resisting the action of heat and cold, within the ranges of atmospheric temperature. On reflecting on this subject, I became impressed with the idea that, in the process of preparation of India rubber, it might be beneficially treated with heat at some degree beyond the highest degree of temperature in which the fabric
37 would be used or exposed, and that such treatment might so change and alter it as to cause it to resist, successfully, all changes of temperature below that under which it was prepared.

To this end I instituted and carried on a series of experiments, and finally accomplished the desired end, viz: that of rendering caoutchouc or India rubber proof against the action of heat and cold below the temperature under which it is cured, and also, for all practical purposes, against the action of all its known solvents.

But as this substance, when subjected to heat by itself, could not be cured or deprived of its sticky or soluble properties, I was led to experiment upon it in connection with other substances, and found that when subjected to the action of a high degree of artificial heat, in connection with some other substance or substances, I could effect this important object. When compounded with sulphur, by the application of a high degree of artificial heat, I obtained good results, and when compounded with sulphur and the carbonate of lead, I obtained the best results; but I found, during my experiments with numerous substances, that whatever substance or substances be used in connection with the India rubber, the grand result sought after could not be obtained without the action of a high degree of artificial heat, which is the great agent in my method of curing.

In view of the peculiar properties of this substance, and the object to be gained, the nature of the first part of my invention consists in curing caoutchouc or India rubber, when combined with or in the presence of sulphur, by submitting the same to the action of a high degree of artificial heat, at a temperature above solar heat, say from 212° to 350°, or thereabouts, whereby this substance becomes so changed in its properties as to resist, without material change, the variations of temperature below that under which it is cured, and

also the action of the expressed and essential oils and its other known solvents.

And the second part of my invention consists in preparing and curing the triple compound of caoutchouc or India rubber,
38 sulphur, and a carbonate or other salt or oxyd of lead, for the purposes above pointed out.

To enable others skilled in the arts most nearly allied to this, to prepare caoutchouc or India rubber after my improved plan, I will here describe the mode of proceedure by which I have been enabled to obtain the best results.

The articles which I combine with the India rubber in forming my improved fabric are sulphur and white lead, which materials may be employed in varying proportions, but that which I have found to answer best, and to which it is desirable to approximate in forming the compound, is as follows :

I take twenty-five parts, by weight, of India rubber, five parts of sulphur, and seven parts of white lead. The India rubber I usually dissolve in spirits of turpentine, or other essential oils, and the white lead and sulphur also I grind in the ordinary way of grinding paint. These three articles, when thus prepared, may, when it is desired to form a sheet by itself, be evenly spread upon any smooth surface, or upon glazed cloth, from which it may be readily separated, but I prefer to use for this purpose the cloth made according to the present specification, as the compound spread upon this article separates therefrom more cleanly than from any other. Instead of dissolving the India rubber in the manner above set forth, and the sulphur and white lead prepared as above directed, they may be incorporated with the substance of the Indian rubber, by the aid of heated cylinders, or callender rollers, by which it may be brought into sheets of any required thickness, or it may be applied so as to adhere to the surface of cloth or of leather of various kinds. This mode of applying and producing the sheet caoutchouc, by means of rollers, is well known to manufacturers. To destroy the odor of sulphur in fabrics thus prepared, I wash the surface with a solution of potash, or with vinegar, or with a small portion of essential oil or other solvent of sulphur.

When the India rubber is spread upon the firmer kinds of cloth, or of leather, it is subject to peel therefrom by a moderate
39 degree of force, the gum letting go the fibre by which the two are held together. I have, therefore, devised another improvement in the manufacture, not herein claimed, by which this tendency is, in a great measure, corrected, and by which also the sheet gum, when not attached to cloth or leather, is [is] better adapted to a variety of purposes, than when not prepared by this improved mode, which is as follows:

After laying a coat of gum, composed as above set forth, on any suitable fabric, I cover it with a bat of cotton wool, as it is delivered from the doffer of a carding machine, and this bat I cover with another coat of gum, a process which may be repeated two or three times, according to the required thickness of the goods.

When this compound of India rubber, sulphur, and white lead, whether to be used alone in the state of sheets, or applied to the surface of any other fabric, has fully dried, either in a heated room or by exposure to the sun and air, the goods are to be subjected to the action of a high degree of artificial heat, which will admit of considerable variation, according to the thickness and previous preparation of the articles to be treated, say from 212° to 350° of Fahrenheit's thermometer, but, for the best effect, approaching as near as may be to 270°. As a general rule, the usual kinds of fabrics should be exposed to this artificial heat from two to six hours, dependent on the thickness of the sheet of gum and the proportions of the compound. The greater the proportion of lead in the compound employed, usually the shorter time required to cure it. The temperature should be gradually raised to the maximum to avoid blistering. The operator should, from time to time, examine the goods while under treatment, to ascertain whether they have been sufficiently cured, and should be careful to avoid the blistering which will frequently take place, if the heat be applied too suddenly.

The heating process may be effected by running the fabrics over a heated cylinder, but I prefer to expose them to an atmosphere of artificial heat, of the proper temperature, which may be best done by the aid of an oven properly constructed, and when for cloths, with openings, through the sides of which the sheets of India rubber, or web of cloth, may be passed by means of suitable rollers; but the operator may communicate the heat in any suitable manner or form.

When this process is performed upon the above compound, it must be allowed to remain upon the cloth upon which it is placed in order to sustain it, as the compound so far softens during the operation as not to be capable of supporting its weight without such aid. If the exposure be to a temperature exceeding 270°, it must continue for a very brief period.

Any other mode of reducing and dissolving the India rubber, and compounding it with the other substances, may be substituted for that above described; and, although I have described the compound as consisting of India rubber, sulphur, and white lead, I do not mean to limit myself to this compound, when a high degree of artificial heat is used, as good results may be and have been obtained by me, by dispensing with the lead, and it is immaterial, so far as regards the principle of my invention, whether the sulphur is incorporated with the India rubber by admixture in the solid form, or spread on the surface thereof, or combined therewith in the gaseous or other form, previous to or during the process of curing by heat.

The leading feature of my invention, and that which chiefly constitutes the substance or essence of its usefulness, is the discovery of the effects produced on India rubber by the action of artificial heat, at a temperature above that to which the fabric would be exposed in ordinary or common use.

Although I have, above, only described the mode of preparing and curing sheets of India rubber, it will be obvious that my method of curing is applicable to articles of any desired form.

What I claim as my invention, and desire to secure by letters patent, is the curing of caoutchouc or India rubber by subjecting it to the action of a high degree of artificial heat, substantially as herein described, and for the purpose specified.

41 And I also claim the preparing and curing the compound of India rubber, sulphur, and a carbonate or other salt, or oxyd of lead, by subjecting the same to the action of artificial heat, substantially as herein described.

CHARLES GOODYEAR.

Witness:
SETH P. STAPLES.
CHS. M. KELLER.

42 In the Circuit Court of the United States, district of New Jersey.—May term, 1852.

Exhibit B.—Bill in equity heard on pleadings and proofs.

CHARLES GOODYEAR
vs.
HORACE H. DAY.

Grier, J.—The bill in this case sets forth that, since 1843, Charles Goodyear has been, and now is, the owner of certain new and useful improvements in the preparation of India rubber for manufacturing purposes, by which the properties of this substance are greatly changed and improved. It is rendered insensible to heat and cold, within certain degrees of temperature. Its clammy and sticky character is taken away, and it is made proof against the effects of fat and grease, or expressed oils, while the strength, elasticity, and other good qualities of the original substance are retained and improved.

That these improvements were secured to complainant by letters patent—the first, dated 24th of February, 1839, on a discovery of Nathaniel Hayward, of Woburn, Mass., assigned by him to Goodyear. This patent was for the application of sulphur in the curing of India rubber. After this, the complainant, Goodyear, in 1840, commenced, and continued for several years, his experiments on India rubber, in order to discover some method of rendering this substance insensible to cold and heat, and freeing it from the

43 clammy properties which injured the use and sale of goods theretofore manufactured from it. For want of these qualities, all the manufacturers of this substance have heretofore failed, and many been ruined.

That, struggling under many discouragements and difficulties, from his poverty and want of means, he continued his experiments for two or three years; and after repeated failures, and much less of time and materials, in the latter part of the year 1843, he discovered that, by applying a very high degree of artificial heat, (from 250 degrees to 300 degrees of Fahrenheit,) to the substance, when compounded with certain proportions of sulphur and carbonate of lead, or metallic basis, the qualities so much desired would be imparted to it.

That, for this discovery or improvement in the art of manufacturing India rubber, he obtained a patent on the 15th of June, 1844.

This patent, owing to defects in its specifications, was surrendered, and another issued on the 25th of December, 1849, with an amended and more perfect specification.

That, about the time the patent of 1844 was obtained, the complainant sold to David L. Suydam, of New York, the right to use said discovery and improvement in the manufacture of shirred or corrugated goods, for which license said Suydam agreed to pay the sum of $15,000.

That, soon after Suydam had commenced manufacturing shirred goods, the respondent, Day, commenced the same business, in violation and disregard of the rights granted by said patent to Goodyear.

That Day, by overstocking the market with an inferior article, and denying the validity of said patents, so annoyed, vexed and discouraged said Suydam, that he refused to go on with his contract, or to pay the $15,000, and re-transferred his license to complainant. That suits at law and in equity were instituted against Day and his agents, both in New York and Boston. To these suits Day set up, as a defence, that said patents were void, because Hayward and Goodyear were not the inventors or discoverers of the improvements set
44 forth therein. That, after much preparation made on both sides for trial of these issues, at November term, 1846, Day applied to Goodyear to settle and discontinue the suits, offering to confess judgment on one of them, to pay $5,000 damages, and buy from Goodyear a license for the exclusive manufacture of shirred goods under said patents, to pay three cents per yard, and stamp the goods with Goodyear's name, and not to make any other article to infringe the patents. That these terms were accepted, articles of agreement executed, and all the suits discontinued and released by complainant, except one on which judgment was entered in favor of the plaintiff, which was satisfied by the payment of the said $5,000 damages by Day. Since that time Day, in utter disregard of his contract, and of the rights secured to complainant by said patents, has commenced to manufacture other articles than shirred goods, and sell them in large quantities, to the great injury of the complainant.

The bill prays that the defendant may render an account of the articles made and sold by the respondent, in disregard of the patents of complainant, and not included in the license from him to defendant; and for an injunction against Day, restraining him from the further infringement and violation of said patents.

The defendant, Day, in his answer, denies—

1st. That Goodyear is the owner of any new and useful improvements, as claimed by the bill.

2d. Admits a patent was granted for an invention of Hayward's, but denies that it vested in Goodyear any exclusive right to the use of sulphur in the manufacture of India rubber goods, for that the invention of Hayward was in public use, with his consent and allowance, before the application for a patent.

3d. He denies that Goodyear was the first inventor or discoverer

of the beneficial effects of a high degree of heat applied to India rubber.

4th. The answer then sets forth, in hæc verba, the patent
45 to Goodyear of 15th June, 1844, and proceeds to enumerate various companies and individuals, who are alleged to have manufactured India rubber with sulphur, white lead, and a high degree of heat.

5th. Without denying directly the infringement, by defendant, of complainant's patents, the answer alleges that he has not used in the manufacture of India rubber goods a combination of gum, sulphur, and white lead, in the proportions claimed specially in said letters patent.

6th. The answer proceeds to deny that Goodyear is the inventor of shirred or corrugated goods, and proceeds to name others who made and used them. As the bill has no such charge or allegation, this part of the answer need not be further noticed.

7th. That complainant, in 1849, surrendered his patent of 1844, and took out two new patents, one for an improvement in felting India rubber with cotton fibre; that both the re-issued patents are void, for various reasons set forth at length.

8th. The answer repeats frequently that the defendant used all the combinations of the patent of 1844 more than two years before that time; and enumerates some twelve patents, the use of which he has purchased, and alleges that the re-issued patent of complainant interferes with some of them.

9th. The answer admits the suits brought against defendant for infringement of Goodyear's patents; the settlement and discontinuance of said suits, and sets forth the articles of agreement executed by the parties at length, taking some collateral issues as to some immaterial circumstances connected therewith, which need not be mentioned.

10th. That Goodyear willfully and fraudulently deceived the defendant, to induce him to enter into the said agreement, giving no other reason for the assertion, however, than that William Judson was a part owner of Goodyear's patents at the time.

11th. That William Judson, James A. Dorr and John Has-
46 kins, are parties in interest, and should be made parties complainant.

12th. That Goodyear did not protect defendant in the exclusive rights guaranteed to him by the agreements.

13th. That when this agreement was made, the defendant "meant to reserve his right" to manufacture in any way he pleased the moment Goodyear failed to protect him in the exclusive right of manufacturing shirred goods; and because this was done, had "repudiated his said contracts," and pleads such repudiation in bar of this bill.

14th. That complainant is barred from recovering the tariff covenanted in the articles to be paid on shirred goods, up to 1st of January, 1849, by a verdict and judgment at law in a suit tried in this court.

15th. That Goodyear's patent, of 1864, was invalid, by reason of combining two separate inventions—one for rubber compound, the other for felting cloth, (the latter of no value;) that the claim in the patent of 1849 is fraudulent, because it claims the "application of heat to the curing of rubber;" that by this surrendered and fraudulent renewal of his patent Goodyear has annulled said articles of agreement.

16th. That the defendant has not used the compound described in Goodyear's patents of 1844 and 1840, but has used other and better compounds.

17th. The answer concludes by praying "a trial by jury of the various issues of fact formed by it."

If the value of the subject-matter in controversy in this case be in any measure proportionate to the amount of costs and expenses, the number of volumes of printed record, the number and eminence of the counsel, or the zeal and ability displayed in the argument, it must be one of great importance to the parties in its results, if not in its principles.

Numerous points, both of fact and law, have been argued and submitted by the counsel, many of which might have been avoided, if such had been the desire of the complainant, by the form of
47 the bill. Much of the answer, also, is occupied with matter either wholly irrelevant, or merely tending to evade the consideration of the case.

We shall, therefore, only notice such points stated in the answer as have been relied on in the argument, without further criticism of the pleadings than to say, that the defendant is not estopped from denying the validity of complainant's patents, although he would have been if the bill had contained proper averments.

I. The first question in their natural order for our consideration is, whether the bill should be dismissed for want of proper parties. It has been contended that this bill should be dismissed, because John Haskins, William Judson, and James A. Dorr have not been made parties.

Haskins was but a mere license of the complainant; and although such licensees may be benefited indirectly by a decree in favor of complainant, they are not necessary parties. Besides, the agreement with Haskins, if not surrendered to plaintiff, has been long abandoned, and cannot be invoked to affect the merits of this case in any manner.

The assignments to Dorr and Judson contain certain words, which, if taken alone, would convey a legal title to certain undivided interests in the patents; but when we examine the whole instrument, it clearly appears that the intention of the parties was not to convey the legal title to any portion of the patent. It reserves the whole and sole power of disposal, and, consequently, title to Goodyear. Dorr and Johnson are cestui que trusts, entitled to a share of the profits made by such sales. The defendant has met with Goodyear. Dorr and Judson are no parties to the contract. The injunction, if decreed, may be beneficial to them, and they may be entitled to a

share of the damages recovered in their settlement with Goodyear. We do not think that they are necessary as parties, in order that the court may make a full and final decree. They were present in court; are willing to be made parties on the record, if necessary; and if any difficulty should be anticipated on that subject, the court will suspend the decree till they are made parties, and consent to
48 be bound by it.—[See Story on eq. pl. §237.

We do not, therefore, consider this difficulty such a one as should stand in the way of our procceding to a final decree in this case.

II. Another objection on which the defendant resists the decree for an injunction is, that the complainant has not established his title at law. It has been urged by the counsel for defendant that the verdict of a jury on the question of the validity of a patent is absolutely required by the practice of courts of chancery, before granting a final injunction; and that this is a right or privilege which the court is bound to accord to the defendant, when the answer takes issue on this point.

It is true, that in England the chancellor will, generally, not grant a final and perpetual injunction in patent cases, when the answer denies the validity of the patent, without sending the parties to law to have that question decided. But even there the rule is not absolute or universal; it is a practice founded more on convenience than necessity. It always rests on the sound discretion of the court. A trial by law is ordered by a chancellor to inform his conscience; not because either party may demand it as a right, or that a court of equity is incompetent to judge of questions of fact, or of legal titles.

In the courts of the United States the practice is by no means so general as in England, or as it would be here, if the trouble of trying issues at law devolved upon a different court.

Cases involving inquiries into the most complex and difficult questions of mechanics and philosophy, are becoming numerous in the courts. Often questions of originality and infringement of patents do not depend so much on the credibility of witnesses, or the weight of oral testimony, as on the application of principles of science and law to admitted facts. It is true that, in matters of opinion, both mechanics and learned professors will differ widely. But still the question is not to be decided by the number, credibility, or respectability of such witnesses, but by the force and weight of the reasons given for their respective opinions. It is no reflection on trial
49 by jury to say, that cases frequently occur in which ten out of twelve jurors do not understand the principles of science, mathematics, or philosophy, necessary to a correct judgment of the case. Besides, much of the time of the courts is lost where twelve men will not agree on any verdict; or when they have agreed, the conscience of the chancellor, instead of being enlightened, rejects it altogether.

A select or special jury of philosophers, if they could be got, would, perhaps, not prove more satisfactory, or obviate the difficulty.

In the late case, involving the validity or Morse's telegraph patents, which was heard in Philadelphia, a final injunction was decreed without a verdict to establish the patents; and many other cases might be cited from other circuits, if necessary, in support of this practice, showing that the courts of the United States do not always consider it a proper exercise of their discretion to order such issues to be tried at law before granting a final injunction.

In the present case there are many reasons why the court will not thus exercise their discretion:

1st. Because this case has been set down for final hearing on the exhibits and proofs, without any motion or order of the court for such an issue.

2d. After a patient hearing of very able counsel, and a careful consideration of the testimony, the court feel no doubt or difficulty on these questions which would be removed or confirmed by a verdict.

3d. It would require three or four weeks at least to try this case before a jury, if this library of testimony were read to them; and at least as many months if the witnesses were examined viva voce, as they probably would be; and after all this expenditure of time and labor, it is even more than probable that, from the confusion created by the great length of the testimony and argument in court, or the force and effect of those urged from without, no verdict would be obtained, and most certainly none that would alter the present conviction of the court.

50 4th. But even if it were the right of the defendant to demand such an issue in ordinary cases, there are sufficient reasons why it should not be accorded in this.

This defendant commenced his infringement of the plaintiff's patents soon after they were issued. Actions of law were brought against him and his agents; the cases were prepared for trial; the defendant found he could not defend himself, and he agreed to give judgment on one of the suits; he paid damages for his infringements; he purchased a license to use plaintiff's discovery in the manufacture of shirred goods; he covenanted not to use it in the manufacture of any other than the articles specified in his license; he does not allege any mistake or misrepresentation, or the discovery of any new evidence or fact since that time, or that any one but himself disputes the complainant's rights, or invades them with impunity. All these facts are apparent on the face of the pleadings, and do not entitle the defendant to any claim of favor in the use of our discretion, or to any action of the court which will add to its enormous expenses and greatly protract the results of this suit.

III. Without requiring the aid of a jury, we shall, therefore, proceed to examine the questions, both of fact and law, which affect the validity of complainant's patents.

The patents are themselves sufficient prima facie evidence that the patentees were the original inventors or discoverers of the things patented, and that the same are new and useful. Since the patent act of 1836 the Commissioner of the Patent Office acts quasi judicially

on these subjects. He is bound to inquire and decide them before granting a patent; but, as they proceed ex parte, their action is not conclusive on those who were not parties to the proceeding. The burden of proof, therefore, lies on the defendant to show that any other persons than Hayward and Goodyear were the original inventors or discoverers of the things patented.

To give a history of the various experiments on the substance called caoutchouc or India rubber, and of their success or
51 failure, previous to those of Hayward and Goodyear, or to notice particularly the testimony of each of the hundred witnesses who have been examined, would require us to add another to the numerous volumes which already encumber this case. Being unwilling to inflict on ourselves the labor of writing, and on others that of hearing or reading such a treatise, we shall not attempt to vindicate the correctness of our decision by analyzing the testimony, and arraying the volume, page and folio, which justifies our conclusions, but shall merely state the results to which we have arrived after careful consideration of the whole case.

Previous to the years 1834 and '35 many experiments had been made and much capital expended in attempts to manufacture caoutchouc or India rubber, or rather to employ it in the manufacture of various articles for the purpose of imparting to them the peculiar quality of this substance. All attempts to do this in a satisfactory manner had been, in a great measure, if not wholly, unsucessful. The defects in the article manufactured on the various plans and discoveries thus far made, were such as to destroy their value in market. The goods became clammy and sticky by heat; they were made hard and stiff by cold. It is true that in this variety of experiments and failures many facts and processes had been discovered which were partially beneficial; but the great and important fact that India rubber could, by any treatment or combination, be made to assume the peculiar and valuable qualities now known to be possessed by the material or substance called "vulcanized India rubber," had not been discovered.

About this time Goodyear commenced his experiments. For a long time he was unsuccessful. He spent his mony, his time, his credit. His family was reduced to poverty and himself immured in a prison; yet, still he persisted. And finally, his faith and energy were rewarded by the discovery, the value of which this controversy most abundantly proves. As we know a substance only by its qual-
52 ities, he may be said to have discovered a new substance; or, at least, the fact that India rubber, by certain combinations and manipulations, could be made to assume certain valuable qualities which it did not before possess, and the mode of imparting them.

Previous to this time Nathaniel Hayward had discovered that sulphur could be used to great advantage in drying the rubber, and had assigned his right to this discovery to Goodyear, and a patent had been issued.

It was not till 1844, when Goodyear had perfected his invention by continued experiments, that he obtained a patent. This patent was

afterwards found to be defective, and was surrendered and cancelled, and a new one granted in 1849.

As the answer does not put in issue the originality of Hayward's discovery, we need not notice it further at present than to say, that, notwithstanding the attempt to controvert this fact on the argument from certain testimony in the case, it was wholly unsuccessful. The defendant need not regret the candor of his answer in admitting it.

The question now under consideration is, therefore, whether any other person had succeeded in discovering and perfecting the peculiar process or manufacture claimed in the patent of 1844 and 1849, before Charles Goodyear? Was "vulcanized India rubber," as now known in the arts, known and the process of manufacturing it perfected before Charles Goodyear made known his discovery, and had perfected it by experiment?

The testimony shows that many persons had made experiments; that they had used sulphur, lead, and heat before Goodyear's patents, and probably before his discovery. But to what purpose? Their experiments ended in discovering nothing, except, perhaps, that they had ruined themselves. The great difference between them and Goodyear is, that he persisted in his experiments and finally succeeded in perfecting a valuable discovery, and they failed. It is usually the case, when any valuable discovery is made, or any new machine of great utility has been invented, that the attention of the public has been turned to that subject previously, and that
53 many persons have been making researches and experiments. Philosophers and mechanicians may have in some measure anticipated, in their speculation, the possibility or probality of such discovery or invention; many experiments may have been unsuccessfully tried, coming very near, yet falling short of the desired result. They have produced nothing beneficial. The invention, when perfected, may truly be said to be the culminating point of many experiments, not only by the inventor, but by many others. He may have profited indirectly by the unsuccessful experiments and failures of others, but it gives them no right to claim a share of the honor or the profit of the successful inventor. It is when speculation has been reduced to practice, when experiment has resulted in discovery, and when that discovery has been perfected by patient and continued experiments; when some new compound, art, manufacture, or machine has been thus produced, which is useful to the public, that the party making it becomes a public benefactor, and entitled to a patent.

And yet, when genius and patient perseverence have at length succeeded, in spite of sneers and scoffs, in perfecting some valuable invention or discovery, how seldom is it followed by reward! Envy robs him of the honor, while speculators, swindlers, and pirates rob him of the profits. Every unsuccessful experimenter who did, or did not, come very near making the discovery, now claims it. Every one who can invent an improvement, or vary its form, claims the right to pirate the original discovery. We need not summon Morse, or Blanchard, or Woodworth to prove that this is the usual history of every great discovery or invention.

The present case adds another chapter to this long and uniform history. Every man who has made experiments with India rubber, sulphur, lead, or any other substance; who has heated them in a stove or furnace; who has annoyed his family and his neighbors with sulphurous gas; who has set up a rubber factory and failed; who has made India rubber goods that no one would buy, or, if bought, were returned as worthless; in fine, all who have ceased their experiments and endeavors, because they had not discovered that such qualities could be given to that substance, are now paraded forth as the inventors and discoverers of vulcanized India rubber. It is but just to many of these persons to say, that they themselves have made no such claim. It has been now for the first time made for them by the defendant, who appears to have discovered, at length, that he himself was probably the inventor—a fact which appears to have been unknown to him in 1846, when actions were first brought against him for pirating this discovery; a fact, also, which others are more ready to prove than himself to assert. Notwithstanding the indomitable energy and perseverance with which this attempt to invalidate the patent has been pursued, the volumes of the testimony with which it is oppressed, and the great ability with which it has been canvassed in the argument, we are of opinion that the defendant has most signally failed in the attempt to show that himself, or any other person, discovered and perfected the process of manufacturing vulcanized India rubber before Charles Goodyear.

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The testimony about Collins, which has been most relied on in the argument, contains much internal evidence of falsehood; it proves too much, and too little; it is felo de se. Yet, assuming it to be true, it amounts to no more than this: that he had used the ingredients of sulphur, white lead, &c., in connection with the rubber; that he had heated them; that he may have had some partial success, which, if pursued with perseverance and judgment, might have resulted in the discovery of vulcanized rubber. He may possibly have been so near the discovery as to stumble over it. Yet he never went on to perfect his experiments. They were abandoned without a successful result. Every factory that employed him, and purchased his services or his secret, failed. No goods of "vulcanized India rubber" made by him, or in the factories that employed him, have survived to prove his success. Time, which devours all things, may be presumed not yet to have digested or destroyed all vulcanized rubber supposed to have been made (if it ever had been made) by Collins and the various other pretenders.

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The sum of the evidence, so industriously collected, appears to be this, and this only. Others have made experiments; they have tried sulpur, white lead, and a high degree of heat, and have failed to perfect any valuable discovery. Goodyear has used these elements, and perfected a valuable art. They have failed; he has succeeded.

IV. The objection that the patents to Goodyear are invalid, because both Hayward and himself had severally abandoned their discoveries to the public, is not sustained.

The question of abandonment to the public must always depend, in a great measure, on the peculiar nature of the subject-matter. The mere sale of a peculiar manufacture which does not, on its face, disclose the nature of the compound, or the mode of producing it, is not such an abandonment. That India rubber could be treated so as to have the qualities that it is now known to possess in its "vulcanized state, could not be discovered by any reasoning a priori. Those acquainted with the subject might conjecture, hope, or believe, that such a thing might be discovered; but the discovery must necessarily be empirical—the result of time, experiment, or chance, of patient attention to phenomena exhibited, and results obtained. And when the fact of possibility is at length established, the best mode of obtaining the given result must be tested by frequent and patient experiment and observation.

The compound or substance called "vulcanized India rubber" was of no actual value per se, but only as it could be made to enter into the manufacture of other articles, and communicate its peculiar qualities to them. How those articles would retain those qualities in use, and command a market, could be tested only by time and experience. Neither Hayward nor Goodyear would have been justified in shouting "Eureka," and claiming a patent on the first appearance of success in their respective experiments. Goodyear exhibited the
56 substance discovered by him, and some goods manufactured with it, in England, in 1843. He sold some of the goods here. But he did not disclose to the public, either there or here, the method of compounding his material, or what constituted his real secret or discovery, An exhibition of the manufactured articles did not disclose it, except that from the smell it might be inferred that sulphur had been somehow used in its concoction. Hancock, who obtained a patent in England for the same discovery, had seen Goodyear's articles, and thus ascertained that such a material could be made, but not the mode of effecting it. His patent was held valid by the English courts, on the ground that, although Goodyear had first made the discovery in America, he had not abandoned it to the public by the sale of the manufactured articles; and that the use of the manufacture was not the use of the invention, as the material itself did not disclose the means of making it; and that, therefore, Hancock was entitled to be considered an original inventor.

It is true that discoverers might sometimes deal unfairly with the public, by enjoying their monopoly so long as their process remained secret, and seeking a patent only when it was in danger of discovery. How far such conduct might invalidate a patent will be decided when such a case arises. It is sufficient for the purposes of the present case, that we say that the evidence does not show an abandonment of the processes patented to the public; or that the patentees delayed longer to take out their patents than was justifiable under the peculiar circumstances of the case.

V. We now come to the objections which have been made to the re-issued or amended patent of 1849.

1st. The first objection is, that the patents of 1844 and 1849 are not for the same invention.

This objection is not founded on fact. Both the patents are for precisely the same invention or discovery. They both describe, in nearly the same words, the best mode of manufacturing India rubber, by exposing it to high degree of heat in connection with
57 sulphur and white lead; by which treatment the substance is endowed with new and valuable qualities which it did not possess before. The discovery is the same; the mode of manufacturing the compound is the same.

The first patent had set forth the nature and extent of the invention defectively. There is no reason to doubt the bona fides and propriety of the re-issue. It is apparent on the face of the papers, even if the action of the commissioner on that point was not conclusive.

2d. The objection, "that the description in the specification is obscure and insufficient," is an assertion wholly unsupported by any testimony in the cause.

3d. The objection, "that rubber and sulphur cannot be vulcanized in a heated atmosphere," is not only irrelevant, but unsupported by the evidence. That some persons have not succeeded, while others have, is no proof of its impossibility.

4th. The fourth objection is, "that the latter patent claims more than was described in the original." If the latter patent is for precisely the same invention, art, or discovery, as that described in the first, the objection that it claims more, is a mistake of fact. If the last patent differs from the first only in stating more clearly and definitely the real principles of the invention, so that those who wish to pirate it may not be allowed to escape with impunity through the imperfection of the language used in the first, then has arisen one of the cases for which it was the intention of the act of Congress to provide, and the objection is worthless in point of law.

5th. It is claimed, also, that the re-issued patent is void, because the things claimed in the original were in public use in the interval between the issue of the original and the re-issue, and were, therefore, dedicated to the public, and cannot be resumed by the re-issue.

This objection is founded on an assumption of law which cannot be conceded. It assumes that the publication of a discovery or invention by a defective patent, is a dedication or abandonment of it to the public. If such be the case, the permission given by
58 the act to re-isue a patent, on account of defects, is of little value, and a snare to inventors. The most skillful and ingenious inventor is seldom able to draw up a valid specification of his invention, and not many lawyers have sufficient experience and knowledge, both scientific and legal, to do it for him. The original patents, for some of the most valuable modern inventions now known, have been afterwards discovered to be insufficient, and the patents have been renewed, with specification setting forth, not a different or improved machine, but the same machine or invention, and a corrected statement of what is the true nature and extent of the

patentee's claim. Every specification or claim, which correctly sets forth the true nature and full extent of an invention, may be said to be broader than the one which fails to do it. To decide that such a difference would vitiate the last patent, or that the original mistake had amounted to a dedication to the public of everything not correctly claimed in the specification, would leave the rights of inventors in a most precarious situation, and the right given to amend their patents a mere illusion.

The original patent of Woodworth, issued in 1828, was most palpably defective and worthless. It was renewed in 1845, and the true nature and extent of his claim correctly set forth. The court decided that the renewed patent was valid, because it was for the same invention; and that the question to be decided was not whether the last patent differed from the first in the extent of the claim or statement of the distinctive principle of the invention, provided it claimed nothing more than the same machine. The right to amend the description of the claim, so as to make the patent a valid grant of the real invention to its full and true extent, is what the law intended to confer on the inventor. The mistake of claiming too little, in the original patent, has an equal claim to correction with that of claiming too much.

The case lately decided at Philadelphia, about the machines for breaking and screening coal, has no application to the present.

The renewed patent, in that case, was for a different ma-
59 chine from that described and claimed in the original; and the machine claimed and described in the last patent had been abandoned to the public for many years. But in this case, the art of manufacturing vulcanized India rubber, having certain qualities not before known, is all that is claimed in the renewed patent, and the same art or discovery was described in the original. It included two several inventions, and its validity was, on that account, doubted; (whether correctly or not is immaterial); a separate renewal was a just and proper precaution, and one which the complainant had covenanted with the defendant to obtain.

The amendments in the last, by setting forth the true extent and distinctive principles of the invention, was a right vested in the patentee, and a wrong to no one, and more especially to the defendant in this case.

In examining questions of identity or infringement, we should first ascertain wherein consists the substantial peculiarity which distinguishes the art or invention patented from all others. Whoever adopts or appropriates such distinctive peculiarity or principle, without license of the patentee, appropriates the invention, and infringes the patent, if its specifications be correctly drawn.

Goodyear's invention or discovery did not consist merely in the use of sulphur, or lead, or both, or the application of heat to rubber in connection with both, either or neither of them; all these things had been done before, perhaps to little purpose.

The essential and distinctive peculiarity of his discovery is, that by using a certain degree of heat in the treatment of rubber, in

connection with those materials, it can be made to assume new and valuable qualities, distinguishing it from any other substance heretofore known. Whoever manufactures this material, or imparts its peculiar qualities to manufactured goods, by taking advantage of the peculiar discovery of Goodyear, pirates it, whether the patent be sufficient or not. If the specification of the original patent
60 was so ill drawn as to permit this to be done with impunity; if it fully disclosed the art or invention, but left the patent open to evasion or invasion, the property of the inventor may be compared to a field with an insufficient inclosure. Trespassers may take advantage of it, and defend themselves on the ground that the fence was not legal and sufficient, according to the statute; but, though they may escape punishment by such a plea, they gained no right of entry or property in the field.

It is no justification of the infringement of a renewed patent that the infringer had stolen and used the invention with impunity before the patent was amended. The inventor, it is true, may possibly not be able to recover damages for such use antecedent to the date of the renewed patent; but such previous use, though made with impunity, confers no right to the invention, or to future immunity for its infringement. The seventh section of the act of 3d March, 1839, ch. 88, protects those who "have purchased or constructed a newly invented machine, &c., prior to the application of the inventor or discoverer for a patent," but confers no such privilege on those who may have seized upon an invention or discovery disclosed in a patent, whose specification may happen to be defective or insufficient. On the contrary, the thirteenth section of the act of July, 1836, which regulates the re-issued patents, declares "that the patent so re-issued, together with the corrected description and specification, shall have the same effect and operation in law as though the same had been originally filed in such corrected form before the issuing out of the original patent."

VI. After what has been said, but a few words will be necessary on the question of infringement.

The answer does not contain a direct denial of the infringement of both of the patents. The assertion, that he "has not used the compound in the proportions described in the patents, but has used other and better compound," is evidently a mere evasion, or rather an admission that he has been attempting to evade while actually in-
fringing the patents, in disregard both of the law and his
61 solemn contract. The allegation that he has purchased other patents may be true, but it is immaterial. If the other patents showed a better right to the inventions claimed by Goodyear's patents, they were not given in evidence; if they were for mere variations or improvements of the discovery patented by Goodyear, they were wholly irrelevant.

There is another feature in the defence set up in this answer which the court are compelled to notice. It claims a right to exercise all the privileges granted by the contract, while it repudiates its obligations. And, moreover, it seems not only to claim to exercise a

license granted for using the patents in the manufacture of shirred goods, without paying the tariff or compensation, but also the right to violate the patents with impunity. As regards all other articles, the various covenants, amendments and additions, signed and sealed by these parties, constitute, in fact, but one agreement. Though dated on different days, they are but consecutive portions of a long negotiation, never concluded till after the last instrument was signed. The covenant not to use the plaintiff's patented discoveries in the manufacture of other articles than those for which he had a license, like a covenant not to rob him, may be considered superfluous. Where law governs, the action of trespass, or case for a tort, will afford as simple a remedy as an action on a special covenant not to commit it. If the monopoly of using these patents in the manufacture of shirred goods, granted and warranted to Day by these articles, has been materially injured through any negligence or fraud of Goodyear, Day will undoubtedly have a right to show such fact in evidence, and recoup the damage caused thereby, in any action, either at law or equity, demanding the compensation or tariff agreed to be paid for the license or monopoly. In the action heretofore prosecuted at law by the same parties on this agreement, Day did recoup or set off such damages against the demand for the tariff—in a case, too, where it was shown that Goodyear had acted in good faith, and had
62 done all in his power to protect the monopoly of Day; but the injury to Day was effected by the fraudulent conduct of others, whose acts neither Goodyear nor Day could control. All damage for breach of the covenants of this article, up to the date of the institution of that suit, must be considered as adjudicated in that suit. The allegation of the plea of the defendant in that case, that the injury to Day's monopoly was done with the collusion of Goodyear, was treated as superfluous, and the jury instructed to allow the set-off without evidence of collusion. The pleas entered in that case had evidently been intended to draw a demurrer, but issues having been taken on them, many of which were wholly irrelevant, it was thought better for the interests of both the parties to dispose of the merits, without regard to the net of ill-drawn pleadings with which it was entangled.

In the present case the whole controversy between the parties, except so far as it has been previously litigated and decided, is presented, though somewhat informally, by the bill and answer. The latter sets forth the contract in hæc verba. Though the prayer of the bill does not demand an account of tariff on shirred goods, the answer and proofs seem to have proceeded on the supposition that it did. We cannot permit the plaintiff to split up his claims against the defendant, that he may harass the defendant with another triennium of litigation in actions at law for past breaches of his covenants. The decree must be final on all causes of action between the parties up to its date, whether founded on the contract, or for infringement of the patents. The contract required the assent of two minds to make it, and the repudiation must be mutual in order to annul it. As the defendant has not succeeded in showing the patents to be

void, he can hardly be supposed to desire an abandonment of the contract, which would subject him to much greater damages. What would have been the consequence to him if the complainant, by amending his bill, had joined him in the rejection and destruction of this agreement, we need not inquire. But this contract has been made after great deliberation; and as many acts have been
63 done, and large sums of money paid in part performance of its stipulations, and not only so, but as it has been adjudged to be a binding and subsisting contract in suits at law where both parties have relied on its covenants, it cannot now be treated as a nullity, even though the plaintiff may now assert his readiness to join the defendant in its repudiation. The parties cannot be put in the same situation as if this agreement had never been made. And the court will not, in a decree intended to put an end to litigation, attempt to undo what has been done, and set aside what has been already adjudicated between the parties. Such a course would cause great difficulty, and renew old disputes. Interest reipublicæ sit finis litium. The court and the public have an interest in this matter, and the parties cannot be indulged, even if they were willing to indulge in a course so harassing and injurious, if not ruinous, to both.

These articles of agreement were originally framed for the avowed purpose of putting an end to litigation; but by some fatality, or, perhaps, necessarily, (from the numerous and contradictory covenants of parties dealing with fear and distrust of each other,) they seem to have furnished fuel for a worse fire than that which they extinguished. If the defendant has exercised the privilege, or enjoyed the license granted to him by the agreement, he should pay the consideration contracted for, and be compelled to perform the stipulations. The evidence shows that he has made large profits by this monopoly of shirred goods. He has, as yet, paid nothing for it. It is no bar to the account of these profits that some petty pirate may have manufactured some shirred goods, if it has not materially affected the profits of the defendant. If Goodyear, after notice that such infringements were committed, has neglected to protect the defendant from such interference, the master, in stating the account, will allow such damages as may be proved to be recouped from the amount of the tariff.

The court do, therefore, award an injunction, as prayed for in the bill, and refer the case to James S. Green, esq., as master, to take the accounts decreed.

64 In the Circuit Court of the United States for the district of New Jersey, in equity.

CHARLES GOODYEAR
vs.
HORACE H. DAY.

DICKERSON, J.—In this case the bill charges that the complainant, since the year 1843, has been, and now is, the owner and proprietor

of certain new and useful improvements in the preparation of India rubber for manufacturing purposes, by which the properties of the India rubber are greatly changed and improved, and the material itself rendered insensible to heat and cold, within certain degrees of temperature.

That those improvements have been secured to him by letters patent, one of which was granted to the complainant upon the first discovery and invention of one Nathaniel Hayward, and purchased by the complainant, which letters bear date February 24th, 1839.

That, in 1840, he was engaged in experimenting upon India rubber, and discovered that a high degree of heat, in connection with sulphur and other substances, might be attended with beneficial effects. After much difficulty and many experiments, in the latter part of the year 1843, he ascertained that most beneficial results might be obtained by compounding India rubber with sulphur and the carbonate of lead, or its oxydes, or other substances having a metallic base.

That he applied for and obtained a patent for that invention or discovery, dated June 15th, 1844.

65 That, by accident or mistake, and not by fraud, the improvements were not properly described or specified according to the invention and improvements as made.

That he surrendered that patent and obtained a corrected one, dated December 25th, 1849.

That, about the time he obtained the patent of 1844, he sold to one David L. Suydam the right to use said improvements in the manufacture of shirred goods, for suspenders or other purposes, for the consideration of $15,000.

That Suydam commenced the manufacture of said goods, when the defendant, Day, also commenced manufacturing the same goods, in violation of the complainant's right, and so much to the injury of Suydam that he gave up and surrendered his purchase, which surrender the complainant accepted.

That the defendant, Day, still continued to infringe the rights of the complainant as secured by said patent, by reason whereof he prosecuted the said Day, and his agents in different places, for violating the same.

That complainant was prepared to try said causes, or some of them, at the Circuit Court of the United States for the southern district of New York, at the November term, 1846.

That, shortly before that term, the defendant, Day, applied to settle those causes, and proposed: To acknowledge the validity of his patent; to pay complainant $5,000 for damages and settlement of said suit; to take a license for the sole manufacture of shirred goods, and to pay three cents a yard to the complainant for every yard of shirred goods made under the same; and to consider all shirred goods made by him as made under those patents; to stamp all such goods with complainant's name as patentee; and to keep and render regular accounts of all shirred goods made by him, and not to infringe said patents.

That complainant accepted said proposition, and agreed to discontinue his suits; and to take judgment on one of them, and
66 enter satisfaction of the same without costs; and to accept the $5,000, and relinquish his claim for damages on the defendant and his agents in said suits.

That the said suits were accordingly discontinued, except one, upon which judgment was entered and satisfied, as agreed upon.

That the said sum of $5,000 was paid by Day, and all claim for damages relinquished by complainant.

That Day acknowledged said patents to be valid, and accepted said license to make shirred goods, and agreed to pay the said tariff of three cents a yard, and to abstain from all infringement of said patents, and to confine himself to the manufacture of shirred goods and some other articles mentioned in said agreement.

That Day, notwithstanding said agreement, violated the said patents, and continues to do so.

Prayer.

"That defendant may render his account of the articles he has made of India rubber, or of which India rubber is a component part, prepared by the use of the improvements, or either of them specified in said patents, or either of them, or made after the manner of either of said improvements specified in either of said patents, &c., except such articles as he is entitled to make under said agreement," &c.

And also a writ of injunction to restrain defendant, Day, from further infringement of the patents of complainant, and to prevent him from use of the improvements for the manufacture of any articles, except those allowed by said agreement.

The defendant, in his answer, admits the several patents, as set out in the bill, but denies that the complainant was the original inventor of the improvements claimed by him; and also denies the validity of either of the patents. But he admits the execution of the agreement mentioned in the complainant's bill, and sets out the same with all the covenants at length. And in this view of the case, it is proper to inquire whether the complainant has made a case which entitles him to any relief, and for that purpose to examine
67 carefully that agreement and consider its effects; and it is proper to remark that, upon this part of the case, there is no serious dispute as to facts.

But the defendant, in his answer, alleges, by way of plea, that the complainant had granted portions of his said patents to William Judson, James A. Dorr, and John Haskins, and that they should have been made parties to this suit. In answer to that, it is sufficient in this place to say, that it is not pretended that he has granted away all of his interests in said patents, and, therefore, at least as to one branch of the relief prayed, to wit, the injunction, he is entitled to sue alone; and the question, therefore, is not, whether proper parties have come into court, but whether the party complainant is entitled to the relief asked, or either branch of it.

The contract made by the parties consists of a variety of covenants, and the first part of it is dated the 29th of October, 1846, and recites that Charles Goodyear, the complainant, at the time of the contract, "has, owns, and controls all and every right and privilege, granted or intended to be granted to him, the said Charles Goodyear, by the several letters patent issued to him," except a certain license to Hutchinson & Runyon, one to Ford & Co., both dated August 12, 1854, and one to Onderdonk & Letso, dated September, 1845. It also recites that the said Goodyear and his assigns had instituted various suits at law and in equity against the defendant, Day, and his agents, for alleged violations of the said rights, and that they had resolved to settle all differences between them.

Therefore, it was agreed as follows: "That the said Charles Goodyear, in consideration of the sum of $10,000 paid by Day, and of further covenants on the part of Day, hath granted, bargained, sold, assigned, transferred, and set over, and doth hereby grant, bargain, sell, assign, transfer, and set over to the said Horace H. Day, his executors, administrators and assigns—

1st. The exclusive right to make, use, and sell shirred goods; to use his machinery and improvements for that purpose during the terms specified in said patents; also to use the same for the manufacture of India rubber hose, beds, &c.

68 2d. That complainant will re-purchase and cancel all licenses, &c., (except the three above-named, touching or affecting the right conveyed to Day, and until such re-purchasing and cancelling the covenants of Day not to be binding.

3d. That Goodyear will not grant other rights to manufacture shirred goods, and in case of violation of this article, the covenants of Day not to be binding.

4th. Goodyear to prosecute for violations of rights sold to Day, and carry suits to judgment, &c.

5th. That Day shall have the right to use all the improvements made, or to be made, by Goodyear, to manufacture shirred goods, &c., machinery, &c.

6th. That Goodyear shall immediately discontinue all suits, each paying his own costs, and that he will, and hereby does, release and discharge the said Horace H. Day, &c., from all damages, actions, and causes of action for any violations, or alleged violations, of any or all of the said patents above enumerated or referred to, and indemnify and save harmless the said Day from any damages on account of any claim set up under said Goodyear. And the said H. H. Day, in consideration of the premises, agreed—

1st. That he would pay to Goodyear a tariff of three cents a yard for the shirred goods to be made by him.

2d. That he would keep accounts and books of all such goods made by him.

3d. That he would pay the tariff quarterly, from the 1st January then next, 1847.

4th. That he would mark the goods with the name of Goodyear as patentee.

5th. That he, Day, would not assign this right without the assent of William Judson.

Thirdly. It was mutually agreed, that if any person manufactured shirred goods "thereby materially impairing the profits of said Day in the exclusive enjoyment," &c., or if either of said patents should be declared void by a competent court, "that then the tariff
69 or assessment above provided for should cease," anything therein before contained to the contrary notwithstanding, "and the settlement of the claims consequent upon the case first above-named, should be referred to arbitration, &c. But it was, nevertheless, fully understood and agreed, that the suspension of the tariff or assessment aforesaid, if arising from the cause first above provided for, should subsist only during the continuance of the injurious competition aforesaid." By an additional article on the same day, it was agreed that Goodyear might, when he deemed it right and proper, surrender the patents of 1839 and 1844, or either of them, and take them out anew, but such new patent or patents to be subject to all the foregoing covenants.

By additional or supplemental articles, dated 5th November, 1846, it was agreed—

1st. That the original articles should be construed and governed by "those of November 5th," in all particulars wherein they differ or are inconsistent with these, but in all other respects to remain in full force and virtue.

2d. That the article requiring the assent of William Judson to enable Day to assign be cancelled.

3d. Day covenants "that while Goodyear protects him, the said Day, in his exclusive right to manufacture shirred or corrugated goods, he, the said Day, will not manufacture any other articles of metallic rubber, or such as is compounded of rubber and sulphur, white lead, or its oxyd, or any such as it is necessary to complete and finish by the aid of artificial heat, or sulphur, except for experiment, &c.

4th. Goodyear covenants that he will procure and cause to be assigned to Day, to be cancelled, the three licenses to Hutchinson & Runyon, to Ford & Co., and to Onderdonk & Letson; which re-assignment shall be a condition precedent to the performance of any part of this contract by said Day.

5th. Day agrees that the license granted him to use machinery patented to Goodyear be vacated, &c. By another agreement of same date, it is provided—

1st. Hutchinson and New Jersey Rubber Co. to bind them-
70 selves not to manufacture any shirred goods after a certain time to be fixed.

2d. Ford & Leston to do the like.

3d. That all suits upon the subject be discontinued, each party paying his own costs, except (if deemed advisable by the counsel of the parties) judgments may be taken in the suits *vs.* Myer and Sevier and Knowlton, on condition that satisfaction be entered, each party paying his own costs.

4th. That a release from the Naugatuck Company of the right to make any articles which Day is licensed to make be obtained and assigned to Day at the time of executing these articles.

5th. That the goods attached in Boston be delivered up to Day free of charge.

6th. All newspaper articles be submitted to counsel before publication, &c.

7th. All remaining questions, such as the period when present manufacturers shall stop making shirred goods, &c., to be submitted to arbitration, if parties cannot agree.

These several covenants were not delivered and exchanged until about the 5th day of December, 1846, when all the preliminary matters therein contemplated had been adjusted, when they were duly executed, under the hands and seals of the respective parties, and delivered; and it is important to inquire as to the rights, duties, and obligations of the parties at that time. These several covenants are to be taken together as one entire contract; and it is manifestly a contract partly executed and partly executory. Goodyear had executed his part of the contract by assigning to Day all the rights contemplated in the contract in that respect.

He had withdrawn all suits against Day and his agent, and released all claim for damages according to the terms of the contract. He had called in and cancelled all outstanding licenses, according to the requirements of the contract.

He had caused the goods of Day, which were attached in Boston, to be delivered to him without charge. On the part of Day,
71 he had admitted that Goodyear had owned and controlled all and every right and privilege granted or intended to be granted to him by the said several letters patent.

He had established the validity of those patents upon record by consenting that a verdict should be taken and judgment entered thereon for that purpose, and he had paid to Goodyear the consideration of $5,000. What part of the contract yet remained to be executed? Nothing material on the part of Goodyear, but that he should protect Day in the exercise of the right granted him to manufacture shirred goods, &c.; and on the part of Day, that he should pay the tariff of three cents a yard, keep accounts, and mark the goods as made under Goodyear's patents.

If, at that time, and after the execution and delivery of that contract, Goodyear had, in fact, fully protected Day, and he had, notwithstanding, gone on to infringe the rights of Goodyear, as secured by said letters patent, he would, undoubtedly, have been restrained by injunction under a bill filed by Goodyear for that purpose, and that without the intervention of a jury; and, if at that time, and under those circumstances, he would have been restrained, why should he not be restrained at this time under existing circumstances? It may be true, as alleged in the answer, that Goodyear did not protect Day, as by the contract he had agreed to do. But the only consequence of such failure is to relieve the defendant, Day, from the payment of the three-cent tariff, and not to authorize him to repudi-

ate the contract itself, which provides that the suspension of the tariff, if caused by injurious competition for want of protection, "shall subsist only during the continuance of the injurious competition." It seems hardly necessary to advert to the extraordinary claim of the defendant, in his answer, of a right to repudiate this contract by virtue of the 3d covenant of the article dated November 5th, 1846, which provides that while Goodyear protects Day in the right granted him, he, the said Day, will not manufacture any other articles, &c. This article is manifestly made in favor of Good-
72 year, and its only effect is to give him an action of covenant in addition to his other remedies against Day, for an infringement of his patents.

The counsel of the defendant, Day, deny that those articles of agreement should be so construed as to prevent Day from denying the validity of the patent of Goodyear, and contend that the court should not inquire into this matter of alleged estoppel, because it cannot be passed on but by the aid of a jury. In answer to this objection, it is sufficient to remark, that in this view of the case, there is no disputed fact upon which a jury could act.

They contend, in the next place, that the construction of the complainant's bill is such that he cannot deprive the defendant of a trial at the law by means of the special equities; that the bill should have stated the settlement in all its terms, and averred performance of all conditions, &c., and that the bill should have been so framed as to give the defendant an opportunity to answer on his oath, deny the special equity, &c.

By reference to the bill, in this respect, it appears that the complainant has set out all the material parts of the covenant, and averred the execution and performance of the same; and the defendant admits the truth of the bill in this respect, and sets out the covenants at large; and I cannot conceive how the defendant can complain that they had no opportunity in their answer to deny the special equity arising under those covenants, for if that equity arises at all, it is upon the facts charged in the bill and admitted in the answer. The defendant further objects that this bill does not bring this settlement before the court by such averments as are requisite, in order to obtain specific perfomrance.

This may be true, and the reason why the bill does not contain such averments is, that it is not a bill for specific performance; but it is founded upon the letters patent, and the ground of relief is the infringement by the defendant of those letters; and this agreement is charged in the bill as a fact, which, in a court of equity, should estop the defendant, Day, from denying the validity of the complainant's title; and that is the question now to be considered.
73 Upon this point, I think, there can be no reasonable doubt, either upon principle or authority. I know of no principle of equity or fair dealing which would justify the defendant in denying, at this time, the validity of the complainant's patents, when by these settlements he had induced him to discontinue his suits; to release his claims for damages for former infringements; to call in and cancel

all licenses before granted; and to surrender the goods of the defendant which he had attached at Boston. Nor do I know of any authority by which the court would be justified in permitting him to make such denial.

This is not the case of a mere license, but of a license connected with important agreements on the part of the complainant, already executed. and it is a case where the defendant has, in fact, and under his seal, admitted the validity of the patents; and for the very purpose of estopping himself from denying their validity, he has consented to a verdict of a jury against him, which now stands of record to establish it. I am, therefore, of opinion that the defendant could not be permitted to deny the validity of the complainant's patents, and that he is entitled to an injuntion according to the prayer of his bill. And under the circumstances of the case, complainant is also entitled to an account, unless a good objection from that branch of the relief arises from the want of proper parties.

The defendant, in his answer, sets up, by way of plea, that the complainant had made certain assignments of intdrest in his patents to James A. Dorr, John Haskins, and William Judson, and that they should have been made parties to the bill. This involves the necessity of inquiring into the nature of those assignments. Upon inspection, it appears that the agreement with Haskins is a mere license and, therefore, furnishes no foundation for the objection. The assignment to William Judson would appear, in the first part of it, to convey a present interest; but in the latter part of it it is "distinctly understood" that "Mr. Goodyear had not conveyed, and did not convey, to said Judson, or his representatives, any
74 right of sale or diposition of said inventions or patent rights, and that the said William Judson should not be entitled to collect or enforce the payment of said interest until the decision of the court, on motion for injunction, or by verdict of a jury, which reduces the assignment to Judson to a mere covenant on the part of Goodyear, that, upon a certain event, (which has not yet taken place,) he, (Judson,) shall have a certain interest in the improvements and patent rights, and, of course, it was not necessary to make him a party. The assignment to Dorr was one sui generis, but it is similar to that of Judson's in its conclusion, in which it is provided virtually that the said Goodyear had not conveyed, and did not convey, by anything in said assignment contained, to the said Dorr, or his representatives, any right of sale, deposition, or control, of said inventions, patent rights, and property mentioned in said assignment, until there should be $75,000 credited to Dorr, according to the terms of said agreement," which event does not appear to have taken place; wherefore it amounts to nothing more than a covenant that Dorr should have a right to the control of said patent rights upon a contingency, which has not yet occurred. I, therefore, can see no good reasons why the complainant is not entitled to his account, according to the prayer of his bill.

But as this view of the case applies to the present defendant only, and those holding under him, it is proper to inquire whether the

complainant is entitled to his relief generally, and without reference to these particular contracts. Before entering upon that important branch of the subject, I advert to one objection, which it appears right to notice at this place. In the 2d point made by the defendant in his brief, he claims, "That the complainant has no right to maintain this suit, because, prior to its commencement, he had bargained and sold, transferred and assigned his interests in the avails of any damages to be recovered against infringers of his patents, to others." And to sustain the objection, he refers to an agreement made by the complainant with L. Candee and others, marked "Exhibit C;" upon the examination of which agreement, it appears to
75 be a license from Goodyear to Candee and others, to use his improvements and patents for the purpose only of manufacturing boots and shoes, with a covenant added, that Candee and his associates should do all that might be proper and necessary to sustain said patents, and defend the same against piracies and infringements, to be done at their expense, and that they were to pay the costs, and to have the avails of all suits which they might commence in the name of the complainant, or otherwise; and liberty was given to use his name in all cases where it might be deemed proper or necessary by counsel. The defendant seems to think that, by these covenants, Candee and his associates are bound to defend the patents of Goodyear against piracies in all cases, and to pay the costs, and to have the avails of all suits which might be commenced for damages for infringements of any of the patents of the complainant, when, according to the correct construction of these covenants, they must be limited in their operation to the subject matter of the license; that is to say, to infringement of their exclusive privilege of using these improvements in making boots and shoes; and although this agreement may possibly furnish a good reason why, in the order for account, this particular branch should be excepted, I can see no reason why it should defeat the action. We now inquire whether the complainant, Goodyear, is entitled to the relief which he seeks, without reference to these covenants with the defendant; and the first objection taken by the defendant is, that the complainant has not established his right at law.

Much ingenuity has been displayed by counsel upon this point. But after all that can be said upon the subject, it is reduced to this general proposition, that courts of equity have the right, which generally should be exercised, of invoking the aid of a jury to settle disputed facts, but to be exercised at the discretion of the court; and, of course, the propriety of adopting such course must depend upon the circumstances of each particular case. The view I take makes it
76 unnecessary to examine the question as applicable to this case, it having already been settled by a verdict of a jury, and it cannot be considered necessary to anticipate what might be a proper course to be adopted in this respect, upon any future case which might arise.

The question recurs, whether Goodyear, the complainant, is entitled to the relief which he asks without reference to these covenants

with Day, the defendant; and the first inquiry in order relates to the patent of 1839, issued to the complainant upon the invention of N. Hayward.

The originality of that invention is not denied in the answer; but it is alleged, that "if Hayward ever had any right to 'a patent for the composition of sulphur and rubber, the same was abandoned and given up to the public by him, and by others, with his knowledge, using and selling it before his application for a patent.' "

In order to understand the bearing of the law and the evidence upon this point, it is necessary to examine and ascertain what Goodyear claimed as the invention of Hayward. He claims as his invention, and desires to secure by letters patent, "the combining of sulphur with gum elastic, either in solution or substance, either in the mode pointed out (in his specification,) or in any other which is substantially the same, and which will produce a like effect." And the patent was issued on the 24th day of February, A. D. 1839. Upon examining the testimony on this point, there appears very little, if any, contrariety. Hayward was engaged, in the spring of 1836, in the manufacture of India rubber for "the Eagle India Rubber Co., at Woburn," in the character of superintendent of the manufacture and compounding part. It appears, by the testimony of Hayward himself, as well as by witnesses of the defendant, that he was experimenting during 1836, 1837, and 1838, in the manufacture of India rubber goods by the aid of sulphur and other materials; and that goods were manufactured and sold to a small amount. But it does not appear by the testimony of any witness that any goods were manufactured during that period in the manner described in the patent of 1839. William S. Humphrey, the principal witness on the
77 part of the defendant in that respect, speaking of the materials used by Hayward in 1836 and 1837, says, they were India rubber, lampblack, and spirits of turpentine; also sulphur and white lead were used; and as to the proportions, he says, "I do not think the proportions were ever definitely fixed. I do not know any definite proportion used at the time;" and when asked, what proportion of all the goods made by that company, during the years 1836, '7, were prepared by the use of sulphur in some form in the rubber compound, he answers, "that he cannot state the proportion, and that he did not feel prepared to give any definite answer." Most of all the other witnesses referred to by the defendant merely go to prove the undisputed fact, that he used sulphur in the manufacture of some of his goods.

The facts as to this point are, and appear by all the evidence to be, that Hayward, being impressed with the importance of sulphur in the manufacture of India rubber goods, continued a series of experiments at Woburn, from the spring of 1836, until the company prohibted the use of sulphur as injurious to their goods, and failed in business. Hayward afterwards went on with his experiments, and in 1839 brought it to such perfection as to justify the taking out of a patent, which was done by Goodyear, as purchaser of Hayward's rights.

It is not necessary to examine particularly the law upon this subject, as the facts do not sustain the objection under any view of the law. The next subject in order of inquiry is the patent of 1849, for an improvement in the manufacture of rubber, by which is produced the article now technically denominated "Vulcanized Rubber." It is a fact of great importance to the public that such an improvement has been made; and it is also a fact that the complainant, Goodyear, has obtained a patent for that improvement, which prima facie establishes his right. In answer to this claim of the complainant, the defendant, in the first place, denies that Goodyear was the original inventor, and then endeavors to establish the truth of the denial by the testimony of witnesses, the first and most important of
78 whom is Richard Collins, whose testimony, from its extraordinary character, requires careful consideration.

He swears that in September, 1833, at Baltimore, he made a "rubber compound consisting of sulphur, lead, lampblack, turpentine and magnesia, mixed with rubber," and that he submitted it to heat of from "200° to 250° for the space of twelve hours." And as to the proportions, he says: "I did not know at first how much it would take; but after I had made my composition, I found it took about the proportions of three pounds of rubber, one pound of dry white lead, nearly half a pound of sulphur. I did not weigh the ingredients; I judged from the portion that was left; I used considerable magnesia, in consequence of using more turpentine than was necessary, not knowing how much it did require."

He left Baltimore, and was in Boston from October, 1833 to March, 1834, when he went to Lowell, and remained there until December, 1834, when he went to Newton, and remained there until March, 1835, when he went to Boston, and continued there until April, 1836, when he went to Salem, and left there in January, 1837, and afterwards went to Lowell, and staid till 1841. In these several places he was engaged in different India rubber establishments, and used this compound which he had discovered at Baltimore, but kept it a secret, except to his brother and some one or two others; and he swears as follows: "I have tried no experiments only what I tried at Baltimore, in 1833. The process I have tried in several places since, and have found the cloth covered with the composition was good, and there was no occasion to alter the compound nor the proportions." And further he says: "The first time I made composition consisting of sulphur, dry white lead, magnesia, lampblack, India rubber, ethereal spirits of turpentine, that was the first time I ever tried it, or heard of its being used. Finding the first composition made by me at Baltimore was right, I have not altered it since." And finally, upon being requested to explain why he used, or directed to be used, his composition at at the several pla-
79 ces after leaving Baltimore, and whether it was to ascertain anything about the goods made of that composition, he answers: "It was not to ascertain anything about the goods. I have always intended, if opportunity offered me a good chance, to take the charge of manufacturing India rubber goods, I should do so; and

knowing the composition being better than any I had ever seen or used, I was in hopes to be benefited by it, and shall hereafter, if opportunity offers." And this sworn on the 23d of July, 1851.

If this testimony be considered upon the hypothesis that Collins, in his Baltimore experiment, produced the article now known as vulcanized rubber, it is incredible for several reasons. In the first place, it cannot be believed that a young man, without any previous knowledge of the India rubber business, without ever having used or heard of the use of the different articles necessary to produce that material, should have discovered, at the first effort, those several articles with the proportion of each, and the degree of heat necessary to produce the desired result. And it is equally incredible that he, having made so important an improvement, should not have availed himself of the benefit of that improvement during the twelve or fourteen years that he was engaged in the different rubber establishments in Boston, Lowell, Salem, etc., where every exertion was making to improve the manufacture of rubber.

But if all that he swears be taken as true, it does not disturb the right of the complainant. It is undoubtely true that many persons about that time were experimenting upon rubber, striving to do away with the objections and difficulties in its use, and they may have used the same materials in experimenting, and applied different degrees of heat; but it matters not how near they may have come, unless they have arrived at the particular result; and it is fortunate for the complainant in this case that such result is known by a chemical change in the material, rendering it insensible to the operation of heat and cold, and so distinct and marked as not to be mistaken.

Now, it does not appear from the testimony of Collins that
80 he ever did produce vulcanized rubber. In no part of his testimony does he says that the effect of the Baltimore experiment was to render the rubber insensible to the effect of heat and cold. His description of the heat to which his composition was exposed, is vague and uncertain. He estimates it at from 200° to 250°; and when it is considered that the experiment was made in his sleeping apartment, a room from from 12 to 14 feet square, in a cylinder placed in the oven of a large stove, heated by wood, and continued for 24 hours, it is not surprising that, (in the absence of a thermometer,) he should have made a high and mistaken estimate of the degree of heat. For it is quite manifest that if he had kept the stove heated to the highest degree estimated, it would have produced upon his own body the very effect that was desired to be produced upon the rubber, rendering it insensible to the effects of heat and cold. It is proper to remark, that in the further part of his testimony, describing the several times and places in which he had used this Baltimore improvement, he never states the degree of heat to which the compound was exposed; and the several witnesses, John Collins, Rufus F. Newhall, Leander M. Earle and Leander Shattuck, who severally swear that they have used this improvement under the direction of Richard Collins, none of them stated that a high degree of heat was used. On the contrary, Earle swears, as to the degree

of heat, that he used a "moderate degree of heat at first, and then pretty warm, quite warm;" and being asked for what purpose the heat was used, he answers: "for drying the composition."

The defendant also insists that Elisha Pratt vulcanized India rubber previous to the patent of the complainant; that is, previous to the 15th day of June, 1844. For in the investigation of this subject, the patent of 1849 must be considered as bearing the same date with the patent which was surrendered.

In answer to this claim, it is sufficient to remark that his vulcanizing process was carried on in a small room, where the hats to be vulcanized were hung up and the room heated by a stove; and that he went into this room when heated, for the purpose of examin-
81 ing the hats, and being asked how long he would stay in the room, he answers: "I should state from 10 to 15 minutes. I had to be very expeditious about my business there. It was very hot, and required to keep the heat in." When we consider that water boils at a temperature of 212 degrees, it is manifest that this also was a mere drying, and not a vulcanizing process. The defendant further insists that Goodyear, the complainant, did not invent the vulcanizing process; but that the knowledge thereof was communicated to him by others who invented it, and he names John F. Nash and Williams Beers as the two persons who made the invention and communicated it to him; and, of course, that Nash and Beers, or one of them, should have had the patent.

Upon examining the testimony, it appears that these two men, with others, were in the employment under pay of Goodyear, making experiments under his direction; and by their experiments they might, and probably did, aid in obtaining the final result.

But it by no means follows that Goodyear, under whose direction these improvements were made, should be deprived of the credit or benefit of the improvement.

The defendant also insists, and in his answer he swears, that "prior to the application of the complainant for his patent, and more than two years before such application, he used and had in practical use and operation in his business, in the State of New Jersey, the thing, invention, or discovery, or every substantial, useful and material part thereof which is claimed by said Goodyear in his letters patent of 1849;" that is to say, he swears he made vulcanized rubber as early as June 15, 1842.

This is not confirmed by any witness on the part of the defendant; but it is quite manifest from the letter of the defendant himself, explained and confirmed by the testimony of Horace Cutler, that until after December, 1842, he, the defendant, did not understand the process of vulcanizing rubber, and that he then obtained the information from said Cutler, who had it from the complainant.

82 The defendant also charges that both N. Hayward and Mr. Hancock, of England, made this improvement prior to the complainant; but, unfortunately for the argument, these gentlemen both accord to Mr. Goodyear, the merit of this invention, and no man for himself claims the merits of the invention, and no man denies

that Mr. Goodyear is entitled to that merit, except the defendant in this case.

But the defendant raises an objection, which, if well founded, renders it very immaterial who was the original inventor. For he insists, that if even the patent of 1844 was a good and valid patent, yet the re-issued patent of 1849 is void, for certain reasons which render it necessary to examine the law upon that subject.

The 13th section of statute of July 4, 1836, provides that if a patent "shall be inoperative or invalid by reason of a defective or insufficient description or specification, or by reason of the patentee claiming in his specification as his invention more than he had, or shall have a right to claim as new," the patentee is authorized to surrender the patent, and the commissioner to issue a new patent, with a corrected description or specification, provided the error has arisen "by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention."

This section contemplates two classes of cases. First, where a patent shall be inoperative or invalid by reason of a defective or insufficient description or specification. And secondly, where that objection arises "by reason of the patentee claiming, in his specification, as his own invention, more than he had, or shall have a right to claim as new."

As to the first case, it is manifest that although the description or specification in a patent be clear and distinct to describe some improvement or invention, yet if it do not describe the particular invention intended to be described, it is inoperative or invalid, according to the sense of the law, and will justify a surrender and re-issue;

but before the re-issue is made the applicant must satisfy the
83 commissioner that the corrected description is a true description of the thing invented. This case had the adjudication of the commissioner upon the subject, and in the absence of all evidence or pretext of fraud or deception, I am not disposed, even if we had the power, to disturb his adjudication. The applicant for the re-issuing of a patent is not bound to describe or claim all that he described and claimed in his original patent; but he may not describe or claim any new or other improvement. In this case it is not necessary to inquire particularly as to the different kinds of evidence which may be used before the commissioner or the court, to establish the fact that the applicant has a case which brings him within the purview of the act, for the letter of Goodyear to Dr. Jones, of the 13th December, 1844, clearly establishes the fact, that the description of a part of his original invention was omitted in the specification of 1844, by inadvertency, accident, or mistake, and, therefore, that he was entitled to a re-issue. And the only important question remaining is, whether, in his re-issued patent of 1849, he has described and claimed an improvement different from and more extensive than his original invention. It is not pretended that the improvement described in the patent of 1849 is different in result from that described in the patent of 1844. Both of them are for making vulcanized rubber; but the objection to the patent of

1849 appears to be, that it embraces a different and more extensive use of heat to produce the result than the patent of 1844. In the specification of 1844 the applicant says: "but I prefer to expose them to an atmosphere of artificial heat of the proper temperature." Now, as that temperature is at least as high as 212°, it must have been an artificial heat; and the word prefer, which he uses in both specifications, as applicable to the particular manner and form of applying the heat, implies that there was some other form that he might use, but that he regarded this particular manner and form more than another; and the expression in the specification of 1849, that "the operator may communicate the heat in any suitable manner or form," refers to the manner or form of applying the
84 heat, and not to the kind or quality of the heat; and the only legitimate and proper use of that expression is, to exclude the conclusion that the operator might be limited to the particular form or manner therein specified and described. The objection, therefore, does not apply to this part of the specification, nor do I think it applies to the latter part or claim made by the complainant in his specification of 1849. In the specification of 1844, he describes the exposure to heat generally, limiting the heat to about 270°; and in his claim he speaks of exposure to a "high degree of heat as therein specified." Under this specification he had the undoubted right to use heat of any kind then known. In the specification of 1849, he claims the use of "a high degree of artifical heat substantially as therein described." And by reference to the specification, it appears that he does not, in any place, describe any particular kind of heat, but uses the term artificial as applicable to degrees of temperature above natural heat.

I do not inquire whether the complainant may use heat in the form of steam, for the purpose of curing rubber, as that is not in issue. It is sufficient to say, that if any difficuly exist, it is not by force of the re-issued patent.

The objection that the complainant, in his patent of 1849, claims curing rubber in the presence of sulphur, is not well founded. For if it be more extensive than the specification of 1844 in that respect, it is not more extensive this actual invention, as is manifest from his letter to Dr. Jones.

I have not thought it necessary to remark particularly upon the testimony on the part of the complainant, as I do not consider that the testimony of the defendant has overcome the prima facie evidence arising from the patent itself. But it is due to Mr. Goodyear to say, that upon examining the certificate of Professor Silliman, and other evidence in the case, I am entirely satisfied that he is the original inventor of the process of vulcanizing rubber, as stated in his bill; and that he is not only entitled to the relief which he asks, but to all the merit and benefits of that discovery. Decree accordingly.

85 In the Circuit Court of the United States for the district of New Jersey.—In equity.

CHARLES GOODYEAR
vs.
HORACE H. DAY.

This cause having been brought to a final hearing upon pleadings and the proofs, and having been argued by counsel for the respective parties, and the court having duly considered the same—

It is now ordered, adjudged, and decreed as follows:

1. That a perpetual injunction issue against the defendant, according to the prayer of the bill.

2. That it be referred to James S. Green, esquire, one of the masters of this court, to take an account of the damages which the complainant has sustained by reason of the infringements by the defendant, of the patents in said bill mentioned, or either of them, since the first day of January, 1849, and in taking such account, the master shall ascertain the amount of goods so manufactured or sold, and the profits accruing therefrom; and also whether any other damages have been suffered or incurred by complainant, as directly consequential from such acts of infringement, which would not be compensated by assuming the defendant's profits as the measure of compensation of the injury to complainant.

3. It is further ordered and adjudged that the said master do take an account of all shirred good and other articles manufactured
86 by the defendant, since the first of January, 1849, in pursuance of or according to the license granted to him by the articles of agreement set forth in the pleadings, and the amount of tariff due and payable thereon; and also whether any damage and how much have been sustained by the defendant from the neglect or failure of the complainant to protect him in the enjoyment of said license, according to his covenants.

4. It is further ordered, that the defendant, from time to time as ordered by said master, do appear before him and submit to examination in the accounting herein ordered, and produce such books and papers relating thereto as said master may direct, and that, (besides the evidence already taken in this case,) the parties have leave to produce and examine witnesses before the master as to the matters of accounting and damages; for which purpose they may have the process of the court to compel their attendance.

5. It is further ordered, that the said master make his report with all convenient speed, and that on the coming in of the report, the cause be set down for hearing thereon, and the equities reserved.

Lastly. All further directions are reserved till the coming in of such report and the final decree to be thereafter entered.

87 In the Circuit Court of the United States, district of New Jersey.—In Chancery.

Exhibit C.

CHARLES GOODYEAR AND THE NEW England Car Spring Company
vs.
THE CENTRAL RAILROAD OF NEW Jersey.

On motion for interlocutory injunction. Argued March 24th, 1853.

GRIER: J.—It will not be necessary to give an abstract of the several averments of the bill and answer, in order to a correct apprehension of the questions involved in the present motion.

Parties.

The possession under Goodyear's patent is of sufficient duration and exclusiveness to be the foundation of an interlocutory injunction, even if the verdict and judgment in the suit, against the agents of Day, were not in the case.

There is no allegation nor pretense that those proceedings were collusive; and it cannot be said to detract from the moral or legal effect of a verdict and judgment, that the plaintiff made so plain a case that the defendant felt compelled to abandon his defence and plead guilty.

The defendants do not deny that they use car springs made
88 of the substance called "vulcanized rubber;" nor aver that such rubber was manufactured by the patentee, or any licensee under him, but they rely upon the three following objections, *i. e.*:—

1. That there are not proper parties to the bill.

2. That the rubber used in their car springs was made by a process in which steam is the chief agent; and is therefore no infringement of the complainant's patent.

3. That the complainant's patent is for a process of curing rubber, and not for the product or manufacture; and, consequently, that the use of the product is no infringement of the patent.

Infringement.

1. The same objection as to parties has been heretofore taken in this court, and overruled. The assignments to Dorr and Judson, of certain undivided interests or shares in the patent, appear at first to contain language, apt and sufficient, to transfer the legal title; but a further examination of the instruments shows that the intention of the parties is only to confer on them an interest in the profits. The whole power of disposal, and consequently the whole legal title, is in Goodyear. The New England Car Spring Company, who have the sole right of using this substance for the manufacture of car springs, are the party in interest. Their right is wholly equitable, as their

license, though exclusive, does not amount to a legal transfer of a several title to a portion of the patent. The right, franchise, or monopoly granted by a patent, is by statute made divisible in the catagory of its locality only. The owner of the legal title to the patent, and the party equitably entitled to the damages as the person immediately injured by the infringement, being parties to the bill, it cannot be successfully objected to for want of proper parties.

2. Where the question of infringement is one that admits of doubt, or where the facts are in dispute, the court will not decide it summarily on a motion for a preliminary or interlocutory injunction. In this case the defendants are amply able to respond in damages, and an injunction is not necessary on the ground of any irreparable
89 injury to the complainant, likely to occur before a final decree.

But the question, as now stated, admits the facts; and its solution will depend on the construction of the patent. It is, therefore, as fully before us as it can be on a final hearing, and the parties have, I presume, no desire to protract litigation. In the case of Goodyear *vs.* Day, the specific proposition was not before the court, and was therefore not decided. But assuming the general doctrines asserted by the court in that case to be direct, there will be little difficulty in the decision of this question. It requires only that we examine the specification of complainant's patent in order to discover whether the process admitted to have been used in manufacturing vulcanized rubber used by defendants is substantially the same with that described in the patent, "and to see whether, in reality, in substance and effect, the defendants have availed themselves of plaintiff's invention, in order to make that fabric or manufacture;" or whether it is not the mere following out the invention or discovery of the plaintiff, with some variation in the means.

Goodyear's Discovery.

Before plaintiff's discovery, many attempts had been made to use the substance called caoutchouc, or India rubber, in the manufacture of certain goods, in order to have the benefit of its qualities of elasticity and impenetrability by water imparted to certain fabrics. These had all failed in a great measure, because this substance became soft and clammy by heat, and stiff and hard by cold. It was then deemed of great importance to discover some method, if possible, by which these bad qualities might be removed, and its valuable ones retained. That this substance was capable of such a change in its qualities was a fact which science could not demonstrate a priori, much less point out the means of effecting it. Its discovery must necessarily be empirical, or the result of patient experiment and judicious observation of phenomena.

That sulphur and some metallic oxydes could be use beneficially in drying the fabric had been discovered, but no one had ever succeeded in producing a compound or substance having all the good
90 qualities of caoutchouc, but unaffected by changes of temperature. The patience, energy and perseverance of Mr. Good-

year at length succeeded in making the discovery that, by exposing this substance, in combination with sulphur and some metallic oxides, (of which white lead was found to be the best.) to a high degree of heat for a certain legth of time, the result so much desired could be obtained. The fabric, product, or manufacture, which was the result of this process, was found to be almost indestructible; its elasticity under pressure was vastly increased; heat would not soften it, nor cold harden it, nor water penetrate it. It was a great and useful discovery rather than an invention. It was not a mere composition of known substances like a patent medicine; nor the production of a known result, substance, or fabric, by newly discovered means or process. We know a substance only by its qualities.

Infringement.

The fabric or product having qualities which cannot be combined in any other substance, may be called a new substance. But whether we call it a fabric, or a manufacture, substance, or product, is immaterial. It is a new product, the result of a new process discovered by the plaintiff. What forms the essence or substance of this discovery? What is the sine qua non, or that without which this composition of matter cannot be produced? The specification says, it is the application of a high degree of heat between 212° and 350° of Fahrenheit. You may vary the proportions of sulphur, or change the metallic oxydes and succeed, more or less, if the exposure to heat between these two points be continued for a sufficient time. But no mere changes in the combined materials will have a beneficial effect without this application of a high degree of artificial heat. Now, it must be abundantly evident to the most simple apprehension that any person having the benefit of plaintiff's discoveries, starting from the platform erected by him, may possibly vary the process and obtain the same result. He may use salts of zinc for salts of lead, arsenic or magnesia for sulphur, or heat by steam instead of
91 air, many other variances of the relative proportions of the materials might be discovered to be equal to those patented.

Yet it must be equally evident that such person is pirating the plaintiff's invention. Suppose that before Goodyear's discovery a manufacturer had taken to a chemist's laboratory some India rubber, rulphur, and white lead, and asked him so make him a compound, having the qualities now exhibited by the substance known as "vulcanized rubber." He would have received an answer denying the possibility of making such a compound by any process known to scientific men. Now, suppose he had put into the same person's hands the specification of plaintiff's patent, and ask him to discover some means by which the same result might be produced in mode, or proportions, different from that set forth in the patent; what science was before incapable of performing by synthesis or any reasoning a priori, can now be improved by valuable hints derived from analysis. The chemist can now immediately suggest many changes in the process which may produce equivalent or better results. He could at once suggest that a carbonate of zinc, or some other metalic

oxyd, could probably perform the office of white lead; that possibly arsenic, or magnesia, or some other metal or earth might be substituted for sulphur; that sulphur might be used better, perhaps, in a gaseous form; that the high degree of heat, so necessary to the process, could be as well or better applied by means of steam than dry heated air. Yet no one, whose perceptions are not perverted, can fail to see that all such changes of mode or operation such interposition of chemical equivalents, though possibly improvements on the original process patented, have their foundation on the patentee's first discovery, and start by appropriating or pirating it. It must be obvious, also, that there is not only a distinction, but a wide difference between one who merely invents a new method or process, by which a well known fabric, product, or manufacture, is produced, in a cheaper or better way, and the discovery of a new compound, substance, or manufacture, having qualities never found to exist
92 together in any other material. In the first case, the inventor can patent nothing but his process, and not his composition of matter. In the latter both are new and original, and both patentable—not severally, but as one discovery or invention. It is evident, also, that the question of infringement must, in such cases, depend on different conditions. Steel is a well known substance. Any one who could devise a new and cheaper method of combining the iron and carbon in order to form it, could patent his process only; and every other person would be at liberty to devise any different process for effecting the same purpose.

But if steel, as a substance, was before unknown, the person who first discovered that a composition of iron and carbon could be made to assume such valuable qualities, would have a right to patent not only his process, but his product. And no person who had thus taken the benefit of the patentee's discovery, and by it was informed of the valuable qualities of this compound of iron and carbon, could, by varying or improving the mode or process of its production, rob the patentee of his franchise.

Infringement by using product of invention.

But assuming this patent to be merely for a process, and not for a product or fabric, still, in a question of infringement, the inquiry is, what is the essential or substantial agent in the patentee's process or discovery? The specification affirms it to be a high degree of heat, and that no commixture or combination of substances with caoutchouc will give it these qualities, unless the composition be exposed for a length of time to a high degree of heat. Can any person doubt that the mere substitute of steam for heated air, in such manufacture, is a bold attempt to pirate the patentee's invention and evade his patent? No learned hypothesis of chemists or philosophers, as to the different chemical action of hot steam and hot air, can be beneficially and extensively applied, in numerous manufactures, as a substance having certain qualities not possessed by caoutchouc in its natural state, or any other known substance, are facts well known and admitted by all, ex-

cept those who have been engaged in pirating the discovery,
93 or whose interests are otherwise concerned in denying the fact. It is true the patent in this case does not use the phrase "vulcanized rubber," a term since invented to denote the newly discovered manufacture or composition of matter. Patents are granted "to promote science and useful arts." They are not odious monopolies or restrictions on the rights of the public. For the temporary monopoly given to the inventor, the public receive a full compensation by the publication of the invention. And when the specification of a patent honestly sets forth the process and mode of compounding a new and valuable composition of matter, courts are bound to give it a liberal construction, and not to fritter it away or annul its benefits by formal or subtle objections.

What we consider the true extent and merit of the plaintiff's discovery we have already stated in this opinion. It only remains to examine whether the patent and specification will bear a construction co-extensive with the patentee's rights arising from such discovery. On account of the great vagueness and indefiniteness of the language used in describing the various arts, machines, manufactures, and compositions of matter, it is almost impossible to describe the real nature of many discoveries or processes in language free from ambiguity or misconstruction. Different persons looking at it from different points of view would describe it in different terms. In the present case one might describe it as "the art of curing India rubber;" another, as "a new and useful improvement in the process for curing India rubber;" another, "the art of rendering caoutchouc, and manufactures in which it is used, insensible to heat and cold, or the action of most of its known solvents;" another, as "a fabric, manufacture, or new composition of matter, having qualities never before combined in any other known substance, being elastic, water proof, insensible to acids, to heat, or to cold."

Construction of Goodyear's patent and specification.

Still, call it what you will, if the patentee has set forth fully the materials, their various proportions, and the processes necessary to the production of this composition of matter, he has done all
94 that the law requires, and should be entitled to its protection. The patent should be carefully examined to find the thing discovered; and, if it be clearly set forth, the patentee should not suffer for the imperfection or vagueness of the language used in describing its true extent and nature. Applying these principles to the present case, let us examine the patent to see if the specification does not set forth a discovery which might be described by the most extended of the descriptions given, as well as the narrowest.

In this country the inventor must file a specification or description of his invention or discovery before he can receive a patent. The patent is required to "contain a short description or title of the invention or discovery, correctly indicating its nature and design." This description ought not to be repugnant to the specification; but,

provided it honestly sets forth in few words the nature and design of the patent, it is sufficient. The specification must be looked to for the full disclosure of the discovery and the extent of the inventor's claims. It should show what the patentee claims to have discovered or invented; wherein it differs from what is heretofore known; and by what combinations or processes the new material may be compounded. While the specification is usually, and always ought to be, drawn with the assistance of learned and able counsel, the short description in the patent is usually suggested by the Commissioner of Patents. The extent of the patentee's rights must be judged from the whole instrument taken together, and not from any one sentence.

It is especially proper in patents for complicated machines that the specification should clearly set forth what the patentee admits to be old, and what he claims to be of his invention, and that he should be held to such statement. In anomalous cases like the present, when a new product has been discovered, and the process of compounding it or obtaining it is disclosed, the patentee, by stating his discovery and revealing his process, has received to palliate or protect so gross an invasion of the patentee's rights. We have,
95 therefore, no doubt that the use of steam in place of heated air, in the manufacture of vulcanized India rubber, is a palpable infringement of the patent of Goodyear.

3. We will notice the third objection made by defendant's counsel to the complainant's right to an injunction, which is—

"That the complainant's patent is for a process only, and not for a product or manufacture; and, consequently, that the use of the product is no infringement on the patent."

If the premises assumed in this proposition are true, the conclusion is undoubtedly correct. A patent grants to the patentee "the full and exclusive right and liberty of making, using, and vending to others to be used, the said invention or discovery." It is evident that the sale or use of the product of a patented machine is no violation of the exclusive right to use, construct, or sell the machine itself; and that the patent for a discovery of a new and improved process, by which any product or manufacture before known in commerce may be made in a cheaper and better manner, grants nothing but the exclusive right to use the particular process. Where a known manufacture or product is in the market, purchasers are not bound to inquire whether it was made on a patented machine, or by a patented process.

But if the patentee be the inventor or discoverer of a "new manufacture or composition of matter not known or used by others before his discovery or invention, it is clear that his franchise or sole right to use, and vend to others to be used, is the new composition or substance itself.

The product and the process constitute one discovery, the monopoly of which is secured to the inventor or discoverer as a consideration or compensation for making it known to the public.

That the composition of matter now known as "vulcanized rubber" was not known before the discovery patented by Goodyear, and that it has since been most done all that he is required to do or can do.

96 The careful separation of new from old, the limitation of claims to particular parts or combinations, cannot be required as a substantial part of the specification. If a specification sets forth a discovery, a new composition of matter, and the process for compounding it, that should be taken as the extent of his claim and the measure of his franchise.

The patent describes the discovery or invention as "a new and useful improvement in the processes for the manufacture of India rubber."

"As a brief description of the discovery, indicating its nature and design," this may be said to be correct, so far as it goes, for it briefly states the nature of the discovery. But it cannot limit the claim of the patentee to narrower bounds than those described in his specification.

The specification first states the valuable qualities possessed by caoutchouc or India rubber, being elastic, water-proof, and durable; but that it was in a measure useless because it became soft, clammy, and would even dissolve under the action of a moderate degree of heat; and also became hard with cold. That the great desideratum was to get a substance or preparation of rubber which would retain its good qualities, and remain unaffected by heat or cold.

That thus far the only step towards improving this substance was a discovery of Nathaniel Hayward, that a compound of sulphur with caoutchouc improved its qualities for some purposes.

That the patentee commenced a series of experiments, with a view to render India rubber capable of resisting heat and cold by treating it with heat. That finding that this substance, if subjected to heat by itself, could not be cured, he was led to experiment on it in combination with other substances.

That afterwards he discovered that when compounded with sulphur, and treated with a high degree of heat, good results were obtained; and finally, that a compound of caoutchouc, sulphur, and carbonate of lead, when treated with a high degree of heat, produced the desired result, but that this result could be obtained only by a high degree of heat.

97 The patentee then goes on to describe the nature of his first invention as follows: "The nature of the first part of my invention consists in curing caoutchouc or India rubber, when combined with, or in the presence of, sulphur, by submitting the same to the action of a high degree of artifical heat, at a temperature above solar heat, say from 212° to 350°, or thereabouts, whereby this substance becomes so changed in its properties as to resist, without material change, the variations of temperature below that under which it is cured, and also the action of the expressed and essential oils, and its other known solvents. And the second part of my invention consists in preparing and curing the triple compound of caoutchouc or India rubber, sulphur, and a carbonate of other salts or oxyd of lead, for the purpose above pointed out."

He then proceeds to describe the process and relative proportions of the materials which enter into the composition "of his fabric."

He concludes by stating the leading features of his invention to be the effects produced by heat on the rubber thus combined, and concludes as follows:

The Hancock case.

"What I claim as my invention, and desire to secure by letters patent is, the curing of caoutchouc or India rubber, by subjecting it to the action of a high degree of artificial heat, substantially as herein described, and for the purposes specified.

"And I also claim the preparing and curing the compound of India rubber, sulphur, and a carbonate or other salt or oxyd of lead, by subjecting the same to the action of artificial heat, substantially as herein described."

Now, what is this India rubber, cured substantially as herein described?

It is clearly not merely an improved method or process of producing an old and well-known composition or material, but it is a new product, fabric, manufacture, or composition of matter, having qualities possessed by no other known material. This is what is described and claimed in the patent, a new product as well as a new process.

98 The product and process being both new and proper subjects of a patent, the patentee has a right to prohibit the sale or use of the composition, unless when purchased from persons licensed by him to use the process and vend the product. If precedent be needed for this doctrine, the case of Hancock *vs.* Summerville, in the English Court of Common Pleas, tried in June, 1851, will be found directly in point.

Hancock had seen samples of vulcanized India rubber made by Goodyear, and had succeeded in discovering the process for preparing it. His patent was for "improvements in the preparation or manufacture of caoutchouc in combination with other substances, which preparation or manufacture is suitable for leather, cloth, and other fabrics, water-proof, and to various other purposes for which caoutchouc is employed."

The claim in the specification was in these words: "What I claim as my invention or discovery is—First, the combination of caoutchouc with silicate of magnesia, whereby manufactured caoutchouc is rendered free from that clammy and adhesive character which it usually possesses. Secondly, I claim the modes herein described, combining asphalt with caoutchouc; and thirdly, I claim the treating of caoutchouc, (either alone or in combination with silicate of magnesia, or other substances,) with sulphur, when acted upon by heat, and thus changing the character of caoutchouc herein described."

Injunction allowed.

The infringement charged upon the defendants was the importation and sale of articles made by Mr. Goodyear. Hancock was decided

to be an independent, original inventor, though posterior to Goodyear, because the substance manufactured by Goodyear did not disclose the process by which it was compounded or manufactured. And the sale of articles in England manufactured by Goodyear was adjudged to be an infringement of Hancock's rights as secured by his patent. The patent of Hancock describes his invention as "An improvement in the preparation," &c. His specification and claim set forth a new product and a new process, in terms, not as well chosen as those of Goodyear's patent; yet not even a doubt was sug-
99 gested by counsel that the sale or use of articles manufactured by Goodyear was an infringement of Hancock's patent, provided his patent could be supported. We should ill protect one patentee, (who is admitted to be the first inventor,) if we should permit articles manufactured to be placed in competition with Goodyear here, while the English courts, in the construction of a similar patent, restrain the sale of Goodyear's articles in England. Yet such would be the necessary consequence of a decision of this point adverse to the complainant.

It follows, that the plaintiffs are entitled to their injunction. But the court will not allow it to have the effect of stopping railroad cars having springs made of this composition, without license. It is to be presumed that the defendants have no intention or desire to continue litigation, or to encourage those who are pirating the plaintiff's invention; and believing that the object of the parties is to have these questions decided, and their respective rights ascertained without regard to the matter of damages, which are in this case of small amount, and the cause having been fully and ably argued by the learned counsel, I have given the case more than usual consideration which it is customary to give, on motion for an interlocutory order. My general practice has been to postpone the consideration of difficult or doubtful points till the final hearing of the cause, and not to decide the whole merits of a cause on a mere preliminary motion.

DICKERSON, J.—In this case the bill charges, that Charles Goodyear, one of the complainants, having a patent for the improvements in curing caoutchouc, or India rubber, by which is produced the material or manufacture now known as vulcanized India rubber,
100 assigned to the other complainants, "The New England Car Spring Company," the right to use the material in the manufacture of car springs; and that the defendants are using car springs made of the same material, and thereby infringing the rights of the complainants, and it prays an injunction and an account.

The defendants resist the application for various reasons:

1st. Because the proper parties, complainants, to wit, Judson & Dorr, are not joined, they being assignees or licensees.

2d. Because the patent of Goodyear is for a mere mode or process, and the defendants only use the articles produced by such process, and which were not made or procured to be made by themselves, and therefore no bill can be sustained.

3d. Because the article used is itself the subject of a distinct patent. It is vulcanized rubber, manufactured into an article of merchandise.

4th. Because it is not a case where a preliminary injunction should be granted, because, 1st. Defendants are in good credit. 2d. No irreparable injury to complainants will be produced by waiting. 3d. Great public inconvenience would ensue if injunction be granted. 4th. The complainants have not established their rights at law.

5th. Because the manufacture of the article in question is not an infringement, as it is manufactured by the use of steam, which courts have not decided to be an infringement.

Parties.

Upon examining the bill and affidavits on behalf the defendants, and these objections, it is quite manifest that there is no material fact in the cause which is controverted. As to parties, there is no dispute but that these parties complainants are proper parties; but the allegation is, that others, to wit, Judson & Dorr, as assignees or licensees, are also interested in the pateent, and therefore should have been joined. I will not inquire whether they would be necessary parties, if an account were to be taken. It is enough at this time to say, that the present application is for an injunction, and they are certainly not necessary parties for that purpose. The next

next objection is, that the bill will not be against the defend-
101 ants for the mere use of the article, as the patent is only for a process or mode of making it; and this leads directly to the inquiry as to the extent and character of the patent.

Infringement by use of product.

The rules of construction upon such inquiry, I think are properly defined by Justice Story, in several cases which came under his decision. In the case of Ames *vs.* Howard, he says that "It has always been the course of the American courts to construe these patents fairly and liberally, and not to subject them to over-nice and critical refinements, The object is to ascertain what, from the fair sense of the words of the specification, is the nature and extent of the invention claimed by the party; and when the nature and extent of that are apparent, not to fritter away his rights upon formal or subtle claim objections of a purely technical character." In the case of Blanchard *vs.* Sprague, he says, "Patents, then, are clearly entitled to a liberal construction, since they are not granted as restrictions upon the rights of the community, but are granted to promote science and useful arts."

And in the case of Ryan *vs.* Goodwin, it is said, "If, therefore, there be any ambiguity or uncertainty in any part of the specification, yet, if taking the whole together, the court can perceive the exact nature and extent of the claim made by the inventor, it is bound to adopt that interpretation, and to give it full effect."

Goodyear's patent and specification.

With these rules of construction for a guide, I proceed to examine the patent and specification of Mr. Goodyear, now in question.

He commences by saying, "I have invented a certain new and useful improvement in the manner of preparing fabrics of caoutchouc or India rubber, and the following is a full, clear, and exact description of the principle or character which distinguishes them from all other things before known."

And in the latter part of of the specification he says: "Although I have only described the mode of preparing and curing sheets of India rubber, it will be obvious that my method is applicable to articles of any desired form."

102 The clear and obvious meaning of which is, that he has discovered how to make India rubber, a new thing or manufacture, which in principle and character is distinguished from any other thing before known.

He then proceeds, as by law he was required, to describe the mode or process by which he produces the result, showing that the effect is produced by mixing certain materials with the India rubber, and submitting it to a high degree of heat; but he does not claim the discovery of any particular process or manner of applying the heat, but says that "the operator may communicate the heat in any suitable manner or form;" nor does he claim in his description or specification any particular form, or manner, or process of combining the different ingredients, and preparing them to be submitted to the action of the heat. On the contrary, he expressly claims in his specification that "the leading feature of his invention, and that which chiefly constitutes the substance or essence of its usefulness, is the discovery of the effects produced on India rubber by the action of artificial heat at a temperature above that which the fabric would be exposed in ordinary or common use."

What is it, then, that he claims as his invention or discovery, in order to entitle him to a patent? The law requires that he should have discovered or invented some new and useful art, machine, manufacture, or composition of matter, or some improvement in one of them. It is manifest that this is not a mere art or machine, and equally manifest that it is something more than a mere composition of matter. It must, therefore, be a manufacture. It is not the process a one which he claims as being new in his invention, but the thing itself. In the first part of the specification he states that the fabrics which he prepares (and not the improvements) are distinguished from all other things before known; and in the latter part he says that the leading feature of his discovery; and that which constitutes the essence of its usefulness, is the discovery of the effects produced on India rubber by the action of heat, and that effect is vulcanized rubber. At the close of his specification he claims the

103 curing of caoutchouc or India rubber, by subjecting it to the action of a high degree of artificial heat substantially as therein described, and for the purpose specified.

This may not be the most appropriate form of words to meet the views of the applicant, as contained in the former part of his specification. The question, however, is not whether these are the most appropriate terms, but what is the meaning of those terms, when taken in connection with the other parts of the specification and description.

The word curing, as used here, must be considered as a technical term. If the expression, curing of India rubber by the application of heat as herein described, be construed to mean the converting of India rubber into a new substance or manufacture, not known as vulcanized rubber, it will be consistent with the other parts of the specification and description; and ex vi terminorum, it will bear that construction better than any other. Whereas, if it be construed to be a claim for a new process, it will be inconsistent with the other parts of the specification, and in violation of the obvious meaning of the applicant.

I am therefore of opinion, that upon a fair construction of the specification and description in this case it appears that Charles Goodyear has discovered a new and useful manufacture, now known as vulcanized rubber; and that the right and liberty of making, constructing, using, and vending the same to others to be used, is secured to him by his letters patent.

The Hancock case.

This view of the case is sustained by the decision of the courts in England upon the Hancock patent, which is for this same invention. In this patent Hancock claims "the treating caoutchouc, either alone or in combination with other substances, with sulphur when acted on by heat, and thereby changing the character of caoutchouc as described."

The one claims "curing," and the other claims "treating," India rubber. And in order to understand the meaning of either of the words as applicable to the subject-matter, it is necessary to refer
104 to the description and other parts of the specification, by which it will appear that they mean the same thing. And yet the courts in England protected Hancock against the sale of shoes made of vulcanized rubber in this country, and sent there as merchandise.

Cormick vs. Keane.

In the case of Cormick *vs.* Keane, the patent was for "an improvement or improvements in the making or manufacturing of elastic goods or fabrics applicable to various useful purposes. It was, in fact, an improvement in making shirred goods, and after describing the manner of doing it, the patentee concludes his specification thus: "By thus combining the the strands of India rubber with yarns of cotton, flax, or other non-elastic material, I am enabled to produce a cloth which shall afford any required degree of elastic pressure, according to the proportion of the elastic and non-elastic material. It remains only to add that the strands of India rubber are, in the first

instance, stretched to their utmost tension, and rendered non-elastic, (as described in my former specification,) and being in that state introduced in the fabric, they acquire their elasticity by the application of heat after the fabric is made. Lastly, as my invention consists solely in the employment of strands of India rubber in connection with yarn, in the way described for manufacturing elastic goods or fabrics, I have not deemed it necessary to describe any particular kind of machinery for carrying the same into effect, as such machinery is well known, and forms no part of my invention."

Upon that point the suit was brought; and the jury, upon evidence showing that the defendants had only sold goods similar to those patented, found that they had infringed the patent, and the verdict was sustained. On the argument of the cause at bar, the defendants, among other objections, contended that the invention was not the subject-matter of a patent; that it was neither a new manufacture, nor an improvement in any old manufacture, but merely the application of a known material to a purpose before known. But in giving judgment the court say: "Whether it is new or not, or whether
105 it is an improvement of an old manufacture, was one of the questions for the jury upon the evidence before them. But that it came within the description of a manufacture, and so far is an invention which may be protected by a patent, we feel no doubt whatever. The materials, indeed, are old, and have been used before; but the combination is alleged to be, and (if the jury are right in their finding,) is new, and the result or production is equally so."

This case is singularly like the one under discussion, and strongly confirms the view which I have taken of it.

The third objection necessarily falls within the second.

Injunction.

The defendants insist, in the fourth place, that this is no case for a preliminary injunction, because it is not pretended that the defendants are insolvent, nor that the complainants would suffer irreparable injury by waiting until final hearing.

But it is manifest that neither the public nor the defendants would suffer any inconvenience, at this time, by restraining them from purchasing and using any vulcanized rubber car-springs, except those which they now have in use, and therefore no reason for delay can be founded upon inconvenience to the public or the parties. On the contrary, it should be the desire of the defendants, and it is interesting to all others wishing to use car-springs of this character, to have the earliest possible decision upon the subject.

Trial at law and renewed patent.

As to the allegations that Goodyear has not established his right at law, that he is not the original inventor, and that his renewed patent is void, these are points which are settled in the case of Goodyear *v.* Day in this circuit, and I have seen nothing since to alter my opinion on the subject.

Infringement and steam.

As a further objection to a preliminary injunction, it is said that the infringement is denied. The defendants do not deny that they use the car-springs, but say that the rubber is prepared by the application of steam, and therefore no infringement; and this is made the subject of their last general objection to granting the injunction at any time. I was somewhat surprised to find this objection
106 taken by the defendants at all, but much more when I found my own opinion in the case of Goodyear *vs.* Day cited in support of the position. In that case, the question of the right to use steam in vulcanizing rubber was not raised except as applicable to an objection started by the defendants, that the re-issued patent of 1848 embraced a different and more extensive use of hea t than the original patent of 1844, which was surrendered. Upon examining the two patents and specifications I was satisfied that there was no foundation for the objection, and therefore I remarked that "I did not inquire whether the complainant might use heat in the form of steam for the purpose of curing rubber, as that was not in issue." And I am at a loss to discover how the defendants in this cause can use that opinion to support their position, and more especially as, by reference to a former part of the same opinion, when remarking upon the patent of 1844, I say: "Under this specification he had the undoubted right to use heat of any kind then known." It is true that this was a mere dictum, but it was, and still is, my opinion. Mr. Goodyear, in his specification, uses the term heat, or artificial heat, without distinguishing any particular kind of heat; and it appears to me that the maxim, qui hæret in litera hæret in cortice, most aptly applies to any one who should contend that there was any essential difference whether the heat be applied by means of steam or hot air, both being heated by the combustion of fuel. A similar distinction was, indeed, once attempted as to Daniell's patent, in which the invention consisted in immersing rolls of cloth in hot water. Another patent was obtained for subjecting similar rolls of cloth to the operation of steam bath instead of immersing them in hot water, but it was held to be an infringement.

Unfortunately for the position of the defendants in this case, the complainant, Goodyear, did, in fact, use steam for vulcanizing rubber, as it appears by his description, in which he says, "this heating process may be effected by running the fabrics over heated cylinders, but I prefer to expose them to an atmosphere of arti-
107 ficial heat of the proper temperature," &c. Now, it is well known that these cylinders are heated by steam, and that it is also known that the car-springs of the defendants are made by placing the rubber in a cylinder, and submitting the cylinder to the action of steam, so that the only difference between them is, that in one case the rubber is placed inside of the cylinder, and the steam applied on the outside; in the other, they change places, and the rubber takes the outside of the cylinder, and the steam the inside.

So it appears that Goodyear did, in fact, contemplate and de-

scribe the use of steam in vulanizing rubber; but he made no claim to that particular mode, for the plain reason that it is included in the claim of applying heat generally.

I am, therefore, of opinion, upon a view of the whole case, that that the complainants are entitled to their injunction.

United States Circuit Court.—In euqity.—Before Judge Nelson, December 1, 1853.

108 *Exhibit D.*

CHARLES GOODYEAR AND THE NEW ENGLAND Car Spring Company
against
ANSON G. PHELPS, HORACE H. DAY, William E. Dodge, George W. Pratt, and George T. M. Davis.

This is a motion for an injunction against the defendants, for an alleged infringement of Goodyear's patent, "for a new and useful improvement in India rubber fabrics."

The plaintiffs, the New England Car Spring Company, are the assignees of Goodyear for the exclusive right to use the improvement or invention in the manufacture of India rubber springs for railroad cars, locomotives, and tenders.

The first patent was issued to Goodyear, June 15, 1844, and was afterwards surrendered and re-issued, December 25, 1849, on an amended specification.

The bill sets forth a suit in the Circuit Court for the district of New Jersey, between Goodyear and Day, one of the defendants, and that, after a hearing in that court, involving the validity of this reissued patent, a decree was rendered in the September term, 1852, in favor of the complainant, holding that Goodyear was the first and original inventor of the improvement claimed, and that the letters patent were valid in all other respects.

The bill further charges that, after the hearing of the case referred to in New Jersey, and while under advisement by the court, the defendants, Phelps, W. E. and D. S. Dodge, Pratt and Davis, combined with Day, with full knowledge of the facts respect-
109 ing the suit in New Jersey, and that it involved the validity of Goodyear's patent, to infringe the same, and commenced manufacturing car-springs out of India rubber, mixed or compounded in some form with sulphur, and cured or vulcanized by a high degree of artifical heat, in violation of the patent.

Interrogatories are appended to the bill, calling upon the defendants to answer whether or not they, or some of them, are engaged in manufacturing India rubber for car-springs, prepared, cured, or vulanized by applying to it a high degree of artificial heat in con-

nection with sulphur alone in some form, or with sulphur and white lead, or the carbonate or other salt or oxyd of lead.

In addition to the case of Goodyear against Day, decided in the Circuit Court of the United States, at the September term, in New Jersey, already referred to, the opinion of that court has been furnished on a suit of these plaintiffs against the Central Railroad of New Jersey, in which an injunction was granted, and in which the principal objections were presented and overruled that are now relied on before me. They were—

First. That the complainants were not the proper parties for the suit.

Second. That the rubber used in the defendant's car springs was made by a process in which steam is the chief agent, and is, therefore, no infringement of complainant's patent; and

Third. That Goodyear's patent is for a process of curing rubber, and not for the product or manufacture, and consequently the use of the product is no infringement.

These several questions were very fully considered by the learned judges of the Circuit Court in New Jersey, and the grounds of their decision stated at large, and I need only say, in disposing of this case at this stage of it, that, in my judgment, they are such as well warranted the granting of the preliminary injunction.

There is some evidence before me bearing upon the ques-
110 tion of originality of Goodyear's patent, and also upon the second and third objections taken in the last case in New Jersey, that may not have been before that court; but it is wholly insufficient and too unsatisfactory to warrant a different conclusion from the one arrived at there; and especially when considered in connection with the mass of evidence taken in the case of Goodyear *vs.* Day, decided at the September term, 1852, which is before me in this case.

The originality of the invention was then most thoroughly examined by the respective parties, as is shown by the seven large volumes of proofs then taken, and to which I have referred. Perhaps no patent in this country was ever subjected to so extended and searching an examination of witnesses as that of Goodyear's on this occasion; and I think it not hazarding much to say it is scarcely possible that any farther light will be hereafter shed upon it by any new or additional evidence. At all events, it must be very different from that which has been produced before me on this motion to produce any such effect.

A point has been made that the defendants are not liable for the infringements charged, as the only participation alleged in the same is as stockholers of an incorporated company, which company is engaged in manufacturing and selling the patented article. However that may be, it appears that the defendants are either directors of the company who have the management and superintendence of the business, and under whose directions the articles are manufactured and sold, or are the agents of the same, concerned in conduct-

ing the business. On this ground I am of opinion they are responsible and properly made parties defendants. Injunction ordered.

E. N. DICKERSON and
JAMES T. BRADY
For Complainants.
GEORGE GIFFORD and
FRANCIS B. CUTTING
For Defendants.

111 *Exhibit E.*

In the matter of the application of Charles Goodyear, of New Haven, Connecticut, for an extension of the patent granted to him on the fifteenth day of June, 1844, for an "improvement in India rubber fabrics," which patent was surrendered and re-issued on the twenty-fifth day of December, 1849, in two separate patents, based on two separate amended specifications, viz.: one for "improvement in processes for the manufacture of India rubber," and the other for "improvement in felting India rubber with cotton fibre."

Monday, the 31st day of May, 1858, having been, by notice published in the newspapers, appointed for the hearing of said application, it was continued until the fourteenth day of June, 1858, at which time the undersigned, having duly considered the evidence adduced, decides that said patent ought to be extended.

J. HOLT, *Commissioner.*

Whereas, upon the application of Charles Goodyear, of New Haven, Connecticut, for an extension of the patent granted to him on the 15th day of June, 1844, and re-issued on the 25th day
112 of December, 1849, in two separate patents based on separate amended specifications, viz.: one for "improvement in processes for the manufacture of India rubber," and the other for "improvement in felting India rubber with cotton fibre," the undersigned, in accordance with the 18th section of the act of Congress, approved the 4th day of July, 1836, entitled "An act to promote the progress of the useful arts, and to repeal all acts and parts of acts heretofore made for that purpose," and the act approved the 27th day of May, 1848, entitled "An act to provide additional examiners in the Patent Office, and for other purposes," did, on this 14th day of June, 1858, certify that said patent ought to be extended:

Now, therefore, I, Joseph Holt, Commissioner of Patents, by virtue of the power vested in me by said acts of Congress, do renew and extend the said patent, as re-issued in said two patents designated as above, and certify that the same is hereby extended for the term of seven years from and after the expiration of the first term, viz.: from the 15th day of June, 1858, which certificate being duly entered of record in the Patent Office, the said patent has now the same effect in law as though the same had been originally granted for the sum of twenty-one years.

And it appearing from proof on file in this office that the originals of said two re-issued patents, dated as aforesaid, on the 25th day of December, 1849, have been lost or destroyed, and cannot now be produced, it is directed that this certificate of extension be entered on certified copies of said re-issued patents.

In testimony whereof, I have caused the seal of the Patent Office to be hereunto annexed this 14th day of June, 1858, and of the independence of the United States the eighty-second.

[L. S.] J. HOLT, *Commissioner.*

113 *Exhibit F.—Goodyear to Naugatuck I. R. Co.*

JULY 18, 1844.

This indenture, made this 18th day of July, A. D. 1844, by and between Charles Goodyear, of Naugatuck, New Haven county, State of Connecticut, of the one part, and the Naugatuck India Rubber Company, a joint stock corporation, duly incorporated pursuant to the statute of the State of Connecticut, of the other part, witnesseth:

That the said Charles Goodyear, in consideration of the payments and stipulations herein provided, hath given and granted, and by these presents doth give and grant, unto the said Naugatuck India Rubber Company, a full and absolute license to use any and all his preparations of India rubber, and improvements in the preparation of India rubber, for manufacturing cloths or any other article of merchandise, or any article to which the same may be applicable, for and during the unexpired term of all patents issued to him bearing any date whatsoever, and for and during the unexpired term or terms of any other patent, patents, or renewals of patents owned by him, or in which he may have an interest, issued or to be issued, and this license is to extend to all his, said Goodyear's, future improvements and preparations of India rubber, whether patented or not, and is subject to, and is not to impair the license and grants to make the following enumerated kinds of India rubber goods, heretofore granted by said Goodyear, namely, napped cloth, coats, caps, mittens, and gloves; and the license heretofore granted by said Goodyear, to William De Forrest and his associates,
114 at Naugatuck, to manufacture India rubber shoes, for five years, from the 1st day of October, 1843, and the contract made by said De Forrest with Samuel P. Lewis, for a continuance of said license for five years further, and the license heretofore granted by said Goodyear to Ralph B. Steel and his associates, at New Haven, to manufacture India ruuber shoes for three years, from the 5th day of June, A. D. 1844; but after the expiration of said respective terms, this present license shall extend to and include the manufacture of India rubber shoes in the same manner, and as fully as any other article of India rubber goods.

And the said Charles Goodyear does hereby for himself, his heirs, executors, administrators, and assigns, covenant and agree to and and with the said Naugatuck India Rubber Company, not to make use, or vend, or to grant to any other person or company whatever,

any other license to make, use or vend said preparation or improvements in the preparation of India rubber, or to apply the same to any of the purposes to which the same can be usefully applied during the continuance of the license hereinbefore specified and granted to the said Naugatuck India Rubber Company, subject nevertheless to the following reservation, namely: That if, at any time after 20th day of July, A. D. 1844, the said Goodyear, his heirs, executors, administrators, or assigns, shall deem it for his or their interest to sell for a stipulated price or sum in gross, the exclusive right for the unexpired period or periods for which the same may be vested in him or them, of making, using or vending said preparations or improvements, or of applying the same to or for any specified purpose or purposes only, or to and for all of the purposes and uses to which said improvements may be adapted or applied, the right and liberty of so doing is hereby expressly reserved to the said Goodyear, his heirs, executors, administrators, or assigns, provided, nevertheless, that before any such sale or sales shall be made by him or them for any such stipulated price or sum in gross, the Naugatuck India Rubber Company shall have the right to become the purchaser thereof, at and for such price or sum in gross, and such sale or sales
115 shall not be made to any other person or company, except on the refusal or neglect of the said Naugatuck India Rubber Company, for sixty days time after such offer shall have been made them, to become the purchasers thereof as aforesaid, nor then, until one-fourth part of such stipulated price or sum in gross shall be first paid or secured to said Naugatuck Innia Rubber Company to their satisfaction, by said Goodyear, his heirs, executors, administrators, or assigns; and thereupon the license hereinbefore granted to said Naugatuck India Rubber Company, shall, to the extent of the exclusive right or rights which shall be sold as aforesaid, and for which one-fourth part of the price shall have been paid or secured to them as aforesaid, wholly cease; and the said Charles Goodyear for himsetf, his executors, administrators, and assigns, hereby further covenants and agrees with the said Naugatuck India Bubber Company that he will, at all times, and to the best of his abilities, aid and assist the said Naugatuck India Rubber Company in the carrying on of the said manufacture of India rubber goods, by furnishing to them any information which he, the said Goodyear, now possesses or may hereafter possess or acquire, which may enable them to carry on or improve and extend the said manufacture, and by using his, said Goodyear's, influence in procuring for them orders and business and a sale for the articles which they may manufacture, and that the said Goodyear, his heirs, executors, administrators, and assigns, will, at his and their expense and cost, prosecute with all possible despatch and carry on to final judgment a sufficient number of suits against violations of the aforesaid patents, or any other patents of said Goodyear's relating to this composition or machinery, either so as to defend and protect said Naugatuck India Rubber Company, in the full enjoyment of all their privileges, until it shall appear to disinterested judges in the law that said patents cannot be defended by law; and

the said Naugatuck India Rubber Company, for themselves and their successors, in consideration of the premises, hereby covenant and agree with the said Goodyear, his heirs, executors, adminis-
116 trators, or assigns, to pay to him or them, semi-annually, five cents on each and every merchantable square yard of India rubber cloth so as aforesaid manufactured by them, whether made up into articles by them, or sold in the piece, due and proper allowance being made for the trimming and shrinking of goods, and for other India ruber goods not reducible to the square yard, and equivalent thereto. It is provided, nevertheless, that if said Naugatuck India Rubber Company shall enter into the manufacture of India rubber paper or goods made of India rubber and raw cotton for maps, book-binding, paper-hangings, covering for band-boxes, and the like, or the manufacture of cheap muslins for umbrella covers, cloth sold to others for japanning or covering for band-boxes, the price of these light goods aforesaid shall be three cents per yard, to be paid to said Goodyear, his heirs, executors, admistrators or assigns.

And the said The Naugatuck India Rubber Company further covenants and agrees with the said Goodyear, his heirs, executors, administrators, and assigns, that they, the said Naugatuck India Rubber Company, will stamp with the words "Goodyear's Patent" each and every article and piece of India rubber goods manufactured by them, when the size and circumstances thereof will admit the same to be conveniently done; and also, that they, the said Naugatuck India Rubber Company, will keep true and correct accounts and books, showing the kind and amount of all the goods, merchandise, and articles so as aforesaid manufactured by them, and showing the amount to be paid to said Goodyear truly and fully; which accounts and books shall, at all reasonable times, be open to the inspection of said Goodyear and of his heirs, executors, administrators, or assigns, for the purpose aforesaid; and that also, all improvements and discoveries made by them, tha said Naugatuck India Rubber Company, as well as by the said Goodyear, his heirs, executors, or administrators, either in relation to the gum, composition, machinery, method or process of preparing and manufacturing said India rubber goods,
shall be the property of said Goodyear, his executors, adminis-
117 trators, or assigns, and shall be patented by him or them, at his or their own cost, if deemed advisable to be patented, and shall be subject to all the terms, conditions, and stipulations of this instrument, and the said Naugatuck India Rubber Company shall have the same rights, powers, and privileges in and respecting the same as they have to the invention, preparations, and improvements which are the subject-matter of this instrument. And also, that in case the said Naugatuck India Rubber Company shall sell, assign, or transfer to any person or company any portion, or all, the rights granted to them by said Goodyear, by this instrument they shall, in every such sale, transfer, or assignment, insert an agreement on the part of every such purchaser, that such purchaser will comply with all the terms, conditions, and stipulations which the said Naugatuck India Rubber Company are bound by this instrument to observe and

perform, so far as the same shall be applicable to the right so purchased, but the said Naugatuck India Rubber Company shall not be held responsible for the fulfillment, on the part of any such purchaser of any such stipulation or agreement.

And further, if the said Naugatuck India Rubber Company shall furnish to said Goodyear, his heirs, executors, administrators, or assigns, specimens of such articles of India rubber goods as the said Naugatuck India Rubber Company have the facilities of making, when required by him or them, he or they paying the full cost price thereof, taking into view the convenience or inconvenience of making the same.

And further, if the said Naugatuck India Rubber Company and their assigns shall, for the term of one year, at one time, neglect or refuse, or be unable from want of means to prosecute the business contemplated by this instrument, or to stamp the articles manufactured, in disregard of the written remonstrances of the said Goodyear, or his executors or administrators, so that the object of this instrument shall fail for said term, then, at the expiration of said year, the license contained in this instrument shall become and be void and of no effect as to the time after said year.

118 And whereas, the said Goodyear has heretofore sold to D L. Suydam, of New York city, the right to manufacture shirred goods, the said right is hereby excepted from the operation of this instrument, in addition to the exceptions above mentioned.

In witness whereof, the said parties have hereunto placed their hands and seals, in duplicate, at the city of New Haven, on the 18th day of July, A. D. 1844. And the said company having no corporate seal, uses an ordinary seal in the execution of this instrument.

[L. S.] CHARLES GOODYEAR.
[L. S.] NAUGATUCK INDIA RUBBER COMPANY.
By THOMAS LEWIS, *President and Agent*.

Signed, sealed, and delivered in presence of—

HENRY C. LANDON.
ISAAC H. TOWNSEND.

STATE OF CONNECTICUT, *New Haven County, ss*:

New Haven, this 18th day of July, A. D. 1844, then and there personally appeared Charles Goodyear, to me well known, signer and sealer of the above and foregoing instrument, and acknowledged the same to be his free act and deed, before me, the subscriber.

ISAAC H. TOWNSEND,
Justice of the Peace for said County.

STATE OF CONNECTICUT, *New Haven County, ss*:

New Haven, this 24th day of July, A. D. 1844, then and there personally appeared Thomas Lewis, president and agent of the Naugatuck India Rubber Company, to me well known, signer and
119 sealer of the above and foregoing instrument, and acknow-

ledged the same to be his free act and deed, and the free act and deed of said company, before me, the subscriber.

ISAAC H. TOWNSEND,
Justice of the Peace for said County.

Received and recorded September 16th, 1844.

THE UNITED STATES PATENT OFFICE.

To all whom these presets shall come, greeting:

This is to certify that the annexed is a true copy from the records of this office.

In testimony whereof, I, William D. Bishop, commissioner of patents, have caused the seal of the patent office to be hereunto affixed, this 26th day of May, in the year of Lord one thousand eight hundred and fifty-nine, and of the independence of the United States the eighty-third.

[L. S.] WILLIAM D. BISHOP.

120 *Exhibit G.*

This indenture, made this fourth day of December, eighteen hundred and forty-eight, between the Naugatuck India Rubber Company, a corporation duly incorporated, pursuant to the statute of the State of Connecticut, of the first part, and the Union India Rubber Company, established in the city and county of New York, of the second part:

This indenture witnesseth, that the party of the first part, for and in consideration of the sum of fifty thousand dollars, lawful money of the United States of America, to them in hand paid by the party of the second part, the receipt whereof is hereby acknowledged, have granted, bargained and sold, and by these presents do grant, bargain, and sell, assign, transfer, and set over unto the party of the second part, their successors and assigns, all and singular the right, title and interest of the party of the first part, of, in, and to a certain letter of license granted by Charles Goodyear to the party of the first part, bearing date the 18th day of July, 1844, and recorded in the patent office in the city of Washington; and by said license or grant, the said Charles Goodyear did bargain, sell, and assign unto the said Naugatuck India Rubber Company, party hereto of the first part, their successors and assigns, a full and absolute right and license to use all his improvements in the preparation of India rubber as secured to him by patents from the United States, so far as they relate to, or may be used in the manufacture of any articles of merchandise, except such as in the said letters of license are excepted, as will more fully appear by reference to the said license, and which is for that purpose made a part of this assignment, and except piano-forte covers and buckets.

121 Hereby giving and granting to the party of the second part, their successors and assigns, full power and authority, at their risk and expense, to do all matters and things that they, the party of

the first part, might or could lawfully do under and by virtue of the said letters of license in the premises, had not these presents been made.

Subject, however, to the payment of all the percentage, and all other moneys therein mentioned to be paid, and the due performance of all and singular the covenants and agreements therein mentioned, which on the part and behalf of the said Naugatuck India Rubber Company are to be paid, kept, done, and performed, and which the said party hereto of the second part hereby assume, and agree to pay and perform.

To have and to hold the above granted and bargained premises, and all benefit and advantage to be derived therefrom, unto the party of the second part, and to their successors and assigns, for, and during the time the party of the first part would be entitled to the same had not these presents been made.

And the said party hereto of the second part, do hereby covenant, promise, and agree, to, and with the said Naugatuck India Rubber Company, that the said party, hereto of the second part, and their successors and assigns, will pay, perform, and comply with all the terms, conditions, and stipulations in the several agreements of the said party hereto of the first part, with the said Charles Goodyear, which the said Naugatuck India Rubber Company is bound by the said several agreements, hereinbefore referred to, to observe and perform, so far as ths same shall be applicable to the rights so purchased, and the party of the second part, its successors or assigns, hereby agree to indemnify and save harmless the party of the first part for any loss or damage they may sustain by any default in this agreement.

And for the true and faithful performance of the agreements herein contained, each party bind themselves firmly by these presents.

In witness whereof, the party hereto of the first part hath
122 caused their common seal to be attached, and the same to be signed by the treasurer, who is authorized so to do; and the party hereto of the second part hath hereto caused their common seal to be affixed, and the same to be signed by their treasurer and countersigned by their secretary, the day and year first above written.

[L. S.] JOHN TROTTER,
Treasurer of the Naugatuck India Rubber Co.

[L. S.] WILLIAM RIDER,
Treasurer of the Union India Rubber Co.

[L. S.] F. W. G. BELLOWS,
Secretary of the Union India Rubber Co.

Sealed and delivered in the presence of—
WILLIAM E. RIDER.
THOMAS CAMPTON.

UNITED STATES PATENT OFFICE.

Received the 19th, and recorded the 22d day of February, 1850, in Liber B, 2, page 17, of Transfers of Patent Rights.

In testimony whereof, I have caused the seal of the Patent Office to be hereunto affixed.

[L. S.] THOS. EWBANK,
Commissioner of Patents.

123 *Exhibit H.*

This memorandum of an agreement between Charles Goodyear, party hereto of the first part, and Jonathan Trotter and William Rider, Emory Rider and John Rider, partner, doing business under the name and firm of W. Rider & Brothers, parties of the second part, witnesseth:

That Charles Goodyear, in consideration of the stipulations herein contained on the part of the said Jonathan Trotter and the said W. Rider & Brothers, parties hereto of the second part, doth hereby grant and convey to the said Trotter and the said Riders the sole and exclusive right to use all his inventions or improvements made or owned by him, or in which he is interested by patents or otherwise made or to be made in relation to the preparation or treatment of India rubber for manufacturing the following articles, namely: all army and navy equipments, sheet rubber of every kind, travelling and other bags (except bags with slide mouth-piece,) buckets and pails, beds filled with water or air, and pillows, life preservers, and cushions, carriage cloths and other cloths, where the cloth is woven, (but not to extend to any knapped or knit cloth, or painted carpeting, or any cloths made by mixing cotton or wool or silk, flax or hemp, or other fibrous substances, with India rubber in layers or otherwise;) and also the sole and exclusive right to make India rubber syringes, breast-bottles, aprons of every description to be worn by persons. And also the right, but not the exclusive right, to make hose; reserving the right to said Goodyear to grant a right for one other establishment, besides the right already granted to Horace H. Day.

And it is hereby agreed and to be understood, that no license is hereby intended to be given to make mail-bags and ship-letter bags, inasmuch as the right to manufacture them has been previously granted.

124 And it is further agreed, and to be understood, that they are to have the right to use in the manufacture of any article provided for in this agreement, any napped or knit cloths, or any printed or other cloths made by mixing cotton or wool or silk or flax, hemp, or other fibrous substances with India rubber in layers or otherwise, which have been above excepted.

And this agreement is not to interfere with previous outstanding grants made by said Goodyear, without the consent of the grantees (where such grants have been confirmed by the Naugatuck Company;) and it is to continue during the unexpired term or terms of said patents, or any of them, or the renewals thereof.

And it is further agreed, and to be understood, that all the above articles made by the grantees herein during the term or terms aforesaid, shall be deemed and taken to be made under this agreement, and be paid for as hereinafter provided, so long as said patents, or any of them, relating to said improvements are in force, and until set aside as void by a court in the last resort having jurisdiction thereof.

In consideration whereof, the said Jonathan Trotter and said W. Rider & Brothers agree to pay said Goodyear three cents upon every square yard of merchantable cloth made under this agreement, as aforesaid, and on all India rubber manufactured for sale in sheets or otherwise, and sold at fifty cents or under, three cents per pound; and on all India rubber manufactured for sale in sheets or otherwise, and sold as gum at a price exceeding fifty cents per pound, a tariff of five cents per pound; and on all other articles not specified, five per cent. on the amount of sales. The accounts are to be carefully and correctly kept, showing the amount manufactured and the amount to be paid thereon, and be rendered on the first day of January next, and quarterly thereafter; and the amount due for tariff shall be payable at the same time.

The books of the concern, so far as relates to this agreement, shall be open at all reasonable times to the inspection of said Goodyear and others interested in this agreement.

125 All the goods manufactured under this agreement by said Trotter & Riders, or their assigns, are to be conspicuously stamped with the words "Goodyear's Patent." And it is further agreed, that the said Trotter & Riders shall retain fifteen per cent. of said tariff, which they agree with Seth P. Staples and William Judson to pay to them or their order for defraying the expenses, costs, and counsel fees which may arise in sustaining, protecting, and defending said Goodyear's patents and improvements, they having entered into arrangement with said Goodyear for that purpose, agree to apply the said fifteen per cent. for the purpose aforesaid.

Twelve and a half per cent. of said tariff to be reserved and paid to said William Judson, or order, for and on account of his interest in the same.

And twelve and a half per cent. more of said tariff is to be reserved and paid to the Naugatuck India Rubber Company, or to their assigns, and to be in full of all their right to the use of any of said Goodyear's said improvements or tariffs so far as comprehended in this agreement, when said company shall have assented to the same. And it is agreed, and to be understood, that this clause has reference only to the articles conveyed exclusively under this agreement. In order that said Goodyear and others interested in said tariff may have some certain income therefrom, the said Trotter & Riders agree that there shall be made under this agreement an amount of articles, including mail-bags and clothing, (the right to manufacture which is now owned by the parties hereto or their associates,) as well as articles made under the Naugatuck contract, equal to the work of two spreading calenders a year, allowing two months in each year for repairs and detentions; and this rule is to become applicable on the first day of January next.

And it is agreed that said Trotter & Riders will not make and sell India rubber in its raw or uncured state for others to make up or prepare according to said Goodyear's improvements, without the written consent of said Goodyear as first had and obtained, or
126 unless said persons have purchased a license for the same from said Goodyear.

And it is further agreed by said Trotter and Riders that they will not knowingly make and sell Goodyear's prepared gum to persons, to be used in carrying out their patented inventions, without said Goodyear's consent.

And it is further agreed by said Trotter and Riders, that they will not assign this agreement, (except to the Union India Rubber Company,) without the consent of said Goodyear first had and obtained in writing.

And it is further agreed that said Trotter and Riders, and their assigns, shall have a right to make all the articles under this agreement which the Naugatuck India Rubber Company have a right to make under their agreements with said Goodyear. or any of them, provided said company assent thereto, and said Trotter and Riders, or their assigns, pay a tariff on the same, as is provided in this agreement.

And the said Trotter and Riders agree with said Goodyear that they will procure the assent of the said Naugatuck India Rubber Company to this arrangement, so far as it relates to the articles conveyed exclusively under the same, and such other articles as may be brought in from under the said Naugatuck India Rubber Company's contract. Notarial copies of this agreement shall be furnished to each party interested therein, which shall be equally binding as the original, and may be used as such. And it is further agreed that said Trotter and Rider & Brothers, or their assigns, shall not make sheet rubber, or stayed goods of sheet rubber, and sell it by the piece to be cut up and applied to the manufacture of suspenders or other articles where the right has been previously sold.

And whereas an agreement was entered into on the 18th day of July, 1844, between the said Charles Goodyear and the Naugatuck India Rubber Company, in which the said Goodyear did make certain grants to the said company, as by reference thereto will more fully and at large appear.

And it is hereby agreed that, for the purpose of defining
127 and grants, reference is thereto to be had, and it is to be considered for that purpose, so far as applicable, a part and parcel of this agreement, (so far as applicable.)

That it shall and may be lawful for the said Naugatuck India Rubber Company to sell, and assign, and convey all or any part of the rights therein granted to the parties hereto of the second part, or to the Union India Rubber Company.

And it is agreed that all rights taken by Goodyear from under the contract above referred to, and not sold by said Goodyear, shall be restored back by said Goodyear to the said pany, and may be brought in under this contract.

And all articles bought under this agreement over which said Goodyear has the right of sale, shall be subject to the same conditions of sale as those under the contract made with the Naugatuck India Rubber Company, save and except in any future sales which the said Goodyear has a right to make, the parties hereto of the second part, or their assigns, shall be bound to decide whether they will become the purchasers at or for the price or sum offered within twenty days instead of sixty days time after such offer shall have been made, as stipulated in the said contract before referred to. And in such sales so to be made by the said Goodyear, he shall be subject to pay before executing a license, only one-eighth of the bonus and an order for one-eighth of the tariff that may acrue under said sale, instead of one-feurth, as stipulated in said Naugatuck contract.

And it is also agreed, and to be understood, that all the right to manufacture articles which the parties of the second part hereto may obtain from the Naugatuck India Rubber Company under the contract before referred to, shall be subject to pay tariff as is herein provided. All improvements and discoveries made by the grantees herein, or their assigns, either in relation to the gum, composition, machinery, method, or process of preparing and manufacturing India rubber, shall be the property of said Goodyear, subject to the terms and conditions of this instrument. And for the true and faithful performance of all and singular the covenants and agreements
128 herein contained, each party binds himself and themselves to the due and faithful performance of this agreement so far as he or they have covenanted and agreed to perform the same.

In witness whereof, the parties to these presents have hereunto interchangeably set their hands ard seals, this first day of July, in the year of our Lord, one thousand eight hundred and forty-eight.

[L. S.] CHARLES GOODYEAR.
[L. S.] WILLIAM RIDER.
[L. S.] EMORY RIDER.
[L. S.] JOHN RIDER.
[L. S.] JONATHAN TROTTER.

Sealed and delivered in presence of, (as to Charles Goodyear at Jersey city)—

G. J. S. THOMPSON.

As to other parties—

ELMER GRANGER.

UNITED STATES AATENT OFFICE.

Received the 19th, and recorded the 22d day of February, 1850, in Liber B, page 1 of Transfers of Patent Rights.

In testimony whereof, I have caused the seal of the Patent Office to be hereunto affixed.

[L. S.] THOMAS EWBANK,
Commissioner of Patents.

Exd.—J. J. R.

129 *Exhibit I.*

This indenture, made this fourth day of December, eighteen hundred and forty-eight, by and between Jonathan Trotter, of the city of Brooklyn, county of Kings, and State of New York, and William Rider, Emory Rider, and John Rider, of the city, county, and State of New York, co-partners in business, under the firm and style of W. Rider & Brothers, of the first part, and the Union India Rubber Company, established in the city and county of New York, of the second part.

This indenture witnesseth, that the parties of the first part, for and in consideration of the sum of forty-five thousand dollars lawful money of the United States of America, to them in hand paid by the party of the second part, the receipt whereof is hereby acknowledged, have granted, bargained, and sold, and by these presents do grant, bargain, and sell, assign, transfer, and set over unto the party of the second part, their successors and assigns, all and singular the right, title and interest of the parties of the first part, of, in, and to a certain letter of license and agreement made and entered into with Charles Goodyear, bearing date the first day of July, 1848, by which said Goodyear did, in said agreement, bargain, sell, and assign unto the parties hereto of the first part, their executors, administrators, and assigns, a full, absolute, and exclusive right, to use all his inventions and improvements made or to be made by him, or in which he is interested by patents or otherwise made or to be made, in relation to the preparation or treatment of India rubber for manufacturing the following articles, namely: all army and navy equipments, sheet rubber of every kind, travelling bags, and other bags, except bags with slide mouth-pieces, buckets and pails, beds filled with air or water, pillows, life-preservers, cushions, carriage cloths,
130 and other cloths where the cloth is worn, but not to extend to any napped or knit cloth, or printed carpeting, or any cloth made by mixing cotton or wool, or silk, flax or hemp, or other fibrous substances, with India rubber, in layers or otherwise.

And also the sole and exclusive right to make India rubber syringes and breast-pumps, aprons of every description to be worn by persons.

And also the right, but not the exclusive right, to make hose, reserving the right to said Goodyear to grant a right for one other establishment, besides the right already granted to Horace H. Day; and it is hereby agreed and to be understood, that no license is hereby intended to be given to make mail-bags and ships' letter-bags, and to make such other articles specified in said agreement, as will more fully appear by reference thereto, and which said agreement is for that purpose made a part of this agreement.

Hereby giving and granting to the party of the second part, full power and authority, at their risk and expense, to do all matters and things that they, the said parties hereto of the first part, might or could lawfully do, under and by virtue of the said letter of license in the premises, had not these presents been made.

Subject, however, to the payment of all the per centage, and all moneys therein mentioned to be paid, and to the due performance of all and singular the covenants and agreements therein mentioned, which, on the part and behalf of the said parties of the first part, are to be paid, kept, done, and performed, and subject, also, to the due performance of certain agreements made by said parties of the first part with William Judson and Seth P. Staples, and with William Judson alone, in reference to the tariffs to accrue under such license, and bearing date on the first day of July, A. D. 1848.

To have and to hold the above granted and bargained premises, and all benefit and advantage to be derived therefrom, unto the parties of the second part, and to their successors and assigns, for and during the time the party of the first part would be enti-
131 tled to the same had not these presents been made.

And the said party of the second part, does hereby covenant, promise, and agree, to and with the said parties of the first part, and to and with the said Charles Goodyear, separately, and to and with the said William Judson and Seth P. Staples, jointly and separately, that the said party, hereto of the second part, and their successors and assigns, will pay, perform, and comply with all the terms, conditions, and stipulations in the several agreements made between the parties of the first part, and Charles Goodyear, and between them and William Judson, and between them and William Judson and Seth P. Staples jointly, which the said parties of the first part are bound by the said several agreements, hereinbefore referred to, to keep, observe and perform, so far as the same shall be applicable to the rights so purchased; and the party of the second part, its successors or assigns, hereby agree to indemnify and save harmless the party of the first part for any loss or damage they may sustain by any default in this agreement.

And for the true and faithful performance of the agreements herein contained, each party bind themselves firmly by these presents.

In witness whereof, the parties hereto of the first part have hereunto set their hands and seals, and the party hereto of the second part hath hereto caused their common seal to be affixed, and the same to be signed by their president and countersigned by their secretary, the day and year first above written.

[L. S.]	JONATHAN TROTTER.
[L. S.]	WILLIAM RIDER.
[L. S.]	EMORY RIDER.
[L. S.]	JOHN RIDER.
[L. S.]	JONA. TROTTER, *Pres.*
[L. S.]	F. W. G. BELLOWS, *Sec.*

Signed and sealed in presence of—
THOMAS CAMPION.
Witness to the above signatures.
WILLIAM E. RIDER.

132 UNITED STATES PATENT OFFICE.

Received the 19th, and recorded the 22d day of February, 1850, in Liber B, 2, page 7, of Transfers of Patent Rights.

In testimony whereof, I have caused the seal of the Patent Office to be hereunto affixed.

[L. S.] THOS. EWBANKS,
Commissioner of Patents.

Exd. J. J. R.

Exhibit J.—Charles Goodyear with Jonathan Trotter.

FEBRUARY *5th*, 1847.

This indenture, made this 5th day of February, in the year of our Lord one thousand eight hundred and forty-seven, by and between Charles Goodyear, of the city of New Haven, in the State of Connecticut, of the first part, and Jonathan Trotter, of the city of Brooklyn, and State of New York, of the second part, witnesseth: That the said Charles Goodyear, party of the first part, for and in consideration of the sum of ten thousand dollars to him in hand paid, the receipt of which is hereby acknowledged, and in consideration of the stipulations and conditions hereinafter provided, hath bargained, and sold, and assigned, and by these presents doth bargain, sell, and assign unto the said Jonathan Trotter, party of the second part, his executors, administrators, and assigns, a full, abso-

133 lute, and exclusive right and license to use any and all the machinery, compositions, and methods of manufacturing and preparing India rubber, so far as they are now or may hereafter be used in manufacturing wearing apparel, of every name, kind, or description whatever, for men and boys, (excepting boots and shoes, bathing caps, and gloves and mittens,) which the said party of the first part now has or may hereafter have by virtue of any patent or patents, or otherwise, for and during the unexpired term or terms of any such patent or patents, or renewal or renewals, thereof, which are or may be owned by him, or in which he may have an interest, or of which he may become possessed, and in all the machinery, compositions, and methods of manufacturing and preparing India rubber which have been or may hereafter be invented or purchased by the said party of the first part, and to the same extent that the said party of the first part may be interested therein, so far as the same relates to wearing apparel, as above mentioned, whether they have been or shall be patented or not, to have and to enjoy the said patents, and their renewals, and the said machinery, compositions, and methods of manufacturing and preparing India rubber, as above mentioned, to the said party of the second part, and to his executors, administrators, and assigns exclusively, for the purpose of manufacturing, using, and vending the articles aforesaid, or for assigning or transferring licenses to use such machinery, compositions, methods, and improvements to others for the purposes aforesaid, as fully and to the same extent that the party of the first part now has, or may

ever hereafter have, subject to the payment of the percentage hereinafter named.

And the said Charles Goodyear doth hereby for himself, his heirs, executors, administrators, and assigns, covenant and agree to and with the said Jonathan Trotter, not to make, use, or vend, or to grant to any other person or company whatever, any other license, to make, use, or vend said preparations or improvements in the preparation of India rubber so far as the same are now used or may hereafter be used in manufacturing wearing apparel as aforesaid.

134 And the said Charles Goodyear for himself, his executors, administrators, and assigns, hereby further covenants and agrees with the said Jonathan Trotter, that he will, at all times, and to the best of his abilities, aid and assist the said Jonathan Trotter in the carrying on of the said manufacture of India rubber goods, by furnishing to him any information which he, the said Goodyear, now possesses or may hereafter possess or acquire, which may enable him to carry on, improve and extend the said manufacture.

And that the said Goodyear, his heirs, executors, administrators, and assigns, will, at his and their expense and cost, prosecute with all reasonable despatch and carry on to final judgment a sufficient number of suits against violations of the aforesaid patents, or any other patents of said Goodyear's relating to the composition or machinery, either so as to defend and protect the said Jonathan Trotter in the full enjoyment of all his privileges, or until it shall appear to disinterested judges in the law, that said patents cannot be defended by law; and the said Jonathan Trotter, party of the second part, for himself, his executors, administrators, and assigns, doth hereby covenant, promise and agree to and with the said Charles Goodyear, party of the first part, his executors, administrators, and assigns, that in consideration of the premises he will pay to the party of the first part, his executors, administrators, agents, or assigns, seven-eighths of five cents for each and every square yard of India rubber fabric so prepared as aforesaid, proper allowance being made for the trimming and shrinking of the same, which he, his executors, administrators or assigns, shall make or cause to be made into the articles aforesaid, or any of them, which payment shall be made on the first days of January and July, in each and every year, during the continuance of said patent or patents or the renewal or renewals of them or either of them. It is agreed and understood that the said party of the first part shall not infringe himself upon the rights hereby granted exclusively to the party of the second part;

135 and shall defend them from infringement by others by bringing and prosecuting said suits in the manner above mentioned.

And the said party of the second part further covenants, promises, and agrees, for himself, his executors, administrators, and assigns, to and with the said party of the first part, that all the articles made as aforesaid by him or them, shall be deemed to be made under the patents and improvements of the said Charles Goodyear, party of the first part; and that he and they shall and will observe in all things

the requirement of the United States Patent Law as it applies to the article manufactured by them under said patents and improvements.

And the said Jonathan Trotter further covenants and agrees with the said Charles Goodyear, his executors, administrators, and assigns, that he, the said Jonathan Trotter, will legibly stamp with the words, "Goodyear's Patent," each and every of the aforesaid articles and pieces of India rubber goods manufactured by him, when the size and circumstances thereof will admit the same to be conveniently done.

And also, that he, the said Jonathan Trotter, will keep true and correct accounts and books, showing the kind and amount of all the goods, merchandise, and articles so as aforesaid manufactured by him, and showing the amount to be paid to said Goodyear truly and fully; which accounts and books shall, at all reasonable times, be open to the inspection of said Goodyear or his heirs, executors, administrators, and assigns, for the purpose aforesaid.

And, also, that all improvements and discoveries made by him, the said Jonathan Trotter, as well as by the said Goodyear, his heirs, executors, administrators, and assigns, either in relation to the gum, composition, machinery, method, or process of preparing and manufacturing said India rubber goods, shall be the property of said Goodyear, his executors, administrators, or assigns, and shall be patented by him or them, at his or their cost, (if deemed advisable to be patented,) and shall be subject to all the terms, conditions, and stipulations of this instrument.

136 And the said Jonathan Trotter shall have the same right, powers, and privileges in and respecting the same as he has to the invention, preparations, and improvements which are the subject-matter of this instrument.

And, also, that in case said Jonathan Trotter shall sell, assign, or transfer to any person or company, any portion or all of the rights granted to him by said Goodyear, by this instrument, he shall, in every such sale, transfer, or assignment, insert an agreement on the part of every such purchaser, that such purchasers will comply with all the terms, conditions, and stipulation which the said Jonathan Trotter is bound, by this instrument, to observe and perform, as far as the same shall be applicable to the right so purchased, or such sales, transfer, or assignment, shall be void.

But the said Jonathan Trotter shall not be held responsible for the fulfillment, on the part of any such purchaser, of any such stipulation or agreements.

It is further understood and agreed between the parties, that the party of the first part is not to grant licenses for unfinished or unbaked fabrics, to be put into the market, so as to allow them to be made into wearing apparel as aforesaid; but it is not expected that the party of the first part will prosecute individuals who may make sewed garments out of finished fabrics, unless the same shall be done as a manufacture to such an extent as materially to interfere with the rights herein granted.

In witness whereof, the parties hereto have hereunto set their hands and seals, this day and year hereinbefore mentioned.

[L. S.] CHARLES GOODYEAR.
[L. S.] JONATHAN TROTTER.

Witness:
CHARLES J. GILBERT.

137 UNITED STATES PATENT OFFICE.

Received this 12th day of February, 1847, and recorded in Liber G. 1, page 374 of Transfers of Patent Rights.

In testimony whereof, I have caused the seal of the Patent Office to be hereunto affixed.

[L. S.] EDMUND BURKE,
Commissioner of Patents.

Ex. J. J. R.

Exhibit K.—Jonathan Trotter to the Union India Rubber Company.

DECEMBER 4*th*, 1848.

This indenture, made this fourth day of December, eighteen hundred and forty-eight, between Jonathan Trotter, of the city of Brooklyn, in the county of Kings, and State of New York, of the first part, and the Union India Rubber Company, established in the city of New York and the county of New York, of the second part.

This indenture witnesseth: That the party of the first part, for and in consideration of the sum of twenty-five thousand
138 dollars, lawful money of the United States of America, to him in hand paid by the party of the second part, the receipt whereof is hereby acknowledged, hath granted, bargained, and sold, and by these presents doth grant, bargain, and sell, assign, transfer, and set over unto the party of the second part, their successors and assigns, all and singular, the right, title, and interest of the party of the first part, of, in, and to a certain letter of license granted by Charles Goodyear, to the party of the first part, bearing date the fifth day of February, A. D. eighteen hundred and forty-seven, and recorded on the twelfth day of February, in the said year, 1847, in the United States Patent Office, in Liber G. 1, page 374, of Transfers of Patent Rights, by which said license or grant, the said Charles Goodyear did bargain, sell, and assign unto the said Jonathan Trotter, party hereto of the first part, his executors, administrators, and assigns, a full, absolute, and exclusive right and license to use all his improvements in the preparation of India rubber as secured to him by patent from the United States, so far as they relate, or may be used in the manufacture of wearing apparel of all kinds, except such as in the said letters of license are excepted, as will more fully appear by reference to said license, and which is for that purpose made a part of this assignment.

Hereby giving and granting to the party of the second part, full

power and authority, at their risk and expense, to do all matters and things that he, the said party hereto of the first part, might or could lawfully do under and by virtue of the said letters of license in the premises, had these presents never been made.

Subject, however, to the payment of all the percentage, and all moneys therein mentioned to be paid, and to the due performance of all and singular, the covenants and agreements therein mentioned, which, on the part and behalf of the said Jonathan Trotter, are to be paid and kept, done and performed, and which the said party of the second part hereby assume and agree to perform and pay.

139 And subject also to the due performance of certain agreements made by the said Jonathan Trotter, with William Judson and Seth P. Staples, and with William Judson alone, in reference to the tariff to accrue under such license, and bearing date on the first day of July, A. D. eighteen hundred and forty-eight, and which the said party of the second part hereby assumes to perform and keep.

To have and to hold the above-granted and bargained premises, and all benefits and advantages to be derived therefrom, unto the parties of the second part, and to their successors and assigns, for and during the time the party of the first part would be entitled to the same had not these presents been made.

And the said party hereto of the second part, do hereby covenant, promise, and agree to and with the said Jonathan Trotter, that the said party hereto of the second part, and their successors and assigns, will pay, perform, and comply with all the terms, conditions, and stipulations in the several agreements of the said party of the first part with the said Charles Goodyear, and with William Judson and Seth P. Staples, jointly, and with William Judson alone, which the said Jonathan Trotter is bound by the said several agreements hereinbefore mentioned to observe and perform, so far as the same shall be applicable to the rights so purchased, and the said party of the second part, its successors or assigns, hereby agree to hold the said party of the first part harmless, and to indemnify him of and from any loss or damage, which he may suffer by any default in this agreement.

And for the true and faithful performance of the agreements herein contained, each party binds himself and itself to the other.

In witness whereof, the party hereto of the first part, hath hereunto set his hand and seal, and the party hereto of the second

140 part hath hereto caused their common seal to be affixed, and the same to be signed by their treasurer, and countersigned by their secretary, the day and year first above mentioned.

[L. S.] JONATHAN TROTTER.

[L. S.] WILLIAM RIDER,
Treasurer of the Union India Rubber Company.

F. W. G. BELLOWS,
Sec. Union India Rubber Company.

Sealed and delivered in the presence of—

WM. E. RIDER.

THOMAS E. CAMPION.

UNITED STATES PATENT OFFICE.

Received the 19th and recorded the 22d day of February, 1850, in Liber B 2, page 11, of Transfers of Patent Rights.

In testimony whereof, I have caused the seal of the Patent Office to be hereunto affixed.

[L. S.] THOS. EWBANK,
Commissioner of Patents.

Ex. J. J. R.

141 *Exhibit L.*

This agreement made this twenty-third day of April, in the year 1858, between Charles Goodyear, of
of the first part, and the Union India Rubber Company, of the city of New York, of the second part, witnesseth:

That, whereas, the parties of the second part have certain rights and interests in the patents of the party of the first part, in relation to the preparation and treatment of India rubber for manufacturing purposes, under an agreement made by the party of the first part with the Naugatuck India Rubber Company, dated July 18th, 1844, an agreement with Jonathan Trotter, dated February 5th, 1847, an agreement with William Rider & Brothers, dated March 28th, 1847, an agreement made with William Rider & Brothers and Jonathan Trotter, dated July 1st, 1848;

And, whereas, the patent of the party of the first part, dated June 15th, 1844, re-issued December 25th, 1849, is about to expire, and application has been made for an extension thereof:

Now, in order to fix, define, and render certain the rights and obligations of the parties hereto, and of their assigns, and representatives, under any renewed term of said patent or patents, and for other considerations, the parties hereto moving, the party of the first part covenants and agrees with the parties of the second part, their successors and assigns, that the tariff or compensation payable during said renewed term or terms, under the said grants or agreements, shall be three cents on every square yard of merchantable cloth when made up into clothing; two cents on every square yard of merchantable cloth in the piece, or when made up into other articles; one and one-half cents a pound on all India rubber manufactured for sale in sheets or otherwise, and sold at the rate of fifty cents a pound
or under, and two and one-half cents a pound for the same,
142 when sold at the rate of over fifty cents a pound, and two and one half cents a pound for other articles not herein specified. One-eighth part of which tariff or compensation is to be retained by the parties of the second part to their own use.

Which tariff shall be payable on the amount of vulcanized goods which the parties of the second part, their successors or assigns, shall actually make under said agreements, and shall be in full of all tariffs and compensation from the parties of the second part, their successors and assigns.

And it is further agreed that the parties of the second part shall be at liberty to make and sell the prepared gum of the party of the first part, to persons, to be used in carrying out their patented inventions.

And it is further agreed, that the clauses or covenants in the said agreements which relate to patents to be issued, or improvements, or discoveries to be made by either of the parties hereto, are hereby annulled and made void.

And it is further agreed, that all clauses or covenants in the said agreements that bind the party of the first part to prosecute suits for the violation of the aforesaid patent or patents are hereby annulled and made void.

And it is also agreed, that all clauses or covenants in the said agreements that require the party of the first part to assist in the manufacture or sale of India rubber goods, are hereby annulled and made void.

And it is also stipulated and agreed, that the clause or covenant in the said agreement with the Naugatuck India Rubber Company which binds the said company to furnish specimens of India rubber goods at cost price, is hereby annulled and made void.

And it is hereby understood and agreed, that the clauses or covenants that are annulled and made void as above stated, are so for any renewed term or terms of said patent or patents.

And it is stipulated and agreed, between the parties hereto, that the grants and agreements with the Naugatuck Company and
143 others, hereinbefore referred to, shall be and are hereby modified between the parties hereto, as set forth in this agreement, during any renewed term or terms of said patents.

In witness whereof, the parties hereto have subscribed these presents, and affixed their seals thereto, the day and year first abovementioned.

[L. S.] (Signed) CHAS. GOODYEAR.
UNION INDIA RUBBER COMPANY,
[L. S.] By D. C. WHITMAN, *Secretary*.

In presence of—
JOHN RARKER.
JOSHUA NUNN, *Consulate U. S. A., London.*

CONSULATE OF THE UNITED STATES OF AMERICA, AT LONDON.

I, Robert B. Campbell, Consul of the United States of America for London, and the dependencies thereof, do hereby make known and certify, to all whom it may concern, that on the day of the date hereof, before me personally appeared and came Charles Goodyear and Daniel C. Whitman, to me known to be the persons described in, and who have executed the annexed agreement or instrument, and then and there acknowleged the same to be their respective voluntary act and deed.

In testimony whereof, I have hereunto set my hand and affixed the seal of the Consulate of the United States, at London, aforesaid, this

23d day of April, in the year of our Lord one thousand eight hundred and fifty-eight, and in the eighty-second year of the independence of the said United States.

[L. S.] ROBERT B. CAMPBELL.

U. S. PATENT OFFICE.

Received September 18th, 1858, and recorded in Liber X 4, page 273 of Transfers of Patents.

In testimony whereof, I have caused the seal of the Patent Office to be hereunto affixed.

[L. S.] J. HOLT, *Commissioner of Patents.*

144 *Exhibit M.*

This agreement, made this third day of July, in the year 1858, between Charles Goodyear, of New Haven, State of Connecticut, of the first part, and Union India Rubber Company of the second part, witnesseth:

That whereas, under an agreement of said parties, dated the twenty-third day of April, in the year 1858, the parties of the secood part agreed to pay certain sums as tariff for the use of the patents of the party of the first part: Now, for a valuable consideration, the receipt of which is hereby acknowledged, it is agreed that fifteen per cent. of such tariff as may become due to the party of the first part, under said agreement of the twenty-third day of April, 1858, should be reserved by the parties of the second part, to defray any expense that may be required to defend and sustain the aforesaid patents.

Witness our hands and seals, this third day of July, in the year 1858.

[L. S.] CHARLES GOODYEAR.

THE UNION INDIA RUBBER COMPANY,

[L. S.] By HENRY G. HADDEN, *President.*

Witness to both signatures—

GEORGE GRISWOLD, jr.

145 *Exhibit N.—The Union India Rubber Company with Charles Goodyear.*

This agreement, made this twenty-eight day of September, A. D. 1858, between the Union India Rubber Company, of New York city, of the first part, and Charles Goodyear, of the second part, witnesseth:

First. That, whereas the said company claims the exclusive right to manufacture for sale, and to sell all army and navy equipments to the public generally; and exclusively to manufacture and sell druggists' articles, submarine armor, endless aprons (but not printers' aprons,) flasks and cups, horse covers and hoods, wagon aprons, horse boots, gaiter and pant straps, stationers' gum, chest expanders, bath mats, bathing caps, water bottles, piano and table covers, sponge

and soap bags, clothing made of napped or flocked cloth or goods, water tanks and cisterns.

Now, the said Goodyear hereby grants to the said Union India Rubber Company the exclusive right to use all his improvements and inventions, so far as they may apply to the manufacture of the said articles, during the continuance of his patent, and any renewals thereof, and agrees to execute such other paper as the said company may require, to confirm and fully and exclusively vest in the said company and their assigns, the grants and licenses hereby intended to be conveyed.

Second. That the tariff to be paid to the said Goodyear by the said company, on the above-named articles to be manufactured and sold under the said contract, shall be the same as provided in the contract between the said company and the said Goodyear, dated 23d April, 1858.

146 Third. The said company are not to make, use, or vend any knit, napped, flocked, or cork-surfaced fabrics, or articles made of these materials, excepting wearing apparel, as granted to said company, a license held by them, and as hereby ratified and confirmed; and said company shall release and convey to said Charles Goodyear all claim, and possibility of claim, of every kind, that they may, or can have, to make, use, and vend his invention of vulcanized rubber, and all his inventions and improvements, and of any interest in the same, so far as the same may or can be used or applied in the manufacture of knit, napped, flocked, or cork-surfaced articles or fabrics, excepting as aforesaid.

In witness whereof, the parties hereto have subscribed these presents, and affixed their seals the day and year first above mentioned.

THE UNION INDIA RUBBER COMPANY,
[SEAL.] By H. G. HADDEN, *Pres.*
[SEAL.] CHARLES GOODYEAR.

Signed, sealed and delivered in presence of—
L. CANDEE.
H. L. SCRANTON.

UNITED STATES PATENT OFFICE.

Received December 27th, 1858, and recorded in Liber B. 5, page 180, of Transfers of Patents.

In testimony whereof, I have caused the seal of the Patent Office to be hereunto affixed.

[L. S.] J. HOLT,
Commissioner of Patents.

147 *Exhibit O.—Exemplified copy.—Last will and testament of Charles Goodyear, deceased.*

Be it remembered, that heretofore, to wit, on the sixth day of July, in the year one thousand eight hundred and sixty, Charles Goodyear, jr., an executor, named in the last will and testament of Charles Goodyear, late of the county of New York, deceased, ap-

23d day of April, in the year of our Lord one thousand eight hundred and fifty-eight, and in the eighty-second year of the independence of the said United States.

[L. S.] ROBERT B. CAMPBELL.

U. S. PATENT OFFICE.

Received September 18th, 1858, and recorded in Liber X 4, page 273 of Transfers of Patents.

In testimony whereof, I have caused the seal of the Patent Office to be hereunto affixed.

[L. S.] J. HOLT, *Commissioner of Patents.*

144 *Exhibit M.*

This agreement, made this third day of July, in the year 1858, between Charles Goodyear, of New Haven, State of Connecticut, of the first part, and Union India Rubber Company of the second part, witnesseth:

That whereas, under an agreement of said parties, dated the twenty-third day of April, in the year 1858, the parties of the secood part agreed to pay certain sums as tariff for the use of the patents of the party of the first part: Now, for a valuable consideration, the receipt of which is hereby acknowledged, it is agreed that fifteen per cent. of such tariff as may become due to the party of the first part, under said agreement of the twenty-third day of April, 1858, should be reserved by the parties of the second part, to defray any expense that may be required to defend and sustain the aforesaid patents.

Witness our hands and seals, this third day of July, in the year 1858.

[L. S.] CHARLES GOODYEAR.

THE UNION INDIA RUBBER COMPANY,

[L. S.] By HENRY G. HADDEN, *President.*

Witness to both signatures—
GEORGE GRISWOLD, jr.

145 *Exhibit N.—The Union India Rubber Company with Charles Goodyear.*

This agreement, made this twenty-eight day of September, A. D. 1858, between the Union India Rubber Company, of New York city, of the first part, and Charles Goodyear, of the second part, witnesseth:

First. That, whereas the said company claims the exclusive right to manufacture for sale, and to sell all army and navy equipments to the public generally; and exclusively to manufacture and sell druggists' articles, submarine armor, endless aprons (but not printers' aprons,) flasks and cups, horse covers and hoods, wagon aprons, horse boots, gaiter and pant straps, stationers' gum, chest expanders, bath mats, bathing caps, water bottles, piano and table covers, sponge

and soap bags, clothing made of napped or flocked cloth or goods, water tanks and cisterns.

Now, the said Goodyear hereby grants to the said Union India Rubber Company the exclusive right to use all his improvements and inventions, so far as they may apply to the manufacture of the said articles, during the continuance of his patent, and any renewals thereof, and agrees to execute such other paper as the said company may require, to confirm and fully and exclusively vest in the said company and their assigns, the grants and licenses hereby intended to be conveyed.

Second. That the tariff to be paid to the said Goodyear by the said company, on the above-named articles to be manufactured and sold under the said contract, shall be the same as provided in the contract between the said company and the said Goodyear, dated 23d April, 1858.

146 Third. The said company are not to make, use, or vend any knit, napped, flocked, or cork-surfaced fabrics, or articles made of these materials, excepting wearing apparel, as granted to said company, a license held by them, and as hereby ratified and confirmed; and said company shall release and convey to said Charles Goodyear all claim, and possibility of claim, of every kind, that they may, or can have, to make, use, and vend his invention of vulcanized rubber, and all his inventions and improvements, and of any interest in the same, so far as the same may or can be used or applied in the manufacture of knit, napped, flocked, or cork-surfaced articles or fabrics, excepting as aforesaid.

In witness whereof, the parties hereto have subscribed these presents, and affixed their seals the day and year first above mentioned.

THE UNION INDIA RUBBER COMPANY,

[SEAL.] By H. G. HADDEN, *Pres.*

[SEAL.] CHARLES GOODYEAR.

Signed, sealed and delivered in presence of—

L. CANDEE.

H. L. SCRANTON.

UNITED STATES PATENT OFFICE.

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[L. S.] J. HOLT,
Commissioner of Patents.

147 *Exhibit O.—Exemplified copy.—Last will and testament of Charles Goodyear, deceased.*

Be it remembered, that heretofore, to wit, on the sixth day of July, in the year one thousand eight hundred and sixty, Charles Goodyear, jr., an executor, named in the last will and testament of Charles Goodyear, late of the county of New York, deceased, ap-

peared in open court before Edward C. West, surrogate of the county of New York, and made application to have the last will and testament, which relates to both real and personal estate, proved; and on such application the surrogate did ascertain, by satisfactory evidence, who were the widow, heirs, and next of kin of said deceased, and their respective residences; and some of them appearing to be minors, having no general guardian residing in the State of New York, a special guardian was appointed, in due form of law, to take care of their interest, in the matter of proving said will, by an order duly entered for that purpose by said surrogate; and said surrogate did thereupon issue a citation directed to said widow, heirs, and next of kin, and special guardian, by their respective names, stating their places of residence, requiring them to appear before said surrogate, at his office in the city of New York, on the second day of August then next, to attend the probate of said will; and afterwards, to wit, on the said second day of August, satisfactory evidence, by affidavit, was adduced and presented to said surrogate of the service of the said citation in the mode prescribed by law; and on that day no one appearing to oppose the probate of said will, such proceedings were thereupon had afterwards that said surrogate took the proofs of said will hereinafter set forth, and upon this sixth day of August, in the year one thousand eight hundred and sixty, he adjudged said will to be a valid will of real and personal estate, and the proofs
148 thereof to be sufficient; which said last will and testament and proofs are as follows, that is to say:

I, Charles Goodyear, do make, publish, and declare to this my last will and testament, as follows: I appoint my son, Charles Goodyear, junior, my wife, Fanny Goodyear, and my friend, James A. Dorr, executors of this my last will and testament. I give, devise, and bequeath to my said executors all my property of every nature and kind, with full powers of conversion, investment, re-investment, letting, licensing, leasing, mortgaging, assigning, selling, transferring, and conveying the whole, or any part thereof, as they, in their unlimited discretion, may deem expedient; and it is my will that my said executors shall not be required to give any bond or security whatsoever; and I direct that my executors shall, as soon as they may deem expedient, distribute or partition my estate as follows: One-third part thereof to my wife, Fanny Goodyear, in lieu of dower and all right of dower. The remainder of my estate, or in case my wife shall elect dower, then the whole of my estate, subject to dower, as follows: To my children, and the child or children of any deceased child, per stirpes and not per capita, to my adopted daughter, Julia Spencer, and her two sisters, distributing among them a portion equal to the share of one of my children, (one moiety of such portion to said Julia Spencer, and one-quarter part thereof to each of her two sisters;) and to the child or children of my brother, Henry B. Goodyear, a portion equal to the share of one of my children, such such portion to be distributed equally among them. And I further direct that my executors shall have absolute power to appraise, partition, and divide my estate in conformity with the directions here

given, as they may deem equitable, and no legatee shall have any right to question the validity of their decisions. And I further direct that a majority of my acting executors shall decide all questions which may arise among them; and further, that any act or act
149 of a majority shall be equally binding with, and equivalent to, the acts of all united; and in case there shall be, at any time, two acting executors only, I authorize them to appoint a third executor, by a written instrument of appointment, to be filed with the surrogate or judge of probate of the county in which this will shall first be proven, and in case there shall be at any time but one acting executor, I authorize him to appoint a second executor, by a written instrument of appointment to be filed with such surrogate or judge of probate, such appointment, however, to be subject to the approval of said surrogate or judge of probate, and any executor appointed according to these provisions, shall not be required to give any bond or security. I hereby revoke, cancel, and annul any and all wills and testaments heretofore made by me.

In witness whereof, I have hereunto set my hand and seal this ninth day of June, A. D. eighteen hundred and sixty.

[L. S.] CHARLES GOODYEAR.

In the presence of—
FRS. BACON.
CHAS. B. KIMBALL.
JOHN SCHREIBER.

The above instrument was, at the date thereof, in the presence of each of us, signed, sealed, published, and declared by Charles Goodyear, the testator therein named, to be his last will and testament; and the said Charles Goodyear, at the same time, acknowledged to us that he had signed and sealed the said instrument as and for his last will and testament; and we thereupon, at his request, and in his presence, and in the presence of each other, signed our names thereto as attesting witnesses.

FRS. BACON,
Residing at Fifth Avenue Hotel, New York.
CHAS. B. KIMBALL,
Residing at 370 *Sixth Avenue, New York.*
JOHN SCHREIBER,
Residing at Fifth Avenue Hotel, New York.

150 In the matter of proving the last will and testament of Charles Goodyear, deceased, as a will of real and personal estate.

Examination of witnesses, sworn and examined in the above entitled matter.

COUNTY OF NEW YORK, *to wit:*

Francis Bacon, of New Haven, Conn., being duly sworn as a witness in the above-entitled matter, and examined on behalf of the applicant to prove said will, says :

I was well acquainted with Charles Goodyear, now deceased. I know the abovenamed decedent for about a year and a half before his death. The subscription of the name of said decedent to the instrument now shown to me and offered for probate as his last will and testament, and bearing date the ninth day of June, in the year one thousand eight hundred and sixty, was made by the decedent, at the city of New York, in the presence of myself, Charles B. Kimball, and John Schreiber, the other subscribing witnesses. At the time of making such subscription, the said decedent declared the said instrument so subscribed by him to be his last will and testament; and I thereupon signed my name as a witness at the end of said instrument, at the request of said decedent, and in his presence.

The said decedent, at the time so executing said instrument, was upwards of the age of twenty-one years, and of sound mind, memory, and understanding, and not under any restraint, or in any respect incompetent to devise real estate. I also saw said Kimball and Schreiber, the other attesting witnesses, sign their names as witnesses at the end of said will, and know that they did so at the request of said decedent, and in his presence.

FRS. BACON.

Sworn this 2d day of August, 1860, before me.

EDW. C. WEST, *Surrogate.*

151 In the matter of proving the last will and testament of Charles Goodyear, deceased, as a will of real and personal estate.

Examination of witnesses, sworn and examined in the above entitled matter.

COUNTY OF NEW YORK, *to-wit:*

Charles B. Kimball, of the city of New York, being duly sworn as a witness in the above-entitled matter, and examined on behalf of the applicant to prove said will, says:

I was well acquainted with Charles Goodyear, now deceased. I knew the abovenamed decedent for three or four months before his death. The subscription of the name of said decedent to the instrument now shown to me and offered for probate as his last will and testament, and bearing date the ninth day of June, in the year one thousand eight hundred and sixty, was made by the decedent, at the city of New York, in the presence of myself, Francis Bacon, and John Schreiber, the other subscribing witnesses. At the time of making such subscription, the said decedent declared the said instrument so subscribed by him to be his last will and testament; and I thereupon signed my name as a witness at the end of said instrument, at the request of said decedent, and in his presence.

The said decedent, at the time of so executing said instnument, was upwards of the age of twenty-one years, and of sound mind, memory, and understanding, and not under any restraint, or in any respect in-

competent to devise real estate. I also saw said Bacon and Schreiber, the other attesting witnesses, sign their names as witnesses at the end of said will, and know that they did so at the request of said decedent, and in his presence.

CHAS. B. KIMBALL.

Sworn this 2d day of August, 1860, before me,
EDW. C. WEST, *Surrogate.*

152 In the matter of proving the last will and testament of Charles Goodyear, deceased, as a will of real and personal estate.

Examination of witnesses, sworn and examined in the above-entitled matter.

COUNTY OF NEW YORK, *to-wit:*

John Schreiber, of the city of New York, being duly sworn as a witness in the above-entitled matter, and examined on behalf of the applicant to prove said will, says:

I was well acquainted with Charles Goodyear, now deceased. I knew the abovenamed defendant for six months before his death. The subscription of the name of said decedent to the instrument now shown to me and offered for probate as his last will and testament, and bearing date the ninth day of June, in the year one thousand eight hundred and sixty, was made by the decedent, at the city of New York, in the presence of myself, Charles B. Kimball, and Francis Bacon, the other subscribing witnesses. At the time of making such subscription, the said decedent declared the said instrument so subscribed by him to be his last will and testament, and I thereupon signed my name as a witness at the end of said instrument, at the request of said decedent, and in his presence.

The said decedent, at the time of so executing said instrument, was upwards of the age of twenty-one years, and of sound mind, memory, and understanding, and not under any restraint, or in any respect incompetent to devise real estate. I also saw said Kimball and Bacon, the other attesting witnesses, sign their names as witnesses at the end of said will, and know that they did so at the request of said decedent, and in his presence.

JOHN SCHREIBER.

Sworn this 6th day of August, 1860 before me.
EDW. C. WEST, *Surrogate.*

153. COUNTY OF NEW YORK, *ss:*

Recorded the preceding last will and testament of Charles Goodyear, deceased, as a will of real and personal estate, together with the proofs and examinations taken and had in the Court of the Surrogate of the county of New York, relating to the said last will and testament, which said record is hereby signed and certified by me,

pursuant to the provisions of the revised statutes, the sixth day of August, in the year of our Lord one thousand eight hundred and sixty.

SURROGATE.

STATE AND COUNTY OF NEW YORK, *Surrogate's Office, ss:*

I, Hon. Charles P. Daly, first judge of New York Common Pleas, and acting as surrogate of said county, and acting as clerk of the Surrogate's Court, do hereby certify that I have compared the foregoing copy of the last will and testament of Charles Goodyear, deceased, together with the probate thereof, with the original record thereof, now remaining in this office, and have found the same to be a correct transcript therefrom, and of the whole of such original record.

In testimony whereof, I have hereunto set my hand, and affixed my seal of office, this sixteenth day of September, in the year of our Lord one thousand eight hundred and sixty-two, and of our independence the eighty-seventh.

C. P. DALY,
First Judge of New York Common Pleas
of the city and county of New York.

STATE AND COUNTY OF NEW YORK, *Surrogate's Court ss*:

I, Hon. Charles P. Daly, first judge of New York Common Pleas, and acting as surrogate of said county, and presiding magis-
154 trate of the Surrogate's Court, do hereby certify that the foregoing exemplification of the last will and testament of Charles Goodyear, deceased, together with the probate thereof, is authenticated in due form.

In testimony whereof, I have hereunto set my hand, and affixed the seal of the Surrogate's Court, this 16th day of September, in the year of our Lord one thousand eight hundred and sixty-two, and of our independence the eighty-seventh.

C. P. DALY,
First Judge of New York Commons
of the City and County of New York.

Letters testamentary, granted to Charles Goodyear, jr., upon the goods, chattels, and credits of Charles Goodyear, deceased.

[Coat of arms.]

The people of the State of New York, by the grace of God, free and independent, to all to whom these presents shall come, or may concern, send greeting:

Know ye, that at the county of New York, on the sixth day of August, in the year of our Lord one thousand eight hundred and sixty, before Edward C. West, esquire, surrogate of our said county, the last will and testament of Charles Goodyear, decased, was proved

and is now approved and allowed by us; and the said Charles Goodyear being at, or immediately previous to, his death, an inhabitant of the county of New York, by means whereof the proving and registering said will, and the granting administration of all and singular the goods, chattels, and credits of the said testator; and also, the auditing, allowing, and final discharging the account thereof,
155 doth belong unto us, the administration of all and singular the goods, chattels, and credits of the said deceased, and any way concerning his will, is granted unto Charles Goodyear, jr., of the city of New York, one of the executors in the said will named, he being first duly sworn faithfully and honestly to discharge the duties of such executor.

In testimony whereof, we have caused the seal of office of our said surrogate to be hereunto annexed.

Witness, Edward C. West, esq., surrogate of our said county, at the city of New York, the twenty-fifth day of October, in the year of our Lord one thousand eight hundred and sixty, and of our independence the eighty-fifth.

EDW. C. WEST, *Surrogate.*

STATE AND COUNTY OF NEW YORK, *Surrogate's Office, ss:*

I, Hon. Charles P. Daly, first judge of New York Common Pleas, and acting as surrogate of said county, and acting as clerk of the Surrogate's Court, do hereby certify that I have compared the foregoing copy of the letters testamentary granted on the estate of Charles Goodyear, deceased, with the original record thereof, now remaining in this office, and have found the same to be a correct transcript therefrom, and of the whole of such original record.

In testimony whereof, I have hereunto set my hand, and affixed my seal of office, this twenty-fifth day of September, in the year of our Lord one thousand eight hundred and sixty-two, and of our independence the eighty-seventh.

[L. S.] C. P. DALY,
First judge of New York Common Pleas
of the City and County of New York.

156 STATE AND COUNTY OF NEW YORK, *Surrogate's Office, ss:*

I, Hon. Charles P. Daly, first judge of New York Common Pleas, and acting as surrogate of said county, and presiding magistrate of the surrogate's court, do hereby certify that the foregoing exemplification of the letters testamentary granted on the estate of Charles Goodyear, deceased, is authenticated in due form.

In testimony whereof, I have hereunto set my hand, and affixed the seal of the Surrogate's Court, this twenty-fifth day of September, in the year of our Lord one thousand eight hundred and sixty-two, and of our independence the eighty-seventh.

[L. S.] C. P. DALY,
First Judge of New York Common Pleas
of the City and County of New York.

157 *Exhibit P.—Re-issue No. 1,084.*

The United States of America, to all to whom these letters patent shall come:

Whereas Charles Goodyear, of New York, New York, executor of the last will and testament of Charles Goodyear, (deceased,) late of New Haven, Conn., has alleged that said Charles Goodyear, deceased, did, in his lifetime, invent a new and useful improvement in the manufacture of caoutchouc, (for which letters patent were issued to said Goodyear, deceased, dated June 15th, 1844; the same surrendered and separate letters issued to him on two amended specifications, dated December 25th, 1849, and numbered, respectively, 156 and 157; and the same extended for seven years from and after June 15th, 1858; and said letters patent No. 156 having been surrendered by said executor, the same have been cancelled and separate letters ordered to issue to him, on two amended specifications,) which he stated had not been known or used before his application, had made oath that he was a citizen of the United States, that he did verily believe that he was the original and first inventor or discoverer of the said improvement, and that the same had not, to the best of his knowledge and belief, been previously known or used; said executor having paid paid into the treasury of the United States the sum of fifteen dollars, and presented a petition to the Commissioner of Patents, signifying a desire of obtaining an exclusive property in the said improvement, and praying that a patent may be granted for that purpose.

158 These are, therefore, to grant, according to law, to the said Charles Goodyear, executor as aforesaid, his heirs, administrators, or assigns, for the term of twenty-one years from the fifteenth day of June, one thousand eight hundred and forty-four, the full and exclusive right and liberty of making, constructing, using, and vending to others to be used, the said improvement, a description whereof is given in the words of the said Charles Goodyear, executor, in the schedule hereunto annexed, and is made a part of these presents.

In testimony whereof, I have caused these letters to be made patent and the seal of the Patent Office has been hereunto affixed.

Given under my hand, at the city of Washington, this twentieth day of November, in the year of our Lord one thousand eight hundred and sixty, and of the independence of the United States of America the eighty-fifth.

[L. S.] JACOB THOMPSON,
Secretary of the Interior.

Countersigned and sealed with the seal of the Patent Office.
PHILIP F. THOMAS,
Commissioner of Patents.

The schedule referred to in these letters patent, and making part of the same.

To all to whom these presents shall come:

Be it known, that Charles Goodyear, late of the city of New Haven, in the State of Connecticut, did invent a certain new and useful manufacture of caoutchouc or India rubber, not known or used by others before his invention or discovery, and that the following is a full, clear, and exact description of the principle or character which distinguishes it from all other things known before.

Cauotchouc or India rubber in its native state possesses, in a high degree, the valuable quality of elasticity and capacity to resist the penetrating power of water; but its sensibility to the dissolving power of heat, the hardening power of cold, and its loss of permanent elasticity under pressure or tension diminished its practical utility in the arts. Charles Goodyear succeeded in producing a new manufacture, substance, or product, in which all the properties and qualities of native caoutchouc or India rubber are vastly improved, and all the natural defects of that material are remedied, so that the new manufacture or substance is water-proof, permanently and highly elastic under all conditions of its use, and at the same time insensible to the effects of any fluctuation in temperature, to which, in common use, the articles made of the new manufacture are likely to be subjected, as well as, in some measure, to the destructive effects of many of the essential oils and acids.

The following description of a process by which the new manufacture or substance may be produced, will enable persons skilled in the art to produce it. Twenty-five parts by weight of native caoutchouc or India rubber and five parts of sulphur may be combined or mixed, either by
160 grinding them together in a machine well known to the trade for that purpose, or by dissolving the rubber in any of its known solvents, and adding the sulphur in a powdered form, and then drying the mixture so as to evaporate the solvent. The composition thus made of India rubber and sulphur must then be subjected to the action of a high degree of heat, say from 212° to 350° Fahrenheit, which may be applied in a variety of ways, one of which is by the use of an oven capable of being heated up gradually to the desired temperature, 270° of Fahrenheit being about the best.

It is found in practice that the desired result will be produced by exposing the material to the heat for a length of time, varying according to the temperature and the thickness of the mass to be cured. An exposure to the heat of from two to six hours is generally found sufficient.

The result of this process, thus applied, will be a new manufacture, substance, or product somewhat similar in general appearance to native India rubber, but having qualities or properties possessed by no other known substance or material, and of very great value in the arts.

For many purposes the manufacture is improved by the addition of other substances than sulphur, among which white lead is one of the best, and which, when used, may be combined in the mixture above described in the proportion of seven parts by weight, thereby forming a triple compound. Other salts of lead may be used with advantage, and coloring matter may be also incorporated with the mixture for the purpose of imparting colors to the product.

And other materials, such as cotton, silk, wool, or leather may be incorporated or combined with the India rubber and sulphur, thereby modifying the strength, elasticity, or other qualities of the new manufacture for particular purposes, as it is found that the new substance or product will be produced whenever the essential elements of rubber, sulphur, and heat are used, whether such other materials are incorporated or not.

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In subjecting the India rubber to heat for the purposes described, sulphur may be used or incorporated with or applied to the caoutchouc in a variety of ways, either in a gaseous, liquid, or solid form; but its presence in some form, at some time during the application of the heat, is essential to the production of the new manufacture which Charles Goodyear invented, although it is found that the effect will be produced by the use of very small quantities of sulphur.

In practice, however, for most purposes, the proportion mentioned in this description will be found sufficiently accurate for good results.

Before subjecting the mixture to the action of heat, it is obvious that it may be moulded into such shape as may be needed, and in that shape converted into the new manufacture or substance called "vulcanized India rubber."

What is claimed as the invention of Charles Goodyear, deceased, is the new manufacture called vulcanized India rubber, which is a combination of India rubber with sulphur, (whether with or without other ingredients,) chemically altered by the application of heat, substantially as described.

CHAS. GOODYEAR.

Witnesses:

EDW. N. DICKERSON.

JAMES A. DORR.

162 *Exhibit Q.—Re-issue No. 1,085.*

The United States of America, to all to whom these letters patent shall come:

Whereas Charles Goodyear, of New York, New York, executor of the last will and testament of Charles Goodyear, (deceased,) late of New Haven, Conn., has alleged that said Charles Goodyear, deceased, did, in his lifetime, invent a new and useful improvement in the art of preparing caoutchouc, (for which letters patent were issued to said Goodyear, deceased, dated June 15th, 1844; the same surrendered and separate letters issued to him on two amended specifications, dated December 25th, 1849, and numbered, respectively, 156 and 157, and the same extended for seven years from and after June 15th, 1858; and said letters patent No. 156 having been surrendered by said executor, the same have been cancelled and separate letters ordered to issue to him, on two amended speciffcations,) which he stated had not been known or used before his application, had made oath that he was a citizen of the United States; that he did verily believe that he was the original and first inventor or discoverer of the said improvement, and that the same had not, to the best of his knowledge and belief, been previously known or used, said executor having paid into the treasury of the United States the sum of thirty dollars, and presented a petition to the Commissioner of Patents, signifying a desire of obtaining an exclusive properly in the said improvement, and praying that a patent may be granted for that purpose:

163 These are, therefore, to grant, according to law, to the said Charles Goodyear, executor as aforesaid, his heirs, administrators, or assigns, for the term of twenty-one years, from the fifteenth day of June, one thousand eight hundred and forty-four, the full and exclusive right and liberty of making, constructing, using, and vending to others to be used the said improvement, a description whereof is given in the words of the said Charles Goodyear, executor, in the schedule hereunto annexed, and is made a part of these presents.

In testimony whereof, I have caused these letters to be made patent, and the seal of the Patent Office has been hereunto affixed.

Given under my hand, at the city of Washington, this twentieth day of November, in the year of our Lord one thousand eight hundred and sixty, and of the independence of the United States of America the eighty-fifth.

[L. S.] JACOB THOMPSON,
Secretary of the Interior.

Counrsigned and sealed with the seal of the Patent Office.
PHILIP F. THOMAS,
Commissioner of Patents.

164 *The schedule referred to in these letters patent, and making part of the same.*

To all to whom these presents shall come:

Be it known, that Charles Goodyear, late of the city of New Haven, in the State of Connecticut, did invent a certain new and useful improvement in the manner of preparing fabrics of caoutchouc or India Rubber, not known or used by others before his invention or discovery; and that the following is a clear and exact description of the principle or character which distinguishes it from all other things known before.

The object of this invention is the production of a new manufacture, substance, or product, known as vulcanized India rubber, (which is also the invention of said Charles Goodyear, and the subject of another patent bearing even date herewith,) and its peculiarity is in the art or process by which that manufacture or substance is produced.

That art or process is conducted as follows: Native caoutchouc or India rubber is combined with sulphur, which may be done in various ways, well known to the trade before the date of this invention, the most common of which is, either by grinding the dry rubber and sulphur together in a machine with heated cylinders, well known for that purpose, until the mixture is reduced to a plastic state, or by dissolving the caoutchouc or India rubber in its known solvents, the one most commonly used being camphene or spirits of turpentine, and adding to the solution the sulphur in a powdered state. The proportions of the gum and sulphur, which are found good in practice, are twenty-five parts of India rubber and five parts of sulphur by weight; although vulcanization will be produced by using sulphur in various proportions, considerably less or more than these. To this mixture other ingredients may be added, among which white lead is one of
165 the best, and which, when combined with the rubber and sulphur in the proportion of seven parts by weight, materially facilitates the process.

The mixture of India rubber with sulphur and with other materials was well known before the date of this invention; but no result of any great value was thereby produced until Charles Goodyear discovered his new art or process, by which an entire change is effected in the properties and qualities of the mixture of India rubber and sulphur, rendering the substance or material highly and permanently elastic under all conditions of its use, and insensible to heat and cold, and in some measure to the destructive effects of many of the essential oils and acids.

This art or process consists in subjecting caoutchouc, or India rubber, when combined with, or in the presence of,

sulphur, to the action of a high degree of heat, for the purpose of changing or altering its qualities and properties and producing the new substance called vulcanized India rubber; and it may be carried on in a variety of ways, the effect being due to the action of heat, without regard to the particular manner of its application. One of the methods is to place the composition of rubber and sulphur in an oven, and then to heat it up gradually until it attains the temperature necessary to produce the change required, which will be, say from 212° to 350° Fahrenheit, according to the quantity of sulphur, the size of the mass to be operated upon, the degrees of temperature applied, and the presence of other ingredients in the composition. When the mixture is made in proportions of twenty-five parts of gum, five parts of sulphur, and seven parts of white lead, the temperature of 270° will be usually found the best, and the duration of the process will vary according to the thickness of the mass, from two to six hours, the thinner mass requiring the least time.

The same effect may also be produced by using heated cylinders, and passing the material in sheets slowly
166 over their surfaces, and in various other ways or methods which the convenience of the operator may suggest. The heat may be communicated from the place of combustion to the place where the rubber is to be operated on, the only object being to subject the material to the influence of heat for a sufficient time to produce the desired result.

In subjecting the India rubber to heat for the purposes described, sulphur may be used or incorporated with or applied to the caoutchouc in a variety of ways, either in a gaseous, liquid, or solid form; but its presence in some form, at some time, during the application of the heat, is essential to the production of the new manufacture, which Charles Goodyear invented, although it is found that this effect will be produced by the use of very small quantities of sulphur. In practice, however, for most purposes, the proportions mentioned in this description will be found sufficiently accurate for good results.

Before the plastic India rubber, prepared as before mentioned, is subjected to the above-described process, it may be moulded or formed into any desired shape, and in that shape operated upon. And other materials, such as cotton, silk, wool, or leather, may be incorporated or combined with the India rubber and sulphur, thereby modifying the strength, elasticity, or other qualities of the new manufacture, for particular purposes, as it is found that the new substance or product will be produced whenever the essential elements of rubber, sulphur, and heat are used, whether such other materials are incorporated or not.

What is claimed as the invention of Charles Goodyear,

164 *The schedule referred to in these letters patent, and making part of the same.*

To all to whom these presents shall come:

Be it known, that Charles Goodyear, late of the city of New Haven, in the State of Connecticut, did invent a certain new and useful improvement in the manner of preparing fabrics of caoutchouc or India Rubber, not known or used by others before his invention or discovery; and that the following is a clear and exact description of the principle or character which distinguishes it from all other things known before.

The object of this invention is the production of a new manufacture, substance, or product, known as vulcanized India rubber, (which is also the invention of said Charles Goodyear, and the subject of another patent bearing even date herewith,) and its peculiarity is in the art or process by which that manufacture or substance is produced.

That art or process is conducted as follows: Native caoutchouc or India rubber is combined with sulphur, which may be done in various ways, well known to the trade before the date of this invention, the most common of which is, either by grinding the dry rubber and sulphur together in a machine with heated cylinders, well known for that purpose, until the mixture is reduced to a plastic state, or by dissolving the caoutchouc or India rubber in its known solvents, the one most commonly used being camphene or spirits of turpentine, and adding to the solution the sulphur in a powdered state. The proportions of the gum and sulphur, which are found good in practice, are twenty-five parts of India rubber and five parts of sulphur by weight; although vulcanization will be produced by using sulphur in various proportions, considerably less or more than these. To this mixture other ingredients may be added, among which white lead is one of
165 the best, and which, when combined with the rubber and sulphur in the proportion of seven parts by weight, materially facilitates the process.

The mixture of India rubber with sulphur and with other materials was well known before the date of this invention; but no result of any great value was thereby produced until Charles Goodyear discovered his new art or process, by which an entire change is effected in the properties and qualities of the mixture of India rubber and sulphur, rendering the substance or material highly and permanently elastic under all conditions of its use, and insensible to heat and cold, and in some measure to the destructive effects of many of the essential oils and acids.

This art or process consists in subjecting caoutchouc, or India rubber, when combined with, or in the presence of,

sulphur, to the action of a high degree of heat, for the purpose of changing or altering its qualities and properties and producing the new substance called vulcanized India rubber; and it may be carried on in a variety of ways, the effect being due to the action of heat, without regard to the particular manner of its application. One of the methods is to place the composition of rubber and sulphur in an oven, and then to heat it up gradually until it attains the temperature necessary to produce the change required, which will be, say from 212° to 350° Fahrenheit, according to the quantity of sulphur, the size of the mass to be operated upon, the degrees of temperature applied, and the presence of other ingredients in the composition. When the mixture is made in proportions of twenty-five parts of gum, five parts of sulphur, and seven parts of white lead, the temperature of 270° will be usually found the best, and the duration of the process will vary according to the thickness of the mass, from two to six hours, the thinner mass requiring the least time.

The same effect may also be produced by using heated cylinders, and passing the material in sheets slowly
166 over their surfaces, and in various other ways or methods which the convenience of the operator may suggest. The heat may be communicated from the place of combustion to the place where the rubber is to be operated on, the only object being to subject the material to the influence of heat for a sufficient time to produce the desired result.

In subjecting the India rubber to heat for the purposes described, sulphur may be used or incorporated with or applied to the caoutchouc in a variety of ways, either in a gaseous, liquid, or solid form; but its presence in some form, at some time, during the application of the heat, is essential to the production of the new manufacture, which Charles Goodyear invented, although it is found that this effect will be produced by the use of very small quantities of sulphur. In practice, however, for most purposes, the proportions mentioned in this description will be found sufficiently accurate for good results.

Before the plastic India rubber, prepared as before mentioned, is subjected to the above-described process, it may be moulded or formed into any desired shape, and in that shape operated upon. And other materials, such as cotton, silk, wool, or leather, may be incorporated or combined with the India rubber and sulphur, thereby modifying the strength, elasticity, or other qualities of the new manufacture, for particular purposes, as it is found that the new substance or product will be produced whenever the essential elements of rubber, sulphur, and heat are used, whether such other materials are incorporated or not.

What is claimed as the invention of Charles Goodyear,

deceased, is subjecting caoutchouc, or India rubber, or other vulcanizable gums, mixed with or in the presence of sulphur, (whether with or without other ingredients,) to the action of heat, for the purpose of affecting its qualities or properties, as described. CHAS. GOODYEAR.

Witnesses:
EDW. N. DICKERSON,
JAMES A. DORR.,

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168 *Exhibit B.—Answer.—Filed January 1st, 1863.*

To the judges of the Circuit Court of the United States for the district of Rhode Island.

The joint and several answer of the Providence Rubber Company, Augustus O. Bourn, William W. Brown and Edwin M. Chaffee, to the bill of complaint of Charles Goodyear, executor, the Union Rubber Company, and the Phoenix Rubber Company.

These defendants, now and at all times hereafter, saving and reserving to themselves all and all manner of benefit and advantage of exception to the manifold errors, insufficiencies, and uncertainties in said bill of complaint contained, for answer thereunto or unto so much thereof as these defendants are advised that it is material for them to make answer thereunto, answering, say:

That they do not know and are not informed, save by said bill, that said [that said] Charles Goodyear, deceased, was the first and original inventor of a new and useful improvement in India rubber fabrics, as is in said bill alleged, but they have been informed and believe that said Geodyear, deceased, was not the original inventor thereof, as is in said bill alleged, and they therefore deny that he was the first and original inventor of said new and useful improvement, and require the complainants to make proof of the same, as they may be advised; nor do they know whether letters patent were duly
169 issued to the said Goodyear, deceased, therefor, as is in said bill alleged, and therefore [and therefore] do not admit the same, but require the complainants to make proof of the same, as they may be advised.

That they have no knowledge or information sufficient to form a belief as to whether the said Goodyear, deceased, surrendered letters patent and obtained a re-issue thereof on the 25th day of December, 1849, as in said bill alleged, duly, or otherwise, nor as to whether exhibit "A" to said bill annexed is a copy of said letters patent and the specifications thereto attached, and they therefore deny the same, and leave the complainants to make such proof of the same as they may be advised.

That they have no knowledge or information sufficient to form a belief as to whether suits were instituted against Horace H. Day, or his agents as in said bill alleged, nor as to whether said suits were disposed of as in said bill alleged, nor as to whether the proceedings

therein took place which are in said bill alleged, nor as to whether the said Goodyear settled the same as is in said bill alleged, nor as to whether the said suits were disposed of as is in said bill alleged, and they therefore deny the same, and leave the complainants to make such proof thereof as they may be advised.

That they have no knowledge or information sufficient to form a belief as to whether the said Goodyear, deceased, on the first day of November, 1850, filed his bill in the Circuit Court of the United States for the district of New Jersey, nor as to the contents of such bill, nor as to the proceedings in such suit, nor as to the decision therein, nor as to whether any opinions were rendered therein, nor as to whether copies of said opinion are to said bill annexed, nor as to the decision of the court in such suit, if any there was; and they therefore deny the allegations of said bill in that behalf, and leave said complainants to make such proof thereof as they may be advised. But these defendants admit that they have been informed that a suit was commenced in New Jersey, by said Goodyear, deceased, against said Day, in which the validity of said letters patent was in controversy, which said suit, by reason of connivance and collusion
170 between the parties thereto, was never prosecuted to a final decision in the Supreme Court of the United States, or in the said Circuit Court for the district of New Jersey.

That they are not informed, save by said bill, that said Goodyear, deceased, and his licensees, enjoyed the exclusive possession and use of said improvements, as in said bill alleged, and they, therefore, deny that the said Goodyear, at the time and in the manner alleged in said bill, or at any time or in any manner, enjoyed an exclusive possession and use of the said improvements, and they require the complainants to make proof of the allegations in said bill in that behalf, as they may be advised.

That they have no knowledge or information sufficient to form a belief as to the institution of the suit against the Central railroad of New Jersey, as is in said bill alleged, nor as to any proceedings therein, nor as to the result thereof, nor as to [to] whether Exhibit "C" is a true copy of the same, and they, therefore, deny the same.

That they have no knowledge or information sufficient to form a belief as to whether a bill in equity was filed by the said Goodyear and the New England Car Spring Company against Anson G. Phelps and others, as in said bill alleged, nor as to any proceedings subsequent to such bill, nor as to whether Exhibit "D" is a true copy of the same, and they, therefore, deny the same, and leave the complainants to make such proof in that behalf as they may be advised.

That they have no knowledge or information sufficient to form a belief as to whether the Commissioner of Patents of the United States, on the 14th day of June, 1858, duly or otherwise, granted to the said Goodyear, deceased, a renewal and extension of the said patent of the 15th of June, 1844, as alleged to have been re-issued on the 25th day of December, 1849, for the term of seven years from the 15th of June, 1858, nor as to whether Exhibit "E" to said bill annexed is a copy of the certificate of extension granted by the said

commissioner, and they, therefore, deny the same, and leave the said complainants to make such proof thereof as they may be
171 advised; that, as they are informed and believe, if any such renewal and extension, or either of the said letters patent, or of the re-issue thereof, was made by the said commissioner of Patents, the same was obtained by false and fraudulent representations by the said Goodyear, deceased, to the said commissioner made, and by a wilful and fraudulent suppression of certain material facts, which should have been communicated to the said commissioner, and which, as these defendants are advised and believe, would, if they had been so communicated, have operated to defeat any application for an extension of said letters patent, and by connivance and collusion between the parties seeking and parties pretending to oppose said extension, as will hereafter in this answer be more particularly stated.

That they have no knowledge or information sufficient to form a belief as to whether, before said extension, the said Union India Rubber Company held under certain agreements rights from the said Goodyear, deceased, or whether the effect of such agreements is correctly stated in said bill, or whether Exhibits "F, G, H, I, J, K," are copies of such agreements, or whether the same are still in force and effect, and they, therefore, deny the allegations of said bill in that behalf, and require the complainants to make such proof thereof as they may be advised.

That they have no knowledge or information sufficient to form a belief as to whether said Charles Goodyear, deceased, executed with the Union India Rubber Company certain agreements continuing any rights of the Union India Rubber Company, as alleged in said bill, or whether Exhibits "L, M, N," annexed to said bill, are true copies of any such agreements, or whether the same, or any of the same, are recorded in the Patent Office, as alleged in said bill, or whether said agreements are in full force, and they, therefore, deny the allegations of the bill in that behalf, and require the complainants to make such proof thereof as they may be advised.

That they are informed, and therefore admit, that the said Charles Goodyear, deceased, on or about the first day of July,
172 1860; but they have no knowledge or information sufficient to form a belief whether the said Goodyear, deceased, left a last will and testament, which was duly admitted to probate, as in said bill alleged, or whether the complainant, Charles Goodyear, was duly appointed executor of said will, as in said bill alleged, or whether other executors named therein declined to serve, or whether Exhibit "O" is a true copy of said will and letters testamentary and probate, and they, therefore, deny the allegation of the bill in that behalf, and require the complainants to make such proof thereof as they may be advised.

That they are informed and believe, and therefore aver, that the Surrogate of the city and county of New York had no jurisdiction over the instrument purporting to be the last will and testament of Charles Goodyear, deceased, or to make probate thereof, or to ap-

point an executor thereof, and that any proceedings of the said Surrogate in that behalf are wholly null and void, by reason of the fact that said Charles Goodyear, deceased, at the time of his death, was a citizen and resident of the city of New Haven, in the State of Connecticut.

That they have no knowledge or information sufficient to form a belief whether the said Charles Goodyear, as executor, surrendered the said letters patent in the manner and for the reasons alleged in said bill, or whether two new patents were duly or otherwise issued to said Goodyear, as executor, at the time and in the manner alleged in said bill, or whether Exhibits "P" and "Q" are copies of said alleged re-issued letters patents, as is alleged in said bill, and they, therefore, deny the allegations of the bill in that behalf, and require the complainants to make such proof thereof as they may be advised.

That they are informed and believe, and therefore aver, that any surrender or re-issue of said letters patent by and to the said Charles Goodyear, acting as executor as aforesaid, is wholly null and void, by reason of the fact that said Charles Goodyear was never duly and legally appointed and qualified as executor of the last will and testament of Charles Goodyear, deceased.

That they have no knowledge, and cannot, therefore, admit
173 that the aforesaid patents so re-issued, with the said corrected specifications, have the same effect and operation in law as if originally filed in such corrected form as alleged in said bill, or that each of said patents has the same effect in law as if originally issued for the term of twenty-one years, as alleged in the said bill, and they, therefore, deny the allegations of the bill in that behalf, and require the complainants to make such proof thereof as they may be advised.

That they do not know, and therefore cannot admit, that amongst all persons engaged in the manufacture of India rubber within the United States, the term or phrase "vulcanized rubber" is used or understood to mean a fabric or product made according to said Goodyear's patented process, as alleged in said bill, or is so used and understood as the designation of all goods made of a compound of India rubber, as described and set forth in said bill, and these defendants deny that they so understand it; but they admit that the complainants employ such phrase in the sense so explained in their bill of complaint; and they require the complainants to make proof of the sense in which said term or phrase is used among all persons engaged in the manufacture of India rubber in the United States, or is understood by these defendants, as they may be advised.

That they have no knowledge or information sufficient to form a belief whether the Union India Rubber Company granted unto Warren Ackerman & Company a license of the tenor and affect alleged in said bill, and they, therefore, deny the same, and require the complainants to make such proof thereof as they may be advised.

That they have no knowledge or information sufficient to form a

belief whether the said Warren Ackerman & Company and the Union India Rubber Company granted unto the said Phœnix Rubber Company the aforesaid license, as alleged in said bill, and require the complainants to make such proof thereof as they may be advised.

That they have no knowledge or information sufficient to form a belief as to whether the said Union India Rubber
174 Company, before said alleged extension, and since, were and have been under the aforesaid alleged agreements, in the business of making and selling vulcanized India rubber goods, as alleged in the said bill, or whether the said Phœnix Rubber Company are selling and making preparations to manufacture and sell said goods, as alleged in the said bill, and therefore deny the allegations of the bill in that behalf, and require the complainants to make such proof thereof as they may be advised.

That they do not know, and have no information sufficient to form a belief, whether injunctions were granted in the southern district of New York, as alleged in said bill, or whether the same are now in force, and they therefore deny the allegations of the bill in that behalf, and require the complainants to make such proof thereof as they may be advised; and these defendants have been informed and believe that no injunction has been granted in any case at the suit of Charles Goodyear, executor, or his licensees, since the date of the pretended extension of said letters patent by the commissioner as aforesaid, in which the validity of such extension was put in issue, and that there have been several suits in different districts of the United States at the suit of said Goodyear, executor, or his licensees, which have been defended upon the ground that such extension was fraudulent and void, and that in all cases wherein this defence has been made, the complainants have either compromised or discontinued or ceased to prosecute the same, and have in no instance allowed the validity of said pretended extension to be passed upon by any judicial tribunal.

That they admit the said Brown and Chaffee, of their own knowledge, and the said Providence Rubber Company and A. O. Bourn, upon information and belief, that certain proceedings were had against George O. Bourn, deceased, William W. Brown, and Edwin M. Chaffe, in the Circuit Court of the United States for the Rhode Island district, but whether the history and effect thereof are correctly stated in said bill, they do not know, and for greater certainty crave leave to refer to the records thereof remainin in this court.

175 That they admit the said Brown and Chaffee of their own knowledge, and the said Bourn and the Providence Rubber Company, upon information and belief, that since the date of the pretended extension of the patent granted Charles Goodyear, deceased, a paper exists purporting to be a license to the said George O. Bourn, deceased, Wil- William W. Brown, and Edwin M. Chaffe, to manufacture India rubber boots and shoes, as alleged in said bill, the validity and obligation of which pretended license they do no admit;

but they do admit that the said pretended license by its terms only extended to the manufacture of India rubber boots and shoes, and not to any other articles, if any there be, which the complainants have the exclusive right to make, use, and vend. And they admit, that since the date of said pretended license, the said George O. Bourn has deceased, and that his son Augustus O. Bourn, is now a stockholder in the said Providence Rubber Company, in which the said Brown and Chaffee also are stockholders, and that before the formation of said company, and after the death of said George O. Bourn, the said Augustus O. Bourn was associated with the said Brown and Chaffee as a co-partner; and they admit that the said Bourn, Brown, and Chaffee, since the death of the said George O. Bourn, and since the date of said pretended license, have from time to time been engaged in manufacturing and vending India rubber boots and shoes, as by the terms of said pretended license they were permitted to do; and they admit that they claim, as against the grantor of said license, the right to manufacture boots and shoes as aforesaid, but they do not admit that the license is a valid instrument, or that the obligations contained therein are binding on them. And they deny that for a long time past the Providence Rubber Company, a corporation, and the defendants Bourn, Brown, and Chaffee, as stockholders therein, or as officers or agents thereof, either alone or confederating with others, have been or are now engaged, without the license and consent of the complainants, in manufacturing and selling and procuring to be sold army and navy equipments, blankets, coats, cloaks, cloth, clothing, pon-
176 chos for army, navy, and other purposes, and India rubber bulbs to be used in the manufacture of syringes, which the complainants, as alleged in said bill, have the exclusive right to make. And they therefore wholly deny all the allegations in that behalf in the said bill contained in manner and form as therein set forth, and they aver the truth to be that the said Providence Rubber Company; and the said Bourn, Brown, and Chaffee have, from time to time, manufactured cloths for the purpose of japanning, and made and disposed of cloths japanned as aforesaid, sometimes in the form of blankets so-called, sometimes in the form of clothing and of other articles as they might lawfully do, under and by virtue of an agreement made the 25th day of June, 1846, between the said Charles Goodyear, deceased, and the said Edwin M. Chaffee, a copy of which agreement marked "A" is hereunto annexed, and hereby made part of this answer. And they aver, that by the license and permission of the said Chaffee, the said Bourn, Brown, and Chaffee, and the said Providence Rubber Company, have from time to time, manufactured and disposed of such India rubber goods, as by the terms of said last-mentioned agreement they lawfully might do, and not otherwise. And they wholly deny that they have manufactured or sold any India rubber goods in violation of the rights of the said complainants; the said Union India Rubber Company and the Phœnix Rubber Company, and then wholly deny that the said complainants, the Union Rubber Company and the Phœnix Rubber Company, have, by

virtue of agreements and licenses set forth in said bill of complaint, the exclusive right to manufacture and vend the goods or any portion thereof, in the manufacture and sale of which these defendants have been engaged as aforesaid. These defendants admit that the goods made and sold by them, were made and sold for the purpose of profit and advantage to themselves, but they deny that they, or any portion of them, were made and sold to the injury of the complainants, or in violation of their rights, or that the manufacture and sale thereof were infringements of the patents of Charles Goodyear, deceased, or of any pretended renewals, extensions,
177 or re-issues thereof. And they admit that in the manufacture of India rubber goods, they used a compound of India rubber in which sulphur was present when the compound was subjected to the action of artificial heat, so as to produce the changes and effects mentioned in said bill; but they do not admit that the mode of vulcanization used by them is the same as described in the original patent granted to said Cearles Goodyear, deceased; and they deny that the said Providence Rubber Company is unlawfully engaged in manufacturing and selling goods which the said Union Rubber Company and the said Phœnix Rubber Company have the exclusive right to manufacture, and they admit that the said Augustus O. Bourn is the treasurer of the said company; that the said Bourn, Brown, and Chaffee have the management of its business, were concerned in procuring its incorporation, are its principal directors, stockholders, and agents, under whose direction its business is conducted for the benefit of its stockholders; that they wholly deny that the said company was incorporated and its charter obtained by the said Bourn, Brown, and Chaffee, for the purpose of enabling them to infringe the complainant's rights as is in said bill alleged, and they deny each and all the allegations in said bill in that behalf; and they deny that they have threatened to continue making and selling said goods or any goods in violation of the rights of the complainants, and they deny that the complainants have been damaged and injured by any acts of the defendants, or have any reason to apprehend injury in future from such acts; and they do not admit, but deny, that the said complainant, Charles Goodyear, is lawful executor of Charles Goodyear, deceased; and they deny that he has authorized the filing of this bill, or is lawfully a party thereto, and they require the said complainants, the Union India Rubber Company and the Phœnix Rubber Company, to make proof of their right to make said Charles Goodyear, executor, a party to this bill; and these defendants do not admit but deny that the said Union India Rubber Company and the Phœnix Rubber Company are duly incorporated, or that
178 Henry G. Hadden and Warren Ackerman have been duly elected presidents thereof, and require them to make proof that they are so; and they do not admit but deny that any of the exhibits set forth in said bill were duly executed, and they require proof of the execution of the same, and of each of the same.

And these defendants further answering upon information and belief, aver, that if any extension of said letters patent of the 15th of

June, 1844, was granted to said Goodyear, deceased, by the said Commissioner of Patents, the same was procured by the said Goodyear upon a false and fraudulent representation to the said Commissioner, then made in that behalf, for the purpose of deceiving the said commissioner, and of obtaining the said extension, and in fraud of the requirements of the act of Congress of the United States, passed July 4, 1836, entitled "An act to promote the progress of the useful arts and to repeal all acts and parts of acts heretofore made for that purpose," and of the provision of the 18th section of said act, by which any patentee making application for the extension of his letters patent is required to furnish "a statement in writing, under oath, of the ascertained value of his invention, and of his receipts and expenditures sufficiently in detail to exhibit a true and faithful account of loss and profit in any manner accruing to him, from and by reason of said invention," for the purpose of satisfying the Commissioner of Patents that the patentee, without neglect or fault, on his part, has failed to obtain, from the use and sale of his invention, a reasonable remuneration for the time, ingenuity, and expense bestowed on the same, and the introduction thereof into use; that to obtain such extension, the said Goodyear, deceased, in the month of March, 1858, filed with the said Commissioner of Patents a petition verified by him, the said Goodyear, deceased, in and by which it appeared that the expenditures of the said Goodyear, in and about the said patent, amounted to the sum of ninety-one thousand five hundred dollars over and above all his receipts derived from and by reason of his said patent, and of the invention thereby
179 secured; that subsequently, and in the month of May, 1858, the said Goodyear, deceased, filed with the said commissioner an amended application and account, in and by which it appeared that the said Goodyear, deceased, had received as profit accruing to him, from and by reason of said invention, the sum of thirty-three thousand three hundred and fifty-eight dollars and sixty-three cents over and above all loss and expenditure sustained or made by him from and by reason of said invention; that the said Goodyear, deceased, for the purpose of deceiving the said commissioner, and in violation of the statute aforesaid, omitted to include in said account the profits accruing to him, the said Goodyear, deceased, upon and by reason of various assignments and licenses made and granted by him, the said Goodyear, deceased, of rights to use the said improvement covered by said letters patent, and these defendants specify as assignments, licenses, and agreements, which were so made by the said Goodyear, deceased, and from which he derived a profit, the following, to wit:

An agreement and license to Horace H. Day, dated October 29, 1846, in which the said Goodyear, deceased, admits the receipt of ten thousand dollars, and in and by which it is stipulated that he shall be paid a tariff on all articles manufactured thereunder.

An assignment or license to James A. Dorr, dated February 28, 1845, in which the said Goodyear admits the receipt of twenty-five hundred dollars.

An assignment or license to James A. Dorr, dated October 8, 1844, in which the said Goodyear, deceased, admits the receipt of twenty-five thousand dollars.

An assignment or license or agreement with Bourn, Brown & Chaffee, dated March 27, 1851, in pursuance of which these defendants say, the said Brown & Chaffee, of their own knowledge, and the said, the Providence Rubber Company, and the said Bourn, upon information and belief, that the said Goodyear received property to the value of much more than ten thousand dollars, for which he, the said Goodyear, deceased, has never given any consideration, except the license or agreement as aforesaid.

180 An assignment or license given to Conrad Poppenhusen, dated March 22, 1852, in which the said Charles Goodyear, deceased, admits the receipt of ten thousand dollars.

An assignment or license to Conrad Poppenhusen, dated June 14, 1852, in which the said Goodyear, deceased, admits the receipt of twenty thousand dollars.

An assignment or license to Conrad Poppenhusen, dated January 12, 1853.

An assignment or license to Conrad Poppenhusen, dated September 30, 1853.

An assignment or license to Conrad Poppenhusen, dated January 14, 1854, in which the said Goodyear, deceased, admits the receipt of one thousand dollars.

An assignment or license to Nelson Goodyear, dated January 30, 1852, in which the said Goodyear, deceased, admits the receipt of five hundred dollars.

An assignment or license to Nicholas Williamson and Dower D. Williamson, jr., dated June 9, 1854, in which the said Goodyear, deceased, admits the receipt of one thousand dollars.

An assignment or license to John C. Calhoun and Nicholas Williamson, dated May 23, 1854, in which the said Goodyear, deceased, admits the receipt of one thousand dollars.

An assignment or license to Newell A. Prince, dated October 17, 1854, in which the said Goodyear admits the receipt of one thousand dollars.

An assignment or license given to George Goodyear, dated May 18, 1855, in which the said Goodyear, deceased, admits the receipt of ten thousand dollars.

An assignment or license to Austin G. Day, dated October 17, 1854, in which the said Goodyear admits the receipt of ten thousand dollars.

An assignment or license to Gorham D. Abbott, dated July 2, 1856, in which the said Goodyear, deceased, admits the receipt of ten thousand dollars.

Two assignments or licenses to the Beacon Dam Company, a corporation created under the laws of the State of Connecticut,

181 dated May 27, 1856, in one of which the said Goodyear, deceased, admits the receipt of ten thousand dollars.

An assignment or license to the said Beacon Dam Company, dated

October 22, 1856, in which the said Goodyear, deceased, admits the receipt of one dollar, which amount these defendants aver was inserted for the purpose of endeavoring to conceal the real amount received as such consideration, which they are informed and believe, and consequently aver, was as follows: Upon the execution and delivery of said instrument of October 22, 1856, the said Goodyear received from the said Beacon Dam Company the sum of one hundred and twenty-five thousand dollars, of which twenty-five thousand dollars was paid him, the said Goodyear, deceased, in cash or in negotiable promissory notes, all of which were paid at maturity or shortly after; the balance thereof, to wit, one hundred thousand dollars was paid him in stock of the said Beacon Dam Company, which, at that time, and at the time of the extension of said patent, was worth its par value in the market, and could have been readily sold therefor.

An assignment or license to Evan L. Evans, dated August, 1857, in which said Goodyear, deceased, admits the receipt of $500.

An assignment or license or agreement with H. H. Day, dated May 24, 1858.

That these defendants are not informed as to the precise amount received by the said Goodyear as a present consideration for the granting of all of said assignments or licenses, nor as to the amounts received by him as and for tariffs from the grantees and licensees thereunder, except that these defendants are informed and believe that the said Goodyear, deceased, received, as tariffs, from the said Beacon Dam Company and its successor, the American Hard Rubber Company, prior to June 14, 1858, the sum of ten thousand dollars and upwards; and from the said Conrad Poppenhusen and his licensees, as tariffs, the sum of one hundred and twenty thousand dollars; and from the said Austin G. Day, as tariffs, the sum of five hundred dollars; and, upon information and belief, they aver
182 that all of said receipts by the said Goodyear, from the various grantees and licensees hereinbefore named, should properly have been included by him in said original and amended application and account for said alleged extension; and that as they are advised and believe, the omission so to include the same renders the said alleged extension null and void, and deprives the said Goodyear, deceased, or his heirs, executors, or administrators, of any right under said original or re-issued letters patent.

And these defendants, upon information and belief, further aver that said Goodyear, deceased, fraudulently and willfully, in said original and amended accounts, presented to the said commissioner, misrepresented many of the items therein contained, and they specify as items which were so misrepresented, the following to wit:

An assignment or license to Charles Ely and Edward Crane, dated October 29, 1847, for which in said amended account, the said Goodyear, deceased, admits the receipt of four thousand dollars, but for which these defendants are informed and believe he received the sum of five thousand dollars.

An assignment or license to Jonathan Trotter, dated February 5, 1847, for which, in said amended account, the said Goodyear, de-

ceased, admits the receipt of seventy-five hundred dollars, but for which these defendants are informed and believe he received the sum of ten thousand dollars.

An agreement with the Boston Belting Campany, dated April 11, 1851, under which the said Goodyear, deceased, in his amended account, admits the receipt of eleven thousand dollars, but under which these defendants are informed and believe he received the sum of fifteen thousand dollars.

An assignment or license to W. Rider & Brothers, dated March 28, 1847, for which the said Goodyear, deceased, in his amended account, admits the receipt of ten thousand dollars, but for which these defendants are informed and believe he received the sum of thirty thousand dollars.

As license or agreement to Fowler M. Ray, dated Feb-
183 ruary 5, 1851, for which said Goodyear, deceased, admits, in his amended account, the receipt of two thousand dollars, but for which these defendants are informed and believe he received the sum of twenty-five hundred dollars.

From tariffs and settlements with the Union India Rubber Company and the Boston Belting Company, the said Goodyear, deceased, in said amended account, admits the receipt of thirty-three thousand dollars; but these defendants are informed and believe that he received not less than fifty thousand dollars therefor; and these defendants, as they are advised and believe, allege that the misrepresentation of the aforesaid items, in said original or amended application for said alleged extension, renders the said alleged extension null and void, and deprives the said Goodyear, deceased, his heirs or executors, of any right under said original or re-issued letters patent.

And these defendants, upon information and belief, aver that in said original and amended application, the said Goodyear, deceased, represented to the Commissioner of Patents that he paid certain debts and expenses, prior to 1845, amounting to the sum of seventy-nine thousand two hundred and ten dollars forty-six cents for expenses incurred in the development of his alleged new vulcanizing process, all of which were paid as he alleged to the said commissioner from the proceeds of said vulcanizing patent; which allegation these defendants, upon information and belief, aver to be false in these particulars, to wit: that, during said period, prior to 1845, the said Goodyear, deceased, was engaged in a great many experiments on objects entirely distinct from the vulcanization of India rubber, for some of which letters patent were issued to him, one bearing date March 9, 1844, and one, as said Goodyear, deceased, alleges in his application for a re-issue of his patent in 1849, for fibrous India rubber, erroneously included in said alleged patent of June 15, 1844; that on both these patents he spent large amounts of time and money,
and especially to his alleged discovery in incorporating fibrous
184 substances with India rubber; that at least one-half of said debts and expenses should have been charged to these two alleged improvements, as these defendants have been informed and believe he received considerable sum for their sale.

And these defendants, upon information and belief, aver that in said original and amended accounts, the said Goodyear, deceased, fraudulently and willfully represented to the Commissioner of Patents that one-quarter of all his receipts should be charged to the account of certain letters patent granted to Nathaniel Hayward and Edwin M. Chaffee, while he omitted to deduct one-quarter from his debts and expenses averred to be paid by him, and while he well knew that for neither of these patents had he ever made any charge to his licensees; that, on or about the 3d of November, 1854, the said Goodyear, deceased, James A. Dorr, and William Judson brought a certain bill in equity in the Superior Court of the city of New York, in which the complainants alleged, upon oath, that the said Goodyear, deceased, "made no charge or demand to his licensees as owner of said Chaffee patent for using the same in the manufacture of India rubber goods, and that no specific mention was made in any license by said Goodyear, to his licensees of said process of said Chaffee, or of any right, license, or permission to construct or use the same, and that he held the said Chaffee patent as a mere incident of the vulcanizing patent, and never designed to charge and never did charge any persons anything whatsoever for the use thereof;" that the said Hayward patent expired in the year 1852; that, previous to its expiration, the said Goodyear, deceased, never received, directly or indirectly, any compensation therefor from any of his licenses, for using his vulcanizing process, and that the same was never supposed by any of his licensees to have been paid for by them. And these defendants, upon information and belief, aver that, in said original application and in the testimony and arguments used before the said Commissioner of Patents, it was alleged by the said Goodyear, deceased, and his counsel, that the said Goodyear, deceased, had
185 expended in conducting law-suits to sustain said vulcanizing patent, large sums of money, which, in places, are stated to be from one hundred and fifty to two hundred thousand dollars, which allegation these defendants aver, upon information and belief, to have been wrong and fraudulent; that during the existence of the original patent of said Goodyear, deceased, and before the application for the aforesaid alleged extension, there was a large fund set apart and contributed by the licensees of said Goodyear, deceased, for the purpose, among others, of sustaining his said vulcanizing patent, and that all expenses incurred in such law-suits were paid by his licensees and not by himself.

And these defendants, upon information and belief, aver that the said pretended extension of said letters patent was fraudulent and void in this; that the application for said extension, although made in the name of the said Goodyear, deceased, and ostensibly for his benefit, was, in truth and in fact, made by a combination and confederacy, embracing a large portion of the licensees of said Goodyear, for the purpose of continuing in their hands a profitable monopoly in the manufacture of India rubber goods; that the licensees of said Goodyear, deceased, had the exclusive management and control of the application for said extension, and before the same was granted

secure to themselves the said monopoly in the event that the said extension should be granted; that they paid the expenses of said application; and these defendants aver that the said licensees, with the knowledge and consent of the said Goodyear, deceased, for the purpose of fraudulently procuring the said commissioner to grant said extension, paid large sums of money and other valuable considerations to sundry persons to induce them to withhold and withdraw opposition to said extension, and thereby willfully and fraudulently caused the suppression of facts which, if made known to said commissioner, would have justly and legally prevented said extension, to wit, the fact well known to the licensees and to the said Goodyear, deceased, that the said Goodyear had before that time ob-
186 tained from the sale and use of his invention a full, ample, and reasonable remuneration for the time, ingenuity, and expense bestowed upon the same, and the introduction into use; and that the said licensees, with the knowledge and consent of said Goodyear, deceased, for the purpose of fraudulently procuring the said extension, after having procured one Horace H. Day, for money or other valuable consideration, to withhold and withdraw his actual opposition to the said extension, fraudulently and collusively procured the said Day to continue his name upon the record, and to continue to take testimony pretendedly in opposition to said extension, for the fraudulent purpose of inducing the commissioner to believe that all the facts which could be adduced in opposition to the said extension were brought to his notice, whereby, as these defendants aver, said commissioner was deceived and fraudulently induced to grant said extension.

And these defendants aver, upon information and belief, that the complainants have no right or title to maintain their aforesaid bill of complaint against these defendants, by reason of the fact that, prior to the date of the pretended titles under which they claim in and by said bill, the said Goodyear, deceased, had granted rights and interests, in his pretended patents, repugnant to, and inconsistent with the titles set up and alleged by the complainants in their said bill.

And these defendants aver, that they are advised, informed, and believe, that both the pretended re-issues of said pretended letters patent of June 15, 1844, are invalid and void, by the reason of the fact that the claims therein contained are broader than the original invention of said Goodyear, deceased, if any he made, and broader than the claim originally made by him when he applied for his original letters patent.

And to the interrogatories propounded to them in and by said bill these defendants jointly and severally answer as follows, to wit:

To the first interrogatory they say, upon information and belief, that they do not admit, but deny the validity of the grant of said letters patent to the said Goodyear, as re-issued to him as
187 aforesaid, and the renewals and extensions thereof, and the novelty and utility of the invention so secured by said grant.

To the second interrogatory they say, upon information and belief,

that they do not admit, but deny the validity of the re-issue or re-issues to Charles Goodyear, as executor of Charles Goodyear, deceased.

To the third interrogatory they say they do not know, and have no information upon which to form a belief, whether the said several suits were made at the time and in the manner, and against the parties as stated in said bill, or whether they resulted as therein set forth.

To the fourth interrogatory they say, upon information and belief, that they do not admit, but deny the right and title of said invention as applied to the manufacture of army and navy equipments, cloth, blankets, coats, cloaks, ponchos, or syringe bulbs, as being in the complainants, as set forth in said bill, in the grants and assignments thereof as therein alleged.

To the fifth interrogatory they say, of their own knowledge, that they have, from time to time, manufactured cloths for the purpose of japanning, and made and disposed of cloths japanned as aforesaid, sometimes in the form of blankets, so-called, and sometimes in the form of clothing, and other articles as hereinbefore stated, as they lawfully might do, and that otherwise, than as above stated, they have not made, or procured to be made, sold or procured to be sold, and are not making, or selling, or causing to be made or sold, and are not now making or selling or causing to be made or sold any India rubber blankets, coats, cloaks, clothing, ponchos, or cloth, or syringe bulbs.

To the sixth interrogatory they answer, of their own knowledge, that they have heretofore manufactured and sold about 251,780 yards of japanned cloth in the form of blankets, clothing, and other articles; that they have now on hand about 8,000 yards of said cloth, and that otherwise than as above stated they have not made or sold, and have not now on hand, any quantity of cloth, blankets, coats, cloaks, clothing, ponchos, or syringe bulbs.

188 To the seventh interrogatory they say that the cloth manufactured by them as aforesaid was cured or vulcanized by the application of artificial heat, in combination of sulphur, or in presence of sulphur, and the carbonate or other oxyde of lead, but they do not admit, but deny that the process used by them in curing cloth, as aforesaid, is substantially the same as that pretended to be secured to Charles Goodyear by letters patent.

To the eighth interrogatory they say, of their own knowledge, that a portion of the cloth manufactured by them, as aforesaid, and disposed of in the form of blankets and other articles, has been stamped "Providence Rubber Co.," a portion has been stamped "Goodyear's Patent," and a portion has been stamped "Providence Rubber Company; Goodyear's Patent;" and a portion has not been stamped or marked at all.

To the ninth interrogatory they say, that they refer to their answer to the eighth interrogatory, as containing a full answer to this interrogatory.

To the tenth interrogatory they say, upon information and belief in part, and in part of their own knowledge, that they, or some of them, have been engaged in the manufacture of India rubber cloth, from time to time, and in different places, since the date of the license hereinbefore set forth granted to E. M. Chaffee; but these defendants are not now able to set forth in detail and with accuracy when, where, and to what extent they have been engaged in such manufacture; but since the pretended re-issue of the said letters patent to said Charles Goodyear, executor, from which time, as these defendants believe and are advised, the complainants can alone, under any circumstances, pretend to call upon these defendants for an account; they have been engaged, to a greater or less extent, in the manufacture of India rubber cloth in the form of blankets and other articles, as hereinbefore stated, from time to time, since about June, 1861.

To the eleventh interrogatory they say, that George O. Bourn, deceased, William W. Brown, and Edwin M. Chaffee, did hold a
189 paper, purporting to be a license, under Goodyear's patent, to manufacture and vend India rubber boots and shoes, but they do not admit but deny the validity and obligations of said license.

To the 12th interrogatory they say, that they have heretofore manufactured and sold India rubber boots and shoes, and the Providence Rubber Company are now engaged in manufacturing and vending boots and shoes, and as against the grantor, in said pretended license, claim the right to do so; but they do not admit, but deny that the terms or conditions of said license are binding upon them.

To the thirteenth interrogatory they say, that the Providence Rubber Company was incorporated at its May session, 1861, by the General Assembly of the State of Rhode Island; that its incorporation was procured and accepted by William W. Brown, Edwin M. Chaffee, and Augustus O. Bourn; and the corporators named in its charter are the said Brown, Chaffee, and Bourn; that William W. Brown is president thereof, Augustus O. Bourn is treasurer thereof, and Edwin M. Chaffee is secretary thereof, and that the said Brown, Bourn and Chaffee are the directors and managers thereof; that William W. Brown, Edwin M. Chaffee, Augustus O. Bourn, Thomas Brown, and Augustus O. Bourn, trustee, are stockholders thereof.

To the fourteenth interrogatory they say that they refer to their answer to the thirteenth interrogatory as a full answer to this interrogatory.

To the fifteenth interrogatory they say that they have not combined or confederated with others to manufacture, or prepare for manufacture, said goods. And these defendants deny all manner of unlawful combination, without this, that there is any other matter or thing in the said complainant's bill of complaint contained, material or necessary to make answer thereunto, and not herein and hereby well and sufficiently answered, confessed, traversed, and avoided, or denied, is true, to the knowledge or belief of these defendants, all which things these defendants are willing to aver, prove, or
190 maintain, as this honorable court shall direct, and humbly

pray to be hence dismissed with their reasonable costs and charges most wrongfully sustained.

ABRAHAM PAYNE, *Solicitor.*
J. H. PARSONS,
GEO. GRISCOM,
CALEB CUSHING,
J. S. BLACK,
Of Counsel for Defendants.

THE PROVIDENCE RUBBER COMPANY.
By AUGTSTUS O. BOURN, *Treasurer.*
WILLIAM W. BROWN.
EDWIN M. CHAFFEE.
AUGUSTUS O. BOURN.

On this 31st day of December, 1862, before me, personally appeared William W. Brown, Edwin M. Chaffee, Augustus O. Bourn, and the Providence Rubber Company, by its treasurer, Augustus O. Bourn, who, being duly sworn, depose and say: That the foregoing answer by them signed is true to the best of their knowledge and belief, except as to the matters therein stated on information and belief, and as to those matters they believe it to be true.

JAMES H. PARSONS,
U. S. Commissioner for said Rhode Island District.

191 *A.*

This indenture, made this 25th day of June, 1846, between Charles Goodyear, of the city of New Haven, State of Connecticut, and Edwin M. Chaffee, of Naugatuck, county of New Haven and State of Connecticut, witnesseth:

That the said Charles Goodyear, for and in consideration of the sum of one dollar to him in hand paid, the receipt whereof is hereby acknowledged, hath bargained, sold, granted and conveyed, and by these presents doth bargain, sell, grant, and convey to the said E. M. Chaffee, his executors, administrators and assigns, a free license to use the said Goodyear's metallic gum-elastic composition, for coating cloths, for the purpose of japanning, marbling, and variegate japanning, at his own establishment, but not to be disposed of to others for that purpose, without the consent of said Goodyear; together with all the rights to make and dispose of the aforesaid japanned and marbled or variegated cloths, in and for as the said Charles Goodyear has obtained any rights, patents or privileges, and in virthe of all his inventions, patents and improvements made in the manufacture of India rubber or gum-elastic goods, and which shall be made hereafter by the said Charles Goodyear.

And in virtue of all letters patent, or patent rights of the United States of America, granted to and belonging to, and which shall be granted to and belong to the said Charles Goodyear, for any and all inventions and improvements in the manufacture of India rub-
192 ber goods. The right and license herein conveyed being

limited to and for the United States, and not extending to any foreign country, and not being intended to convey any right to make any contract with the government of the United States.

And the said Charles Goodyear further covenants and agrees with the said E. M. Chaffee, that he will not dispose of concurrent rights to any other person or persons for the manufacture of cloths, for the purposes aforesaid, without paying to the said Chaffe one-half of the proceeds of such sales, and one-half the tariff or income which may be derived therefrom.

And the said E. M. Chaffee hereby covenants and agrees with the said Charles Goodyear, his heirs, executors, and administrators and assigns, that the said E. M. Chaffee will pay, or cause to be paid to the said Charles Goodyear, his heirs, executors, administrators and assigns, a sum of money, at and after the rate of three cents per square yard, for each and every square yard of cloth japanned, marbled, or variegated as aforesaid by the said Chaffee, provided the patent or patents, by virtue of which the said rights are granted to the said Chaffee, are sustained by a decision at law in favor of said Goodyear, so as to protect said Chaffee in the advantages thereof, and so long as the said Chaffee shall continue the manufacture of said goods, or derive advantages from said rights as aforesaid. Said payment of said sum to be made for said goods as aforesaid, on the first day of January and July of each year, from the date hereof, so long as the license or conveyance shall exist; and said Goodyear and his assigns be possessed of any patent right of the United States of America before mentioned.

And the said E. M. Chaffee doth further covenant and agree, that he will keep, or cause to be kept, regular books of account of all manufactured cloth to be japanned, whether manufactured by him or his assigns, under his grant or license; which said books of account,
193 and the factories or places of business and manufacture of said goods, shall be at all times open to the visitation and inspection of the said Charles Goodyear and his assigns, and his other duly appointed agents, or his attorneys; and further, that the said E. M. Chaffee shall and will conform to, and comply with the law of the United States of America, by causing the name of Charles Goodyear, and the date of the patent or patents to be stamped upon or affixed to each and every piece of cloth which shall be made under this grant or license, by the said E. M. Chaffee and his assigns. And the said E. M. Chaffee covenants and agrees, that he will not dispose of or assign the license aforesaid to any person or persons, without subjecting them to the terms and restrictions of this license; and that in the event of any improvements being made in the manufacture or composition of said gum elastic for the aforesaid purposes, such improvements shall become the property of said Goodyear, and may be patented by him at his own expense, and for the use of the said E. M. Chaffee and his assigns, for the purposes aforesaid, according to the terms of this license, so far as said improvements may apply to the manufacture of japanned, marbled and variegated cloth, as aforesaid.

In witness whereof, we have hereunto set our hands and seals, the day and year above written.

[L. S.] EDWIN M. CHAFFEE.
[L. S.] CHARLES GOODYEAR.

Witness:
WM. F. ELY.

194 United States Circuit Court, Rhode Island district, November term, 1864.

Exhibit C.—Decree.

CHARLES GOODYEAR, EXECUTOR, *et al.*
vs.
THE PROVIDENCE RUBBER COMPANY, *et al.* } In equity.

This cause came on to be heard upon the pleadings and proofs, and was fully argued by counsel for the respective parties, and the court having duly considered the same, it is now ordered, adjudged, and decreed as follows:

First. That the respondents, the Providence Rubber Company herein have infringed upon the exclusive rights of the complainants under the patent issued to Charles Goodyear, June 15th, 1844, re-issued Dec. 25th, 1849, extended June 14, 1858, and again re-issued to Charles Goodyear, executor, on the 20th day of November, 1860, being re-issue No. (1,084) one thousand and eighty-four, for the new manufacture called vulcanized India rubber, which is a combination of India rubber with sulphur, whether with or without other ingredients, chemically altered by the application of heat, as set forth in the bill herein.

Second. That an absolute injunction issue against the respondents, the Providence Rubber Company, enjoining them, their workmen, officers and agents, and all persons under their control, and
195 each of them, from any further manufacture, use, or sale of cloth, clothing, coats, cloaks, blankets, ponchos, syringe bulbs, and army and navy equipments, made of vulcanized India rubber, or a componnd of India rubber in which sulphur is present in any form or degree, such compound or other fabric made therefrom having been at any time subjected to the action of artificial heat, that are not made by the Union India Rubber Company, or the Phoenix Rubber Company, until the further order of this court.

Third. That the respondents, the Providence Rubber Company, are liable to account to the complainants, the Union India Rubber Company, and the Phoenix Rubber Company, for all profits made in violation of the rights of the complainants under the patents aforesaid, by respondents, in the manufacture, use, or sale of any or all the articles named in the said bill.

Fourth. That Charles Hart, esq., be appointed master in this cause, to take an account of the quantity of said articles manufactured, used or sold by respondents, and of all the profits made by such manufacture, use or sale, and report the same to this court with all convenient speed.

Fifth. That respondents, by its officers, from time to time, as ordered by said master, appear before him and submit to examination in the accounting herein ordered, and produce such books and papers relating thereto as said master may direct, and that the
196 parties have leave to produce and examine witnesses before him, as to the matters of accounting, for which purpose they may have the process of the court to compel their attendance.

Lastly. That upon the coming in of the report the cause be set down for a hearing thereon, and that all further directions be reserved until the coming in of such report, and the final decree to be thereafter entered.

(Signed) NATHAN CLIFFORD,
Associate Justice Sup. Court U. S.

Entered as of the 22d day of November, 1864.

H. PITMAN, *Clerk.*

Circuit Court of the United States, Rhode Island district, June term, 1866.

Exhibit D.

CHARLES GOODYEAR, EX., *et al.*
vs.
THE PROVIDENCE RUBBER COMPANY, *et al.* } In equity.

Whereas the court in adopting the fourth article of the decree in this case did not intend to prescribe any other or different rule of damages than that more clearly and correctly expressed in the third article of said decree:

Therefore ordered, that the fourth article of the decree be and the same is hereby amended by striking out all after the words "respondents," and inserting in place thereof the words following, to wit: "And of all the profits made by the said
197 respondents in violation of the rights of the complainants under the patents aforesaid, in such manufacture, use or sale," and report the same to this court with all convenient speed.

Ordered further, That the report of the master in this case be and the same is hereby recommitted to him under the original decree as amended, with instructions to report accordingly, as therein directed.

Entered as the order of this court this twenty-sixth day of June, A. D. 1866, per order thereof.

HENRY PITMAN, *Clerk.*

198 In the Circuit Court of the United States for the district of Rhode Island.

Exhibit E.

CHARLES GOODYEAR, EXECUTOR, &c., *et al.*
vs.
THE PROVIDENCE RUBBER COMPANY, *et al.* } In equity.

To the judges of the Circuit Court of the United States for the district of Rhode Island:

The petition of Charles Goodyear, of the county of Westchester, and State of New York, executor of the last will and testament of Charles Goodyear, deceased, respectfully shows that he is one of the complainants in the above-entitled suit, that the bill prays for relief on behalf of all the complainants, and that the opinion of the court upon which the interlocutory decree of the 2d of December, 1864, entered as of November 22, 1864, is based, awards, he is informed and believes, the relief to all of the complainants, but that upon the settlement of the said decree it was so drawn and entered as to award and limit, as he is informed and believes, the relief prayed for in the bill and awarded by the court to the two corporations who are co-complainants with the petitioner, and directing the master to proceed upon the accounting decreed with corresponding directions.

That the Hon. Charles S. Bradley the solicitor of record for
199 the complainants has, as your petitioner is informed and believes, ceased to act as such, and has been appointed to, and holds the office of, chief justice of the Supreme Court of Rhode Island.

That your petitioner was yesterday, August 24, 1866, for the first time, appraised of the manner in which said decree had been settled and entered.

That he is advised and believes that he is the party entitled to receive and be paid the chief portion, if not the whole of the sums decreed to be paid or accounted for by the defendants in this suit, and that he has heretofore been informed and believes that the pleadings and proceedings in this suit were in accordance with and in support of his rights and claims as a party in interest, and that he has at no time previous to yesterday had any notice or knowledge to the contrary.

And he is informed and believes that unless the decree is amended in conformity to the said decision, his rights will be prejudiced in this suit.

Wherefore the petitioner prays that this honorable court amend the said decree by striking out in the third clause thereof the following words, viz: The Union India Rubber Company and the Phoenix Rubber Company, and by inserting at the end of said clause the following words: "And that the said master enquire and report to this court what amount of such profits is due to each of said complainants."

200 And that your petitioner may have such other and further relief as to the court shall seem just and meet.

Dated New York, August 25, 1866.

CHA'S GOODYEAR, JR., *Ex'r, &c.*

SOUTHERN DISTRICT OF NEW YORK, *ss:*

Charles Goodyear, junior, being duly sworn, says that he is the petitioner above named, that he has read the foregoing petition, and knows the contents thereof; and that the same is true of his own knowledge, except as to the matters therein stated on information and belief, and as to those matters he believes it to be true.

CHARLES GOODYEAR, JR., *Ex'r, &c.*

Sworn to before me this 25th day of August, 1866.

[L. S.] JOHN L. BROWER,

Notary Public for the City and County of New York residing in New York City.

In the Circuit Court of the United States for the district of Rhode Island.

201 *Exhibit F.*

CHARLES GOODYEAR, EX'R, &c., *et al,*
vs.
THE PROVIDENCE RUBBER CO., *et al.* } In equity.

To the judges of the Circuit Court of the United States for the district of Rhode Island:

The petition of Charles Goodyear, of the county of Westchester and State of New York, executor of the last will and testament of Charles Goodyear, deceased, respectfully shows:

That he is one of the complainants in the above-entitled suit; that the bill prays for relief on behalf of all the complainants, but that upon the settlement of an interlocutory decree of the 2d of December, 1864, entered as of November 22d, 1864, the said decree was, as he is informed and believes, so drawn and entered as to award and limit the relief prayed for in the bill, and granted by the court to the two corporations, who are co-complainants with the petitioner.

That your petitioner, for the first time, on the 24th of Aug't, 1866, was appraised of, or learned of, the manner in which said decree, so limiting the said relief, has been settled and entered, and being, as he is informed and believes, equitably and legally entitled to participate in the said relief, and to receive a share, if not the

202 whole of the sums decreed to be paid or accounted for by the defendants in this suit, he forthwith caused his petition for the amendment of said decree to be prepared and served upon his co-complainants and upon the defendants, and presented to this honorable court, and such action was thereupon had that the same was, on the 28th of August, 1866, referred by the Hon. J. R. Bullock to the circuit judge.

That your petitioner, who had previously been informed and believed, that the complainant's pleadings and proceedings in this suit were in accordance with, and in support of, his rights and claim as a party in interest, and who, fully confiding and relying thereon, had not examined the same, thereupon caused the bill of complaint, which had been put in and filed without his perusal or signature, to be examined on his behalf, and your petitioner thereupon, and after the presentation of said petition to amend said decree, for the first time ascertained and learned that the said bill contained in sundry allegations language tending to show or showing that the said co-complainants of your petitioner possessed exclusive rights to vend and manufacture the said patented goods in controversy, and the vending and manufacture of which, by the defendants, has been since decreed to be an infringement of the patent of your petitioner, and which statements of exclusive rights in said co-complainants are, as your petitioner is informed and believes, incorrect and wrong, and which will also so appear by reference to the schedules an-
203 nexed to said bill, and which statements are calculated to prejudice and impair the just rights and equities of your petitioner, and which he is advised and believes should be amended in accordance with the prayer of this petition.

That the Hon. Cha's S. Bradley, the solicitor of record for the complainants, has, as your petitioner is informed and believes, ceased to act as such, and has been appointed to and holds the office of chief justice of the Supreme Court of Rhode Island.

And your petitioner further alleges that this petition is not made for the purpose of vexation or delay, and that he is advised and believes that the proposed amendments are material.

Wherefore the petitioner prays that this honorable court amend the said bill of complaint by striking out, in the 5th line of the 20th folio thereof as printed, the word "exclusive," and adding after the words "all of which are still in force and effect," in the first line of the 21st folio, these words, "except as modified or annulled by the agreements herein referred to as Exhibits L, M, and N.

Also by striking out in the 6th line of the 21st folio the word "continuing." and substituting in place thereof the word "respecting," and adding at the end of said paragraph or folio, after the words "page 180," these words, "except as so far modified or annulled as herein before stated."

Also to amend the 40th folio by striking out therefrom the words "The Union India Rubber Company and the Phenix Rubber Company," and also the words "the execution of their respective
204 licenses," and substituting in the place of the latter words, these words, "previous to the acts of the defendants therein complained of."

And also to amend the 42d folio by striking therefrom the words "The Union India Rubber Company and the Phenix Rubber Company."

And also that your petitioner may have leave to appear in this

suit by his own solicitor, and also to file a supplemental bill, and such other and further relief as to the court shall seem just and meet.

Dated New York, November 6th, 1866.

CHARLES GOODYEAR,
Executor, &c., of Charles Goodyear, deceased.

UNITED STATES OF AMERICA, *Southern District of New York, ss:*

Charles Goodyear, junior, being duly sworn, says that he is the petitioner above named; that he has read the foregoing petition and knows the contents thereof; and that the same is true of his own knowledge, except as to matters therein stated on information and belief, and as to those matters, he believes it to be true.

CHARLES GOODYEAR.

Sworn to before me this 6th day of November, 1866.

[L. S.] JOHN L. BROWER,
Notary Public N. Y. city and county, dwelling in the city of New York.

205 Circuit Court of the United States, November term, 1866.

Exhibit G.

CHARLES GOODYEAR, ex'r, *et al*, *vs.* THE PROVIDENCE RUBBER CO., *et al.* } In equity.

RHODE ISLAND DISTRICT, *ss:*

Upon petition of Charles Goodyear, executor, to amend the interlocutory decree made in said cause on the 22d day of November, 1864, by striking out in the third clause thereof the following words, viz: "The Union India Rubber Company and The Phenix Rubber Company," and by inserting at the end of said clause the following words, viz: "That the said master enquire and report to this court what amount of such profits is due to each of said complainants."

It is ordered that the third article of the decretal order be and the same is hereby amended by inserting after the words "complainants" the words "Charles Goodyear, executor of the last will and testament of Charles Goodyear, deceased." the petition, except as aforesaid denied. The court grant the amendment to make the decretal order conform to the language of the bill of complaint and as the correction of a clerical error in the original decretal order.

Entered as the order of this court, this 20th day of November, 1866.

HENRY PITMAN, *Clerk.*

206 Upon hearing Mr. W. E. Curtis for the petitioner, Charles Goodyear, ex'r, *et al*, and Mr. Evarts and Hon. B. R. Curtis for the Phenix Rubber Company and the Union India Rubber Company, and upon reading and filing the petition, ordered, that the

prayer of the petitioner that he may have leave to appear in this court by his own solicitor be and the same is hereby denied.

Entered as the order of this court, this 20th day of November, 1866.

HENRY PITMAN, *Clerk.*

207 *Exhibit H.*

The State of Rhode Island and Providence Plantation, Providence, &c., to the sheriffs of our several counties or to their deputies, greeting:

We command you to arrest the body of Charles Goodyear, of New Haven, in the State of Connecticut, manufacturer alias gentleman, (if he may be found in your precinct,) and for want of his body to attach his goods and chattels to the value of one hundred thousand dollars, and him or those in safe custody keep to answer the complaint of Edwin M. Chaffee, George O. Bourn, and William W. Brown, all of the city and county of Providence, co-partners under the firm of E. M. Chaffee & Company, at the next Supreme Court, to be holden at Providence, within and for our said county of Providence, on the fourth Monday of September next ensuing, the date hereof, in an action of the case, for that the said defendant hath broken his promises to the plaintiffs made, as by declaration to be filed in court will be fully set forth, to the damage of the plaintiffs one hundred thousand dollars. Hereof fail not, and make true return of this writ with your doings thereon. Witness, Samuel Ames, esq., at Providence, this first day of April, in the year 1857.

[L. S.] JOHN A. GARDNER, *Clerk.*

The sheriff may attach personal property to less amount than that named in the writ.

T. A. JENCKES, *Pl'ff's Attorney.*

208 PROVIDENCE, *ss*:

APRIL 3*d*, 1857.

For want of the body of the within-named defendant, to be by me found in my precinct, I have this day, at eleven o'clock a. m., made service of this writ by attaching two pieces grass. cloth, one piece red fitting, six rolls cotton batting, one piece of perforated rubber cloth, one roll grass cloth, one roll sheeting covered with cotton batting, two bundles wadding, one piece bagging, set forth to me by the pl'ffs as the property of the defendant, and have left a true and attested copy of this writ, with my doings hereon, with Messrs. Bourn & Brown, in whose hands or possession I found said goods and chattels, the defendants having no last and usual place of abode within my precinct whereat to leave a copy.

ROGER W. POTTER, *D. Sheriff.*

Service	50
Copy	20
Per centage	49 75
	50 45

Supreme Court, September term, A. D. 1857.

Declaration.

PROVIDENCE, *ss:*

Edwin M. Chaffee, George O. Bourn, and William W. Brown, all of the city and county of Providence, co-partners under the firm of E. M. Chaffee & Company, complain of Charles Goodyear, of New Haven, in the State of Connecticut, manufacturer alias gentleman, duly served by attachment by the sheriff in an action of the case.

For that whereas heretofore, to wit, on the twenty-seventh day of March, A. D. 1851, at New Haven, to wit, at said Providence,
209 the said defendant, by his contract in writing of that date with the said plaintiffs, agreed that said Chaffee, one of the plaintiffs as aforesaid, should go to Providence with the said Bourn & Brown, for the purpose of executing the orders of the said defendant for certain India rubber goods, such as ship's sails, carpetings, air work, round and driving reins, pervious and perforated trunk, and other straps and carpet bags, with the view and expectation that said plaintiffs should, within one year from said last-mentioned date, obtain on reasonable terms from said defendant a license to manufacture some one or more of the branches aforesaid.

And it was furthermore then and there agreed by the said defendant, that if an assortment of specimens of articles made in a workmanlike manner, and described in a certain schedule annexed to the said agreement, should be made by the said plaintiffs, at the defendants' expense, within one year from and after the date of the said agreement, that in such case the said defendant would within one year from and after the said date, to wit, the twenty-seventh day of March, A. D. 1852, be instrumental in obtaining a license from the shoe associates for the said pl'ffs for three hundred pairs of shoes per day, at the same rate of tariffs that was paid by the other shoe companies and by Dr. Hartshorn to said shoe associates.

And it was furthermore then and there agreed by the said defendant, that the terms of the concurrent right to any other
210 branch of manufacture aforesaid should be on as favorable terms as was granted to any other person.

And it was furthermore then and there agreed by the said defendant, that in case he, the said def't, should be wholly unable to obtain the shoe license as aforesaid, the said defendant should pay to the said plaintiffs the sum of five thousand dollars.

And the said plaintiffs aver that they have kept and performed their said contract and agreement entered into with the said defendant in all things relating thereto, but that the said def't has omitted, neglected, and refused to keep and perform his said promises, undertakings, and obligations so entered into by him in the said agreement.

And also for that the said defendant heretofore, to wit, on the sixth day of March, A. D. 1861, at New York, to wit, at said Providence, agreed with the said plaintiffs that they should make various articles of India rubber for and on account of him the said defendant,

and then and there represented to the said plaintiffs that he owned a certain right of license for the manufacture of India rubber boots and shoes, which said right or license was entirely independent of all other shoe licenses and under his the said defendant's control; that the said defendant then and there agreed to sell said right or license for the said manufacture to the said plaintiffs, and also a full and exclusive right for making certain goods, called batting goods,
211 to be made up in any shape for a certain agreed price, to wit, the sum of three thousand dollars.

And the said plaintiffs aver, that they have kept and performed their said contract and agreement entered into with the said defendant in all things relating thereto; but the said defendant has omitted, neglected, and refused to keep and perform his said promises, undertakings, and obligations, so entered into by him in said agreement.

Also, for that the said defendant, at New York, to wit, at said Providence, on the day of , A. D. 1851, for and in consideration that the said plaintiffs had kept and performed all their agreements made and entered into with the said defendant, and had commenced the manufacture of India rubber goods, as aforesaid, agreed with the said pl'ffs that they, the said pl'ffs should continue the said manufacture and sale, and he would protect them from any and all suits or complaints on the part of others, if any should be commenced or made, and gave the said plaintiffs direct license, permission, and authority for himself, and as the representative of his other licenses, to manufacture and sell as aforesaid during the continuance of his patents.

And the said plaintiffs further aver, that they expended a large sum of money for the benefit of the said defendant, and that in consequence of the failure of the said defendant to procure the said license, according to the terms of the said contract aforesaid, suits have been commenced against them and their agents, and judgment has
212 been rendered against them for large amounts; that the said defendant, though often requested thereto, has wholly omitted, neglected and refused to protect the said plaintiffs in the said suits, according to the terms of the said agreement, and that the said plaintiffs have been obliged to pay a large sum of money, to wit, the sum of ten thousand dollars, in defending said suits, and have also suffered great loss in their business by injunctions granted in said suits against said plaintiffs and their agents by the courts of the United States for the district of Massachusetts, Rhode Island, the southern districts of New York, the eastern district of Pennsylvania, and the district of Maryland, restraining said plaintiffs and their agents from making, using, or vending to others to be used the thing patented by the said defendant in the manufacture of India rubber boots and shoes, as aforesaid, and have been made liable to pay large sums to the parties against whose claims the said defendant promised and agreed, for the consideration aforesaid, to protect and guarantee the said plaintiffs.

For that the said defendant, at said Providence, on the 1st day of April, A. D. 1857, was justly indebted to the plaintiffs in the sum of

5,410 dollars and 75 cents, by book account, according to the account herewith filed; and being so indebted, he, the said defendant, then and there, in consideration thereof, assumed on himself, and to the plaintiffs promised to pay them the same on request.

213 And also, for that the said defendant, at the place aforesaid, on the first day of , A. D. 1857, being justly indebted to the plaintiffs in one other sum of one hundred thousand dollars, for certain goods, wares, and merchandise, there before that time sold and delivered by the plaintiffs to the defendant, at the special instance and request of the defendant; and also for certain work and labor, skill, care, and diligence there before that time done, peformed, and bestowed by the plaintiffs for the defendant, at the defendant's request, then and there, in consideration thereof, promised the plaintiffs to pay them said sum on request; and also for interest for the forbearance of suit by the plaintiffs, at the defendant's request, of certain sums of money, due and owing from the said defendant to the plaintiffs.

And also for that the defendant, at the place and on the day and year aforesaid, being justly indebted to the plaintiffs in one other sum of one hundred thousand dollars, for so much money before that time had and received to the use of the plaintiff; and also for so much money before that time paid, laid out, and expended to and for the defendant, and at his instance and request; and also for so much money before that time lent and advanced to the defendant by the plaintiffs, then and there, in consideration thereof, promised the plaintiffs to pay them said sum of money last-mentioned on request; yet, though requested, the defendant hath not paid said sum or any part thereof, but ever hath refused, and doth refuse,

214 to pay the same, to the plaintiffs' damage one hundred thonsand dollars, as laid in their writ, dated the first day of April, A. D. 1857; wherefore, they sue by their attorney.

T. A. JENCKES.

Copy of agreement.

Mr. CHARLES GOOOYEAR,

To E. M. CHAFFEE & Co.:

For E. M. Chaffee's services in getting up new kind stuff, 4½ months, up to October 1, 1851, at $2,000 per annum	$922 24
For A. F. Adee's bill for merchandise	231 03
For Joseph Sweet's bill for merchandise	367 23
For G. & F. Taylor's bill for merchandise	112 07
For E. P. Dason & Co.'s bill for merchandise	28 58
For Gardner & Tiffany's bill for merchadise	6 15
For C. Pratt for merchandise	16 63
For Draper and Thomas for merchandise	15 87
For Providence Gass Co. for merchandise	162 16
For freight and drayage	14 14
For 1885 lbs. rubber, 40 c'ts	754 00

For 58 days' work in June,	$1 50	87 00
For 92 days' work in July,	1 50	138 00
For 45 days' work in August,	1 50	68 38
For 55 days' work in Sept.,	1 50	82 75
For 120 gallons camphene, 50 c'ts		60 00
For services for getting up different patterns shoes and kinds, as per agreement,		1,000 00
5½ years' interest, up to April 1st, 1857,		1,342 52
Total		$5,410 75

215 *Judgment.*

STATE OF RHODE ISLAND AND PROVIDENCE PLANTATIONS, PROVIDENCE, *ss.*

At the Supreme Court of said State, begun and holden at Providence, within and for the county of Providence, on the fourth Monday of September, in the year of our Lord one thousand eight hundred and fifty-eight—

Be it remembered, that at the September term of said court, 1857, Edwin M. Chaffee, George O. Bourn and Wm. W. Brown, all of Providence, co-partners, as E. M. Chaffee & Co., complain of Charles Goodyear, of New Haven, Connecticut, served by attachment by the sheriff in an action of the case, for that the def't, at said Providence, on the 1st day of April, 1857, was jointly indebted to the pl'ffs to the sum of 5,410 75-100 dollars by book account, and being so indebted, assumed on himself and to the pl'ffs to pay them the same on request.

The plaintiffs add other counts upon contracts made and entered into between the said def't and them in relation to the manufacture of India rubber goods, the obtaining a license for the pl'ffs by the def't from the Shoe Association, which the pl'ffs alleged they have performed on their part, but which the def't has wholly broken and neglected to perform, and add the usual common counts; yet, though
216 requested, the def't has not performed his promises but refuses so to do to the pl'ffs' damage 100,000 dollars, as laid in their writ, dated April 1st 1857; wherefore they sue, &c.

Said cause was duly entered at said term and thence continued from term to term to the present for assessment of damages, and being now called and fully heard by the court, it is considered by the court that the pl'ffs recover and have of the def'ts the sum of $48,215 23-100 dollars damages and their costs of suit, taxed at 94 70-100 dollars.

CLERK'S OFFICE SUPREME COURT,
Providence, June 14, *A. D.* 1867.

STATE OF RHODE ISLAND AND PROVIDENCE PLANTATIONS, *Providence, ss.*

I, Charles Blake, clerk of the Supreme Court of said State, within and for the county of Providence, do hereby certify that the papers hereto annexed are true copies of the original writ, with the attor-

ney's direction and the officers' return thereon; the plaintiffs' declaration; the account filed therewith, and the judgment of the court thereon. Said judgment being rendered on the 54th day of the March term of said court, A. D, 1858, to wit, on the 3d day of December, A. D. 1858; all which appears on the files and records in said clerk's office now remaining.

In attestation whereof. I hereto subscribe my name and affix the seal of said court this 14th day of June, A. D. 1867.

[L. S.] CHARLES BLAKE, *Clerk.*

[5 cent int. rev. stamp, duly cancelled.]

217 STATE OF RHODE ISLAND,
and Providence Plantation, ss:

I, Charles S. Bradley, chief justice of the Supreme Court of the State of Rhode Island and Providence Plantations, do certify that Charles Blake, whose signature is affixed to the papers hereto annexed, is clerk of the said Supreme Court for the county of Providence, and hath the keeping of the files, records, and proceedings of said court, and of all former Supreme Courts holden within and for said county, and is by law the proper person to make out and certify copies thereof, and that full faith and credit are and ought to be given to his acts and attestations done as aforesaid, and that his attestation to the papers hereunto annexed is in due form.

In testimony whereof, I hereunto set my hand this 14th day of June, A. D. 1867.

CHARLES S. BRADLEY, *Ch. J.*

[5 cent. int. rev. stamp cancelled.]

And at the same time of the filing of said bill of complaint the following motion was made :

Motion for substituted service.

THE PROVIDENCE RUBBER COMPANY *et al.*
vs.
CHARLES GOODYEAR, JR., ex'r, *et al.*

The complainants in the above-entitled suit move the court that in the abovenamed suit the court order that the subpœna
218 prayed for in the bill filed by the said complainants may be served upon the solicitor of the Union India Rubber Company and the Phenix Rubber Company, and of Charles Goodyear, executor, &c., now appearing in the records of this court to be such solicitor, and that service of the said subpœna may also be made upon Charles Goodyear, claiming to be the executor of Charles Goodyear, deceased, by having service of the same made upon him by some disinterested person in the State of New York, where he, the said Charles Goodyear, resides, and of which said State he is a citizen.

By their solicitor, A. Payne.

Which motion was heard before said court on the 28th of November, 1866, and the following order was entered:

Ordered, That leave for substituted service upon the solicitor of record be granted; rest of motion denied.

Entered as the order of said court this 28 November, 1867.

HENRY PITMAN, *Clerk.*

Wherepuon the following subpœna was issued:

219 RHODE ISLAND DISTRICT, *sc:*

The President of the United States of America to Charles S. Bradley, esq., of the city of Providence, in said district, solicitor of record of Charles Goodyear, jr., of the State of New York, executor of the last will and testament of Charles Goodyear, deceased, the Union India Rubber Company, a corporation duly organized under the laws of the State of New York, and the Phenix Rubber Company, a corporation duly organized under the laws of the State of Connecticut, greeting:

For certain causes offered to our Circuit Court for the first circuit, within and for the Rhode Island district, in chancery, we hereby command and strictly enjoin you, and each of you, that laying aside all other matters and things, and notwithstanding any other excuse, you, and each of you, personally appear at the clerk's office of said court in Providence, on Monday, the seventh day of January next, being the rule day of said court, and then and there, full, true, and perfect answer make, upon your several corporal oaths, to the bill of complaint of The Providence Rubber Company, a corporation duly organized under the laws of the State of Rhode Island, Augustus O. Bourn, William W. Brown, and Edwin M. Chaffee, stockholders, agents, and officers of the Providence Rubber Company, citizens of the State of Rhode Island, now filed of record in the clerk's office of said court, and to do and receive whatever our said court shall order against you in the premises in this behalf; and hereof fail not under the pains and penalties that may accrue in consequence of neglect thereof.

And the marshal of said Rhode Island district, or his deputy, is hereby commanded to make service of this writ by reading the same to the said Chas. S. Bradley, or by leaving a true and attested copy hereof at their several last and usual places of abode twenty days before the rule day aforesaid.

Witness the Hon. Salmon P. Chase, our Chief Justice, at Providence, this 5th day of December, A. D. 1866.

HENRY PITMAN, *Clerk.*

MEMO.—The appearance of the respondents in the suit is to be entered in the clerk's office on or before the return day of this writ, otherwise the bill may be taken pro confesso as against those not appearing.

220 RHODE ISLAND DISTRICT, *ss:*

PROVIDENCE, *Dec. 6th*, 1866.

By virtue hereof, and as directed, I have made service of the within summons by leaving a true and attested copy of the same at the last and usual place of abode of the within-named Charles S. Bradley.

R. SHERMAN,
U. S. Marshal.

Service	$2 00
Copy	50
Travel	10
	$2 60

And at the rule day aforesaid the following appearances were entered:

"B. R. Curtis appears specially for the parties named as defendants, reserving all rights, and especially reserving the right to object to the jurisdiction of the court, for which purpose alone this appearance is now entered."

B. R. CURTIS, *Sol'r.*

Charles Goodyear, executor of Charles Goodyear, deceased, one of the defendants in the above-entitled cause, hereby enters his appearance in said cause.

Jan'y 7, 1867.

By his solicitors, W. E. Curtis & B. T. Eames.

221 And on the first day of February, 1867, was filed the following:

Demurrer.

The demurrer of Charles Goodyear, executor of the last will and testament of Charles Goodyear, deceased, one of the defendants in this suit, to the bill of complaint of the Providence Rubber Company, Wm. Brown, Edwin M. Chaffee, and Augustus O. Bourn.

This defendant, Charles Goodyear, executor as aforesaid, by protestation, not confessing all or any of the matters and things in the said complainants' bill contained, to be true, in manner and form as the same are therein related, set forth, and alleged, doth demur to the said bill, and for cause of demurrer shows—

1st. That the said complainants have not, by their said bill, made such a case as entitles them in a court of equity to any discovery from this defendant, or any relief against him as to the matters contained in the said bill, or any of such matters, and that any discovery which can be made by this defendant touching the matters complained of in the said bill, or any of them, cannot be of any avail to

the said complainants, or any of them, for any of the purposes for which a discovery is sought against this defendant by the said bill, nor entitled the said complainants, or any of them, to any relief in this court touching any of the matters therein complained of.

222 2d. That the matters and things set forth, alleged, complained of, and prayed for in the said bill of complaint are not within the jurisdiction of this honorable court, nor cognizable by any municipal court of justice.

3rd. That the said complainants have not, in and by their said bill, shown any right and title whatsoever to compel this defendant and the Union India Rubber Company and the Phenix Rubber Company, the other said defendants to the said bill, to interplead.

4th. That the said complainants have not, in and by their said bill, shown such a case as renders the discovery sought for material to the relief prayed for in the said bill.

5th. That it appears by the complainants' own showing in the bill aforesaid, that the alleged off-set is a judgment debt therein claimed to be due to the complainants from Charles Goodyear, deceased, in his lifetime, who was the testator of this defendant, and that this defendant's claim is for a cause of action arising after the death of his said testator.

6th. That it appears by the complainants' own showing, by the bill aforesaid, that in the action in which the alleged judgment against the estate of the defendant's testator, Charles Goodyear, was recovered in the Supreme Court of the State of Rhode Island, at its March term, A. D. 1858; that the said testator, Charles Goodyear, was then living, but that he was not summoned, and did not

223 appear; and that no notice, writ, or process was ever served upon him or appearance made by him in the said action; and that at the time of the commencement of the said action, and up to the rendition of the alleged judgment, he was not a resident of the State of Rhode Island, or subject or amenable to its laws, or within the jurisdiction of any of the courts of said State, and that the said action and judgment were only proceedings against the property of the said Charles Goodyear, defendant's testator, and were of no validity, force, or effect, and without jurisdiction as to the said Charles Goodyear, or as to this defendant.

7th. That it appears from the complainants' own showing, in the bill aforesaid, that the alleged cause of action, offset or claim of the complainants against this defendant in the bill set forth, did not accrue or arise within six years next before the commencement of this suit or the exhibition and filing of the said bill, or of the suing out or service of any process against this defendant concerning the same.

8th. That it appears by the complainants' own showing, by the bill aforesaid, that the said complainants seek to offset against the claim of this defendant upon the Providence Rubber Company, one of said complainants, an alleged judgment debt jointly owned by all of said complainants, and that the said claim of this defendant and the said judgment debt sought to be set-off by the defendants, are not mutual and due in the same right.

224 9th. That the complainants have not by their bill, which seeks to establish a set-off against the claim of this defendant therein stated, made or shown such a case as doth or ought to entitle them, or any of them, to any such discovery or relief, as is thereby sought and prayed for, from or against this defendant.

10th. That the complainants in and by their said bill, affect and claim that the same is a mere cross-bill, but that in fact the said bill sets forth and contains allegations and matters separate and distinct from and independant of the matters in litigation in the original suit.

Whereupon, and for other good causes of demurrer appearing in the said bill, this defendant demurs thereto, and he prays the judgment of this honorable court, whether he shall be compelled to make any further and other answer to the said bill, and he humbly prays to be hence dismissed with his reasonable costs in this behalf sustained.

CHARLES GOODYEAR, JR., *Executor.*
B. T. EAMES & W. E. CURTIS,
Solicitor for the Defendant, Chas. Goodyear, Executor, &c.
JAMES C. CARTER,
Of Counsel for the Defendant, Chas. Goodyear, Executor.

The undersigned hereby certifies that in his opinion the foregoing demurrer is well founded in point of law.

JAMES C. CARTER,
Of Counsel for the Defendant, Chas. Goodyear, Ex'r.

225 UNITED STATES OF AMERICA,
Southern District of New York, ss:

On this 29th day of January, A. D. 1867, before me, came the above named defendant, Charles Goodyear, who being duly sworn, makes oath and says, that the foregoing demurrer is not interposed for delay.

[L. S.] JOHN L. BROWER,
Notary Public for New York City and County,
Dwelling in the City of New York.

And on the 28th day of March, 1867, was filed the following:

Motion to dismiss.

Now, pursuant to the special appearance entered herein, The Union India Rubber Company, and The Phenix Rubber Company, do move to dismiss the bill of complaint filed herein, Nov'r 28th, 1866, for want of jurisdiction.

Dated March 27, 1867.

B. R. CURTIS, *Solicitor.*

And said cause was continued to the present June term, 1867, when it was called for hearing upon the demurrer, and motion to dismiss filed therein, and was argued by counsel, and the following decree entered.

226 *Decree.*

The above entitled cause came on, to be heard upon the demurer to the bill filed by Charles Goodyear, junior, executor of Charles Goodyear, deceased, and also upon the motion filed by The Union India Rubber Company, and The Phenix Rubber Company, to dismiss the bill for want of jurisdiction, and the court having heard the counsel of the respective parties, do order and decree, that the said demurrer be allowed and sustained, and adjudged sufficient, and that the said motion be allowed, and that, as well on said demurrer filed by said Charles Goodyear, executor, as upon said motion filed by The Union India Rubber Company, and the Phenix Rubber Company, the said bill be dismissed with costs to the said Charles Goodyear, jr., ex'r of Charles Goodyear, deceased, as also with costs to the said The Union India Rubber Company, and The Phenix Rubber Company, the said costs to be taxed by the clerk.

Entered as the decree of this court, per order thereof, this 18th day of June, 1867, to wit, the 3d day of June term, 1867.

HENRY PITMAN, *Clerk.*

From which decree the complainants prayed an appeal in open court, on said third day of the June term, 1867, which appeal was allowed upon their filing a bond in the sum of five hundred
227 dollars to the satisfaction of the district judge.

And on the 4th day of November, 1867, the following bond and filed:

Appeal bond.

Know all men by these presents, that The Providence Rubber Company, executing this instrument by their treasurer, Augustus O. Bourn, thereto duly authorized, the said company being a corporation, created by the laws of the State of Rhode Island, and doing business in the city of Providence, William W. Brown, Edwin M. Chaffee, and Augustus O. Bourn, as principal, and Abraham Payne, and James H. Parsons, as sureties, are held and firmly bound unto Charles Goodyear, executor, &c., of the last will and testament of Charles Goodyear, deceased, The Union India Rubber Company, a corporation duly created by the laws of New York, and The Phenix Rubber Company, a corporation duly created by the laws of Connecticut, in the full sum of five hundred dollars, to the payment whereof, well and truly to be made to the said Charles Goodyear, executor, &c., and said Union India Rubber Company, and The Phenix Rubber Company; we the said principals and sureties do hereby bind ourselves, our heirs, executors and administrators.

Sealed with our seals, and dated this twelfth day of October, A. D. 1867.

The condition of this obligation is such, that whereas, at a Circuit Court of the United States holden on the 15th of June, A. D. 1867, within and for the district of Rhode Island, a suit in equity
228 commenced by the said Providence Rubber Company, Wm.

W. Brown, Edwin M. Chaffee, and Augustus O. Bourn, against Charles Goodyear, ex'r, &c., The Union India Rubber Company, and The Phenix Rubber Company, was heard and determined, and the decree was entered, dismissing said bill, on the demurrer being filed therein by said Charles Goodyear, ex'r, &c., and also dismissing the same on the motion filed therein by the said Union India Rubber Company, and the said Phenix Rubber Company. And an appeal from said decree was prayed in open court, and the said appeal having been granted to the Supreme Court of United States, to be holden at Washington, on the first Monday of December, A. D. 1867. Now, if the said Providence Rubber Company, Wm. W. Brown, Edwin M. Chaffee, and Augustus O. Bourn shall prosecute the said appeal with effect, or in default thereof pay all costs which may be decreed against them, then this obligation to be void, otherwise in full force and effect.

In witness whereof, we have hereunto set our hands and seals, this twelfth day of October, A. D. 1867.

PROVIDENCE RUBBER CO.,
[L. S.] By A. O. BOURN, *Treasurer.*
[L. S.] WM. W. BROWN.
[L. S.] E. M. CHAFFEE.
[L. S.] A. O. BOURN.
[L. S.] ABRAHAM PAYNE.
[L. S.] JAMES H. PARSONS.

Approved Octo. 14, 1867.

J. R. BULLOCK, *District Judge.*

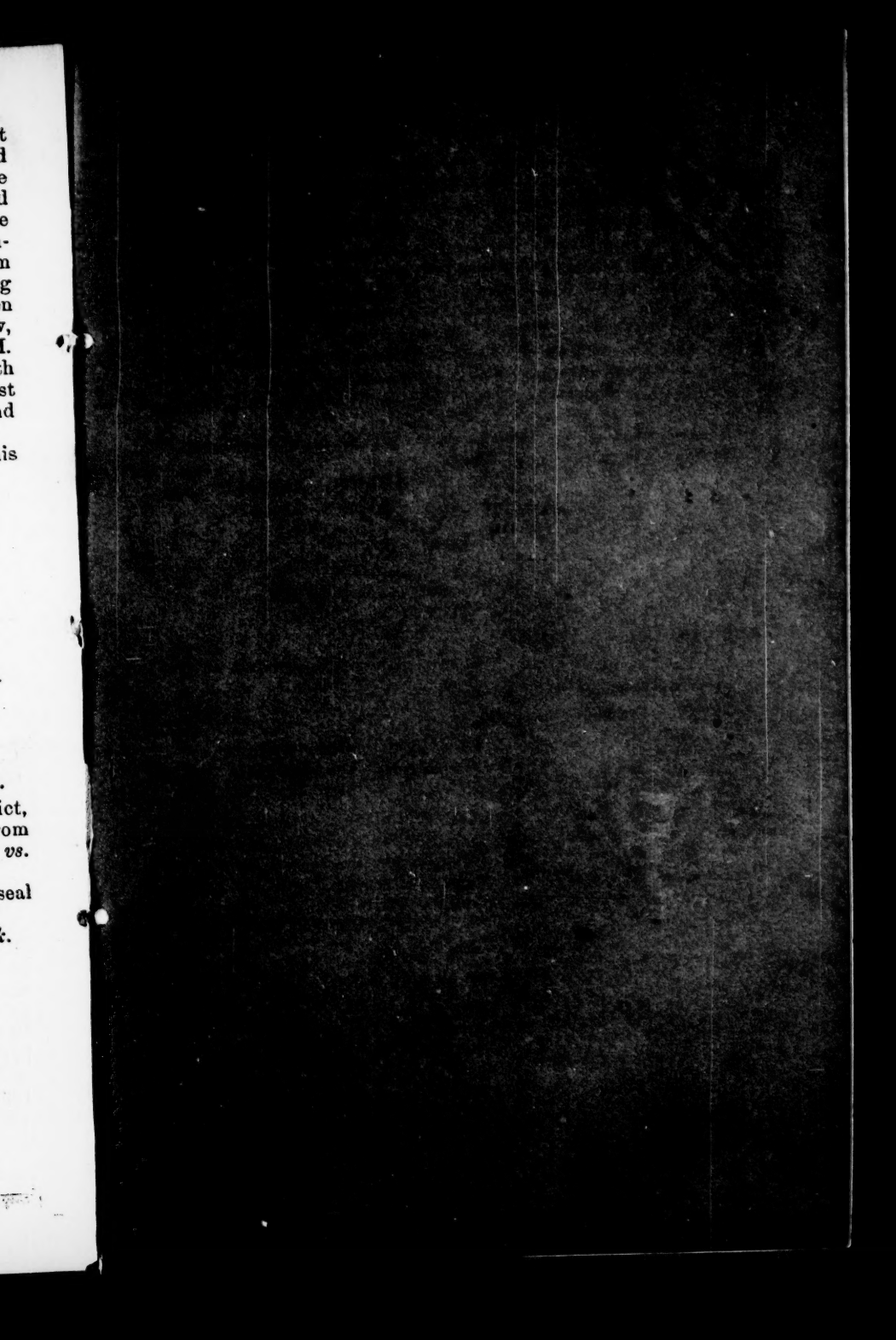
229 UNITED STATES OF AMERICA,
Rhode Island District, ss:

CLERK'S OFFICE, CIRCUIT COURT,
Providence, November 25th, 1867.

I, Henry Pitman, clerk Circuit Court, U. S. for said district, do hereby certify, that the foregoing contains a true transcript from the record of the cause in equity, Providence Rubber Company *vs.* Charles Goodyear, ex'r, *et als.*, duly examined and compared.

In testimony whereof, I have hereunto set my hand and the seal of said court, on the day and year above written.

[SEAL.] HENRY PITMAN, *Clerk.*



Supreme Court of the United States.

THE PROVIDENCE RUBBER CO. *et al.*, appellants,
vs.
CHARLES GOODYEAR, executor, *et al.*
No. 35.

BRIEF AND POINTS FOR APPELLANTS.

This is a Cross-Bill, filed in the clerk's office of the United States Circuit Court for the Rhode Island district, on the 27th day of November, A. D. 1867.

The circumstances attending, and the reasons which induced its filing, are briefly as follows:—

On the 18th of September, 1866, while the original suit to which the cross-bill refers (which has since been brought to this court on appeal, the same being No. 25 on the docket of the present term) was pending before a master, Charles Goodyear, executor, &c., one of the complainants, filed before the master a request that he stay proceedings until the said Goodyear might make application to the Circuit Court for the Rhode Island district to appear by his own solicitor, to have the decree amended, so that his rights and interests, which were diverse from those of his co-complainants, might be protected. This request the master refused, whereupon the said Goodyear filed a protest against further proceedings. (*See pp.* 1175, 1176, 1177, *of Record, No.* 25.)

On the 20th of November, 1866, Goodyear presented his petition to the court to amend the interlocutory decree, and

also another petition to amend the bill of complaint, to appear by his own solicitor, to file a supplemental bill, &c.

The court, upon the first petition, made of its own motion, a formal amendment to the decree, but did not grant the prayer of the petition. The second petition was denied. (*See pp.* 1182, 1183, 1184, 1185, 1186 *of Record, No.* 25.)

The defendants had, in the proceedings before the master, insisted that it was his duty to have ascertained the relation between Charles Goodyear and the other complainants, and to have ascertained also the proportion of profits due to Goodyear, who, in his request to the master, as well as afterwards in his petition to the court, claimed to be entitled to "a large portion, if not the whole of the same." This claim of the defendants constituted one of their exceptions to the master's report. (*See exception* 21, *p.* 1181, *Record, No.* 25.)

The defendants were and are the equitable owners of a judgment obtained against Charles Goodyear, Sr., deceased, and which they always had claimed and now claim that they had the right equitably to have had allowed in reduction of any claim for damages on the part of the executor.

The existence of this judgment was brought to the master's attention. It is referred to in the record. (*P.* 854, *fol.* 540, *p.* 858, *fol.* 546, *Record, No.* 25.)

When the court refused to sustain the exception referred to, or to grant the prayer of Goodyear's petition, the defendants deeming that they were entitled to have the benefit of this judgment in reducing the damages, filed their Cross Bill. The motion was granted, and the bill filed by leave of court November 27, 1866. (See present Record, No. 35, p. 1.)

The bill states the filing of the original bill, the answer, and the petitions of Goodyear. It also sets up the judgment at length, and prays substantially that each of the defendants may set forth what proportion of damages each claims, and that the court may determine what is the proportion due to each, and that the complainants may offset the amount of judgment against the proportion due Goodyear as executor.

To this cross bill Goodyear, the executor, demurred, while the other defendants filed a motion to dismiss for want of

jurisdiction. The court entered a decree (no hearing being had, it being understood that the case would be appealed to this court, an appeal having been taken in the original suit) sustaining the demurrer, and also granting the motion to dismiss. (*See Record, p.* 134, *fol.*, 221, *et seq.; also pp.* 136, 137.)

The bill prays that all the proceedings had in the original suit may be referred to and made part of this. (*Record, p.* 5, *fol* 11.) Indeed that record is practically made part of this. The bill and answer are annexed as Exhibits, and the whole record referred to. The complainants moved, at the time of the filing of the bill, for a substituted service of the subpœna on the solicitor of the two corporations defendant, and for service on Goodyear by some disinterested person in New York, where he resided. The first part of the motion was granted, the remainder denied. So that Goodyear appeared without having been served with process and of his own motion.

Points.

First. As to the motion to dismiss for want of jurisdiction.

We claim that the granting of this motion by the court below was erroneous.

The parties, the subject-matter, all the essentials of jurisdiction, were before the court. The bill was filed after the final hearing it is true, and after the exceptions to the master's report had been argued, *but before the entry of any final decree in the original suit.* (See present Record, p. 1; see return to *certiorari* issued January 10, 1868, p. 3, in No. 16.)

Process was not served until after the final decree in the original suit, but the motion for substituted service was heard and granted in part November 28, 1866, the day the court delivered its opinion in the original suit.

Present Record, p. 133.

Goodyear, one of the defendants, voluntarily appeared,

without being served with process, and filed his demurrer February 1, 1867, his own solicitor also appearing.

Present Record, pp. 134 to 136.

The bill was thus actually on file before the original suit had been finally disposed of in the court below.

Second. As to the demurrer.

I. It is claimed that the cross-bill contains matters and allegations separate and distinct from, and independent of, the matters in litigation in the original suit.

We were sued by three different parties. The master reported that we were to pay a large sum. He refused to ascertain the proportion due to each. We had a judgment against one of the parties, the existence of which was made known to the master. We desired that the proportions due to each should be ascertained, in order that we might claim the benefit of that judgment in reducing the amount ascertained to be due to one of the parties. That party appeared before the master and claimed that he was entitled to "a large portion, if not the whole," of the damages. He appeared before the court, making the same claim by elaborate petitions. Now, we submit that the setting up of the judgment in our cross-bill was not only not introducing anything foreign, distinct, and independent, but it was essential that we should set it up. It was setting up a perfectly proper, legitimate defence, in the form of a cross-bill. The motions and petitions of Goodyear show his distinct interest. They were part of the proceedings in the original suit, and if he has a claim, by himself, to "a large portion, if not the whole," of these damages, we have a right to set up his diverse claim, our judgment, and the fact that his proportion is to be reduced by the amount of this judgment.

If we held his promissory note, giving notice that we held it to the master, the master, then finding that he and the other parties were entitled to a large sum, but refusing to allow any deduction because the parties were identical, and

Goodyear insisting that they were not, (we claiming also that they were not,) we respectfully submit, that when he file a cross-bill we are not introducing foreign matter, when he set up his own adverse claim and the existence of our promissory note, claiming the benefit of it in offset to any damages to which, as distinct from his co-defendants, we may be ascertained to be entitled. The judgment is the same in law as the promissory note would be.

II. It is claimed that the complainants have, in order to obtain the benefit of the judgment, a complete remedy at law.

But the complainants claimed that they were and are the *equitable* owners of the judgment, it having been transferred to them as part of the property of their predecessors in the business in which they are now engaged, and that they are entitled to have it *equitably* taken into account as against any claim for damages which Goodyear or his estate may have against them.

Record, p. 6, fol. 12; p. 127, fol. 207.

As they are equitable owners, their remedy on the judgment is plainly only in equity.

III. It cannot be objected to our claim, to have the benefit of this judgment in the way of equitable set-off, that the claim of Goodyear, as executor, arises upon a cause of action subsequent to the death of the testator.

The subject-matter on which the original suit was brought, which was its foundation and without which it could not have been brought, was a patent granted to Charles Goodyear, the testator.

There is sufficient mutuality here to have enabled the court to have granted the relief prayed for in the cross-bill.

IV. It does not appear that the judgment against Goodyear was not a judgment *in rem.*, and not personally binding on the party as a judgment *in personam*. It may well be that

Goodyear had actual notice of the suit, and declined to appear, and even if the judgment is not binding upon him or his estate as a judgment, it may well be that the claim upon which the judgment is founded is a valid claim, and may be properly allowed as a set-off in this case, and these are proper matters of proof.

V. The statute of limitations cannot avail the defendant in this case: *first*, because, if the judgment is binding as a judgment, the limitation is twenty years, and not six; and, *second* if the judgment be not so binding, and the claim upon which it is founded be a valid claim, it may well be that the statute of limitations did not run against the same by reason of the defendant's absence from the State, and his non-return into the same until within less than six years before the commencement of this suit, and this is a subject of proof, and the defendant has waived the statute by entering an appearance in this suit.

VI. This is not a bill of interpleader, and no objection to the bill on that ground is valid.

VII. The demurrer of the defendant, Charles Goodyear, executor, should be overruled.

VIII. The decree in this case was in every sense a final decree, disposing of the question of jurisdiction, and upon the merits.

J. H. Parsons,
A. Payne,
C. Cushing,
Of Counsel for Appellants.

UNITED STATES

SUPREME COURT.

No. 166.

THE PROVIDENCE RUBBER COMPANY, et al.,

Appellants,

against

CHARLES GOODYEAR, Jr., Ex., et. al.

Respondents.

RESPONDENTS' BRIEF.

J. HERVEY ACKERMAN,

Counsel for Respondents.

NEW YORK:
E. S. DODGE & CO., STEAM BOOK AND JOB PRINTERS,
84 JOHN STREET.
1869.

Supreme Court of the United States.

THE PROVIDENCE RUBBER COMPANY, et al.,
Appellants,
vs.
CHARLES GOODYEAR, Jr., Executor, and others,
Respondents.

THE APPEAL.

This is an appeal from a decree, dismissing a Cross Bill.

STATEMENT OF FACTS.

Leave was granted to file the Bill, on the representation that it was a Cross Bill, as is shown by the following motion:—

THE PROVIDENCE RUBBER CO., *et al*,
vs.
CHARLES GOODYEAR, EX., *et al.*

The Providence Rubber Company, William W. Brown, and Edwin M. Chaffee, move the Court for leave to file the *Cross Bill* herewith presented.

By their Solicitor,

A. PAYNE.

Rec., p. 1.

Such leave was asked for after the final hearing on the merits in the original suit.

Rec., p. 3.

After the Decree thereon was made.

Rec., p. 3.

After the final hearing and decision on the Master's Report.

Rec., p. 3.

And after Appellants had taken their appeal to this Court in the original suit.

The original suit to which it refers, was commenced in Oct., 1862.

Rec., p. 2.

The Cross Bill was filed four years afterwards —Nov. 28th, 1866.

Rec., p. 1.

To this Bill Corporation Respondents entered the following appearance :

"B. R. Curtis appears specially for the parties named as Defendants, reserving all rights, and especially reserving the right to object to the jurisdiction of the Court, for which purpose alone this appearance is now entered."

B. R. CURTIS, *Sol'r.*

Rec., p. 134.

Subsequently, Respondents filed the following motion to dismiss:

"Now, pursuant to the special appearance entered herein, the Union India Rubber Company and the Phœnix Rubber Company do move to dismiss the bill of complaint filed herein, (Nov. 28th, 1866,) for want of jurisdiction. Dated March 27th, 1867."

B. R. CURTIS, *Sol'r.*

At the June Term, 1867, the cause was argued and the Bill dismissed, and the following Decree entered :

DECREE.

The above entitled cause came on to be heard upon the demurrer, to the bill, filed by Charles

Goodyear, Jr., executor of Charles Goodyear, deceased; and also upon the motion filed by the Union India Rubber Company, and the Phœnix Rubber Company, to dismiss the Bill for want of jurisdiction; and the Court having heard the counsel of the respective parties, do order and decree that the said demurrer be allowed and sustained, and adjudged sufficient; and that the said motion be allowed, and that as well on said demurrer, filed by said Charles Goodyear, executor, as upon said motion filed by the Union India Rubber Company, and the Phœnix Rubber Company—the said bill be dismissed with costs to the said Charles Goodyear, Jr., executor of Charles Goodyear, deceased, as also with costs to the said Union India Rubber Company, and the Phœnix Rubber Company—the said costs to be taxed by the clerk.

Entered as the Decree of this Court, per order thereof, this 18th day of June, 1867, to wit, the 3d day of June Term, 1867.

HENRY PITMAN, *Clerk.*

Rec. p. 137.

The only question for examination here, is—

Does an appeal lie to this Court from a Decree of the Circuit Court dismissing a Cross Bill?

The answer to which is given in the following

POINTS:

FIRST.

The appeal should be dismissed for want of *jurisdiction;* the Decree from which it is taken not being *final* within the meaning of the Acts of Congress—a Cross Bill being only incidental or auxilliary to an original suit, clearly no Decree dismissing it can be a final Decree,—or *one which disposes of the whole merits of the case.*

Cross vs. De Valle, 1 Wall., 14.
Beebe vs. Russell, 19 How., 284.
Shields vs. Barrow. 17 How., 145.
Young vs. Smith, 15 Peters, 287.

SECOND.

If such Decree be reviewable, it is only so when brought up *as part* of the record in the original suit to which the Cross Bill claims to belong.

Ayers vs. Carver, 17 How., 595.

The only record before this Court on this appeal is this Cross Bill, and the proceedings thereon.

THIRD.

The dismissal of the Bill in the Court below involved the exercise of that judicial discretion which pertains to all Courts, and which is never re-examinable elsewhere.

Wylie vs. Cox, 14 How., 1.

Brockett vs. Brockett, 2 How., 238.

FOURTH.

The record before the Court shows that there has been inexcusable delay and laches in the filing of this pretended Cross Bill; and that the merits in the original suit had been passed upon two years prior to the application for leave to file the present bill. This brings the present case fully and fairly within the letter and spirit of the decision in the case of

Bronson vs. Rail Road Co., 2 Black, 524.

The Decree below should be affirmed.

J. HERVEY ACKERMAN.

Of Counsel for Respondents.

Supreme Court of the United States.

No. 166.

THE PROVIDENCE RUBBER COMPANY, WILLIAM W. BROWN, EDWIN M. CHAFFEE, and AUGUSTUS O. BOURN, *Appellants*,

vs.

CHARLES GOODYEAR, *Executor of the last Will and Testament of* CHARLES GOODYEAR, *deceased*, THE UNION INDIA RUBBER COMPANY, and THE PHENIX RUBBER COMPANY.

Brief and Points to sustain Demurrer of CHAS. GOODYEAR, *Executor, &c., to the Cross Bill.*

APPEAL FROM THE CIRCUIT COURT OF THE UNITED STATES FOR THE DISTRICT OF RHODE ISLAND.

THE REFERENCES ARE TO THE PRINTED PAGES OF THE RECORD.

BRIEF AND POINTS.

The cross-bill states the filing of the original bill by the defendants. The original bill claims that since July, 1862, the complainants illegally and without license, manufactured and sold certain india-rubber goods, and prays that they account and pay such sums as they may have made thereby. The cross-bill further sets forth the answer to the original bill, which, among other things, generally denies the allegations in the same. The cross-bill then sets forth the interlocutory decree and proceedings thereunder, and the motions of Charles Goodyear, Executor, to amend the same, and claiming an interest in the accounts and proceeds of the suit, and for other relief, and the orders of the Court thereupon; and it also states that these complainants may be adjudged to pay full dam-

ages to the Union India Rubber Company and the Phœnix Rubber Company, and remain liable to pay the same damages to Charles Goodyear, Executor. Pages 3, 4, and 5.

It then states that the complainants hold a judgment recovered in the Supreme Court of the State of Rhode Island against the defendant's testator, Charles Goodyear, deceased, in his lifetime, at the March Term, A. D. 1858, for $48,521.30, which they hold as an offset to any damages which the Providence Rubber Company may finally be adjudged to pay in said cause, which may be due and payable to the said Charles Goodyear, Executor. Pages 5 and 6.

It then prays that the said Charles Goodyear, Executor, may set forth what portion, if any, of the damages he claims which the Providence Rubber Company may finally be adjudged to pay in the cause, and the facts upon which said claim is founded, and that his co-defendants may do the same. Pages 5, 6.

It then asks the Court to determine what portion of the damages, if any, that the Providence Rubber Company *may be decreed to pay*, are due and payable to each of the defendants, and that they may offset the alleged judgment against such portion as may be adjudged due and payable to Charles Goodyear, Executor. Page 67.

It appears by the Record that Charles Goodyear, this defendant's testator, died July 1st, 1860. Pages 12 and 106.

The defendant, Charles Goodyear, Executor, demurs to the cross-bill.

POINTS.

I.

A cross-bill is matter of defence. It cannot embrace new and distinct matter not embraced in the original suit, and if it does so, no decree can be founded on those

matters, and the cross-bill is open to a demurrer for this cause.

§ 631, *Story Eq. Pl.*
Gallation v. *Erwin*, *Hopkins R.*, 48, 59;
8 *Cowen R.*, 361.

Nothing can be more entirely foreign to the original suit, than the matter set up in the cross-bill respecting the alleged judgment against Charles Goodyear deceased, and the accounting and relief prayed for in the cross-bill. Pages 5 to 6 *of cross-bill and Exhibit H therein referred to.*

The settled rule of Courts of Equity in respect to a cross-bill like the one demurred to in this case, is stated by Judge Story thus: "A cross-bill being as has been "already said, a matter of defence, is confined to the "matters in litigation in the original suit. And therefore "if it seeks to bring before the Court other distinct mat- "ters and rights, it is no longer entitled to be deemed a "cross-bill, but is an original suit. *Without such a re-* "*striction new matters might be introduced into litigation by* "*cross-suits without end.*"

§ 631 *Story Eq. Pl.*

A cross-bill is a mere auxiliary suit, and a dependency of the original, and it must be confined to the matters in question in the bill.

Crosse v. *De Valle*, 1 *Wallace*, 1.

II.

The cross-bill is filed for a discovery and an account, when the subject is matter of set-off of a judgment, and where the plaintiff can have as effectual and complete a remedy in a Court of Law as in a Court of Equity, and it is clearly demurable.

2 *Dan. Chy. Pr.* (*Ed.* 1846), marginal paging, 28.
Dinwiddie v. *Bailey*, 6 *Vesey*, 136.
Story Eq. Pl., § 482.

The proper way to set off one judgment against another is by motion. Judgments, not only in the same court, but in different courts, may be set-off against each other at law; and the powers of courts of law in allowing such set-offs, does not depend upon statute, but on the general jurisdiction of the court over its suitors.

Barker v. *Braham*, 2 *W. Black R.*, 869.
Simpson v. *Hart*, 1 *John. Chy.*, 94.

Courts of Equity follow the law in matters of set-off, unless there is some equity attaching to the transaction between the parties.

Gordon v. *Lewis*, 2 *Sumner's C. C. R.*, 143.
Howe v. *Sheppard*, 2 *Sumner's C. C. R.*, 409.

There are no equities attaching to the transactions in the present case, and nothing is alleged showing that the plaintiffs have not an effectual and complete remedy in a court of law.

1. There is no force in the allegation of the cross-bill, that the complainants may be adjudged to pay full damages to the Union India Rubber Company, and the Phenix Rubber Company, and remain liable to pay the same damages to Charles Goodyear, Executor, as the record discloses that the order amending the decree, and adjudging payment of damages to all the complainants in the original suit, was made Nov. 20th, 1866, seven days before the filing of the cross-bill. Pages 7, and 126

III.

In the original suit, Charles Goodyear, Executor of Charles Goodyear, deceased, sues upon a cause of action arising subsequent to the death of his testator. The defendants in that suit file their cross-bill to establish a Page 118

set-off arising Pages 5 and 6 of cross-bill) before the death of the testator, Charles Goodyear, deceased. To allow them to do this, would be giving them an undue preference over the other creditors of that estate. A Court of Equity will not sustain a bill filed to accomplish so unjust and inequitable a purpose, especially where the record discloses that the estate of the deceased is insolvent and the creditors numerous.

Where an executor sues for a cause of action arising after the death of the testator, the defendant cannot set-off a debt due to him from the testator. "In assumpsit, by the plaintiff, as executor, for goods sold and delivered to the defendant by the plaintiff, as executor, the defendant pleaded a set-off for a debt due from the testator to the defendant. *On demurrer*, the Court held the plea bad; for to allow a set-off in this case, would be altering the course of distribution."

1 *Wheaton's Selwyn*, *p.* 150.
Teggetmeyer, *et al.*, *Executors*, v. *Lumley*, reported in *Dumford's Note to Hutchinson* v. *Sturges*, *Willes R.*, 264.
Merrit v. *Seaman*, 6 *Barb.*, 330.

"The debts sued for, and the debts intended to be set-off, must be mutual, and due in the same right."

1 *Wheaton's Selwyn*, *p.* 150.

IV.

It appears by the bill and Exhibit H, Page 127 made a part of the bill, that the alleged judgment against defendant's testator, was a proceeding by attachment of certain personal property found in the State of Rhode Island; that there was no service of process upon him, and that he never appeared or contested the suit.

It was a mere proceeding, *in rem*, and not personally binding on the party as a judgment *in personam*. It affected the property attached to the extent thereof, but

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was in no sense a judgment binding the party beyond that property.

McVickar v. *Beebe*, 31 *Maine*, 314.
Storys' Conflict of Laws, § 549.
Am. Law Reg., N. S., vol, 6, *pp.* 5, 8.

It follows that a bill like the one in question seeking to convert a proceeding or judgment *in rem* into a judgment *in personam*, or to establish a set off, of a judgment *in rem* cannot be sustained. It would be attended with great injustice and confusion, and it is without a precedent.

V.

The alleged judgment being but a mere proceeding *in rem*, and it appearing upon the face of the cross-bill that the cause of action accrued more than six years before the filing of it—the demurrer lies.

Public Laws (Edition, 1844) *of Rhode Island*, 221.
Storys' Equity Pleadings, § 484.

VI.

Even if the alleged judgment against the defendant's testator was a judgment *in personam*, the complainants jointly owning it, cannot offset it against this claim of Charles Goodyear, Executor, against the Providence Rubber Company, one of their number.

It is an elementary principle that the debt sued for, and the debt intended to be set-off, must be mutual, and due in the same right.

1 *Wheaton's Selwyn*, § 150.
Jackson v. *Robinson*, 3 *Masons C. C. R.*, 138.
Cobb v. *Haydock*, 4 *Days' R.*, 472.

The demurrer lies because the plaintiffs' ask a relief for their joint benefit, by off-setting against the executors interest in the claim against one of their number, the Providence Rubber Company, the alleged judgment against the executors testator, and the relief thus sought is in contravention of the settled law upon the subject.

Courts of Equity so far from favoring set-offs, do not independent of any statute of set-off, exercise jurisdiction to set-off mutual disconnected debts, unless where the dealings of the party imply it, or as matter of agreement by mutual credit.

Green v. *Darling*, 5 *Masons C. C. R.*, 201.

Joint debts cannot be set-off against separate debts, or separate debts against joint debts, either at law or in equity, as where there is a separate debt due from a partner, and a joint debt due by a partnership.

Howe v. *Sheppard*, 2 *Summers' C. C. R.*, 409.

Palmer v. *Green*, 6 *Conn. R.*, 19.

Ladne v. *Hart*, 4 *Wendell*, 583.

The statute of Rhode Island in respect to set-offs effectually disposes of the complainants' claim to offset this alleged judgment, it is as follows:

" If any defendant shall have a demand on the plain-
" tiff for any sum liquidated, or for one which may be
" ascertained by calculation, and which is founded on a
" judgment, or upon an account, or upon any contract,
" whether express or implied, and whether with or with-
" out a seal, *and which existed at the time of the commence-*
" *ment of the action, and then belonged to the defendant in his*
" *own right, and for which he might maintain a suit in his*
" *own name, he may set off the same in any action founded*
" *upon any demand which could itself be set-off.*

Public Laws of Rhode Island, (edition, 1844, *p.* 128.)

It appears by the complainants showing that they do

not bring their case within any of the statutory requirements, it *neither belongs to them in their own right*, nor is the demand in the original suit one which could itself be set-off.

As to the construction of this statute of Rhode Island, Judge STORY, in dismissing a bill to establish a set-off, uses this language: "There is no pretence to say, that in "Rhode Island an assigned judgment of a third person "against the plaintiff, could be set-off in favor of the de- "fendant, who had purchased it against the plaintiff's "judgment."

Greene v. *Darling*, 5 *Mason C. C. R.*, 217.
Trafford v. *Hall*, 7 *Rhode Island R.*, 107.

The Providence Rubber Co. and Augustus O. Bourn two of the plaintiffs in this suit were not parties in the attachment suit against Charles Goodyear. - Page 127

VII.

The complainants cannot ask the defendants to interplead; it is the foundation of all bills of Interpleader that the complainant should deny any interest in the thing in controversy between those he asks to interplead and offer to pay the money unconditionally into Court. This entirely fails in the present suit.

Story's Equity Pl., §§ 291, 292.

The Cross-Bill and Exhibits show that the complainants, by their record, entirely controvert the defendants' claim in the original suit, and have not paid the money into Court, or offered to do so, in order that it may be distributed as the Court may award among those they ask to interplead.

A Cross Bill of Interpleader, based on hypotheses, and subject to conditions, if sustained, would establish a precedent that would lead to endless litigations.

VIII.

The complainants have been guilty of laches in waiting for years, after the commencement of the original suit, before interposing their alleged set-off, or seeking to take advantage of it, and a Court of Equity will not relieve them.

Green v. *Darling*, 5 *Mason C. C. R.*, 201.

IX.

The demurrer of the defendant Charles Goodyear, Executor of Charles Goodyear, deceased, to the Cross-Bill, should be sustained, and he should have judgment that the bill be dismissed with costs.

WM. E. CURTIS,
of Counsel for Defendant.

CHARLES GOODYEAR,
Executor, &c.,
of CHARLES GOODYEAR, deceased.